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PATENTS FOR INVENTIONS

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LONDON

SIR ISAAC PITMAN & SONS, LTD.
PARKER STREET, KINGSWAY, W.C.2
BATH, MELBOURNE, TORONTO, NEW YORK

1922

FROM THE SAME PUBLISHERS

RESEARCH IN INDUSTRY

The Basis of Economic Progress

In demy 8vo, cloth gilt, 264 pp. 10s. 6d. net.

By A. P. M. FLEMING, C.B.E., M.Sc., M.I.E.E., and J. G. PEARCE, B.Sc., A.M.I.E.E.

An attempt has been made in this book to consider the nature of research and its relation to manufacture, and to indicate the manner in which existing research resources may be placed at the disposal of industry, thereby affording guidance to industrial managers in determining the most effective manner of dealing with their problems. Recent tendencies towards co-operative action for the conduct of research, notably instanced by the formation of Research Associations in Great Britain, are examined, together with the conditions under which a works research organization may be established. The internal organization, design, staffing, equipment, cost, and direction of research laboratories for industry, and their relations to national, university, and private laboratories are outlined. The progress made in the world-wide movement towards the foundation of research institutions is briefly considered.

"This book is an illustration of the new spirit, and will serve as a valuable guide to it. One is struck by the breadth of outlook displayed in the opening and closing chapters, and by the extent to which the authors are able to go into detail without obscuring the ultimate issue. Their work is at once exhaustive, concise, and thorough."—*Western Mail*.

*sent
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W.P.*

PREFACE

THE object of this book is to set out clearly and concisely the present law and practice relating to patents for inventions, and to do so in such a form that it will be readily comprehensible not only to those who have had a legal training, but also to that large and important section of the community who are directly or indirectly interested in inventions from the point of view of their protection and commercial exploitation.

A departure is made from the usual manner of treating the subject, the purpose being to follow a more logical and practical sequence. After a broad survey of the whole subject in Chapter I, the various matters outlined there are more fully treated in the following chapters, starting with the various steps an applicant must take to obtain a patent, the formalities and requirements he must comply with, the difficulties he may encounter prior to the grant of the patent, and how he may meet them. Having obtained the patent, the construction of the complete specification as a legal document and the question of the validity of the patent are next discussed. Following this, the rights of the patentee and the methods by which he may enforce these rights are dealt with, and, finally, the liabilities of the patentee are considered.

To those who may peruse the present work, and to all who have had practical experience with patents, it may seem that the grant of a patent, and the establishment of its validity in the Courts, are attended by too many difficulties and uncertainties. It must not be forgotten, however, that a patent constitutes a monopoly and to this extent operates as a restriction on the common law rights of the public. The grant of a patent is the method adopted for encouraging invention and rewarding an inventor who by his ingenuity devises a new manner of manufacture which is of benefit to the public by extending or improving industry within the realm.

Whilst, however, it is the policy of the law, on the one hand to encourage invention by the granting of patents, it is necessary, on the other hand, to ensure that the interests of the public are not unduly prejudiced. To achieve these dual objects the grant of a patent is subject to certain well-defined requirements and obligations on the part of the patentee, from which arise the difficulties and uncertainties he may encounter. Certain formalities and requirements, for example, are laid down with which an applicant must comply, and the validity of the patent may subsequently be challenged in the Courts. In the case of a really new, useful, and ingenious invention there is, however, no great difficulty in obtaining a patent. Also, provided due care has been taken in drafting the complete specification, the difficulties and uncertainties will largely disappear and the patent may be of very great value.

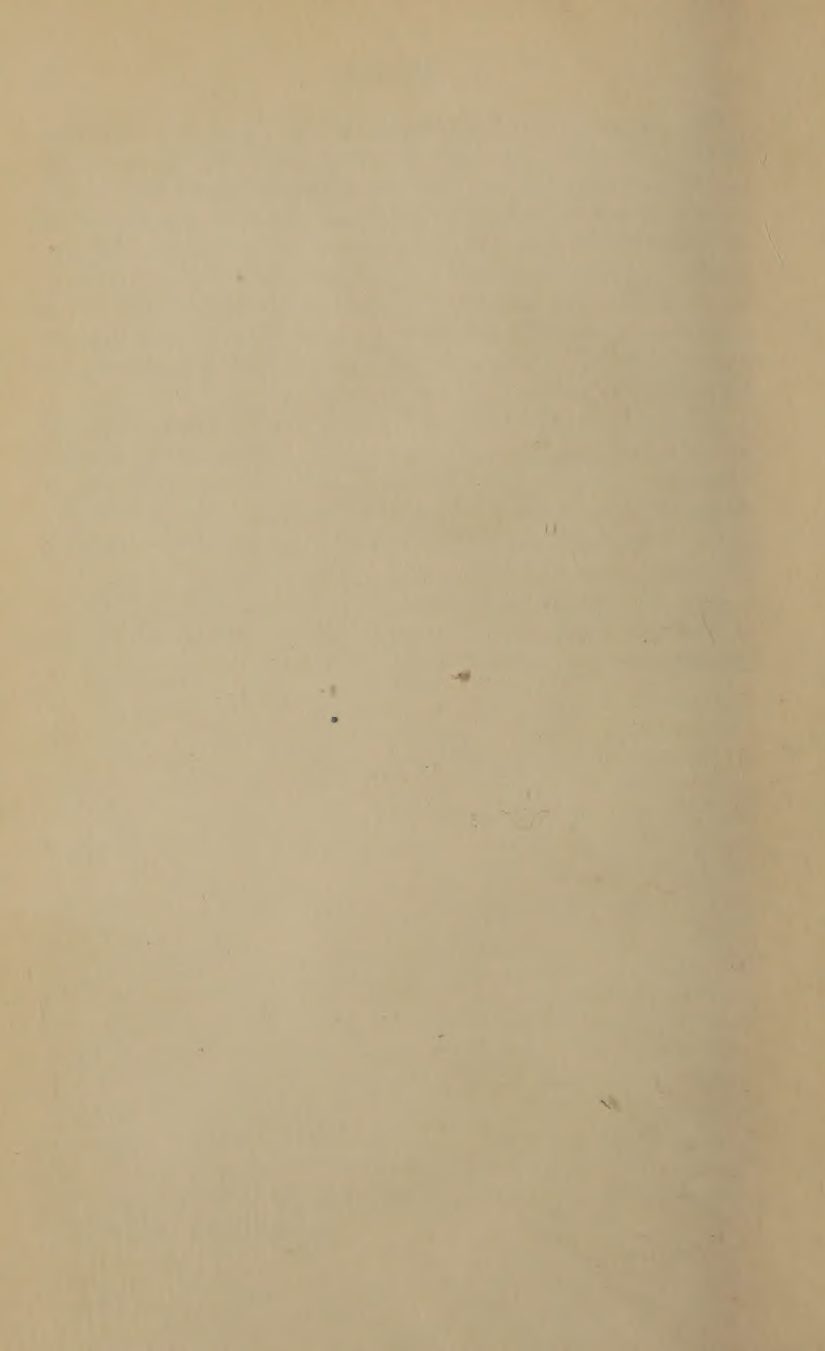
A patentee's most valuable right is the right to prevent infringement of the patent by unauthorized persons, and this depends upon his ability to establish the validity of the patent if challenged. It has been necessary, therefore, to deal with the subject from the legal aspect. In so doing, an endeavour has been made to remove the difficulties which would be felt by those who have not had a legal training. The language of lawyers is, naturally, not free from technical expressions, and in patent law certain terms are often loosely used and are liable to cause confusion of ideas. "Subject-matter" is an example of such a term. When a patent is said to be invalid for want of "subject-matter" this may mean that it lacks any one or more of the following essentials for a valid patent, namely: (1) a manner of manufacture which can be patented, (2) novelty, (3) utility, or (4) inventive ingenuity. The term "subject-matter" is often, however, and in fact most frequently, used to indicate the last essential, "inventive ingenuity," even to the exclusion of the others. In this book the above requirements are kept distinct, and where inventive ingenuity is meant, this term is used and the more general but somewhat indefinite term "subject-matter" is avoided. This also has the merit of emphasizing the distinctions between the various requirements.

The authority for statements made in the text is indicated in the footnotes. In order to avoid the constant repetition in the footnotes of the titles of the decided cases and of the reports in which they are to be found, the cases are set out in an alphabetical list and numbered consecutively. The list states the full title of each case and where it is reported. It also indicates the particular branch of the subject for which each case is cited and the page or pages of the text where the case is referred to. In the footnotes the case is indicated by its number in the list.

Where the word "Section" occurs the reference is to the Patents and Designs Acts, 1907-1919, unless otherwise stated. Similarly, "Rule" refers to the Patents Rules, 1920. These Acts and Rules are fully set out in the Appendix. The latter also includes the Treaty of Peace Order, 1920, and the relevant Statutory Rules and Orders made thereunder.

The Authors desire to acknowledge their indebtedness to H. F. Lowe, Esq., of the Patent Office, for reading the proofs, and for valuable criticisms and suggestions.

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CONTENTS

PREFACE	PAGE iii
-------------------	-------------

CHAPTER I

INTRODUCTORY

Letters Patent	1
What can be patented ; subject-matter	1
Patent rights	2
Acts in force	3
The International Convention	4
Administration of the Patents Acts	4
Agency	5
Registered patent agents	6
Offences	7
Who may apply for a patent	8
First steps to acquire a patent	8
The specification	9
Examination and acceptance	9
Opposition to the grant of a patent	10
Grant and sealing of patent	10
Register of patents	11
Term, renewal, and lapse of patents	11
Restoration of lapsed patents	12
Amendment of patent specifications	12
Surrender of patents	13
Rights, obligations, and liabilities of a patentee	13
Territorial extent of patent	15

CHAPTER II

HOW TO OBTAIN A PATENT

1. The application	16
2. The specification of the invention	19
(a) Provisional specifications	19
(b) Advantages and drawbacks of filing a provisional specification	20
(c) Complete specifications	21
(d) Chemical inventions	22
3. Procedure in the Patent Office	23
(a) <i>Pro forma</i> requirements	23
(b) The title	23
(c) The description	23
(d) " Manner of manufacture "	24
(e) One invention	24

3. Procedure in the Patent Office (<i>contd.</i>)	PAGE
(f) Searches and anticipations	25
(g) Disconformity	27
(h) Post-dating	28
(i) Manner of making amendments	29
(j) Interviews, hearings, and appeals	29
(k) Acceptance and sealing	29
4. Notes on special types of patents	31
(a) Patents of addition	31
(b) International Convention applications	32
(c) Secret patents	32
(d) Single patents for cognate inventions	33

CHAPTER III

OPPOSITION TO THE GRANT OF A PATENT

The statutory grounds of opposition stated	34
Ground 1. Invention obtained from another person	35
(a) Cases of fraud	35
(b) Joint inventions	36
Ground 2. Prior publication	36
Ground 3. Prior grant	39
Ground 4. Invention not particularly described and ascer- tained	39
Ground 5. Disconformity	40
Ground 6. Convention application differs from invention applied for abroad	41
Procedure	41
(a) Notice of opposition	41
(b) Counter-statement by applicant	42
(c) Evidence in support of opponent's case	42
(d) Applicant's evidence	43
(e) Opponent's reply	43
(f) Hearing	43
(g) <i>Locus standi</i>	44
(h) Decision and costs	44
(i) Appeal from decision	45

CHAPTER IV

THE CONSTRUCTION OR INTERPRETATION OF THE COMPLETE SPECIFICATION

General consideration and principles	46
Rules of construction	47
Rule 1. It is considered as a whole	47

Rules of construction (<i>contd.</i>)	PAGE
Rule 2. Its meaning is gathered from the words used . . .	48
Rule 3. It is construed in the light of the state of knowledge in the art or manufacture at the date it was published	49
Rule 4. It must be construed with a desire to preserve property	51
Rule 5. The extent and limits of the monopoly granted (i.e. of the invention claimed) are gathered from the claims read in the light of the rest of the specification and the drawings (if any) . . .	52

CHAPTER V

THE VALIDITY OF THE PATENT

General considerations and statement of grounds on which a patent may be held to be invalid	55
Ground 1. That the grantee is not the true and first inventor	57
Ground 2. That the invention is not a "manner of manu- facture" within the meaning of Sect. 6 of the Statute of Monopolies	59
Ground 3. That the invention is contrary to public policy .	59
Ground 4. That the invention is not novel	59
(a) Prior user	60
(b) Prior publication, orally or in writing	60
(c) Tests of prior publication	62
(d) Special circumstances in which prior use or publication does not invalidate	62
Ground 5. That the invention is not useful	63
Tests of utility	63
(a) That the invention works in the way described . .	63
(b) That the end attained is useful	64
(c) Commercial success	64
Ground 6. That the invention is wanting in inventive ingenuity	65
(a) General principles	65
(b) Illustrations of cases relating to inventive ingenuity .	69
(i) Cases illustrating insufficient ingenuity	70
(ii) Cases illustrating sufficient ingenuity	71
Ground 7. That the invention is insufficiently or improperly described or claimed in the complete specification	71
(a) Intelligibility	72
(b) Sufficiency of specification	73
(c) <i>Bona fides</i>	75
Ground 8. That there is disconformity between the pro- visional and complete specifications	76

CHAPTER VI

THE RIGHTS OF A PATENTEE

	PAGE
Section A. Infringement actions	77
(1) Who may bring an action and in what Court	77
(2) In respect of what acts it may be brought	79
(3) Procedure	81
(a) Interlocutory injunctions	81
(b) Pleadings	82
(c) The trial	83
(4) What defences are open	84
(a) Want of title to sue	85
(b) Non-infringement	85
(c) Licence	87
(d) Invalidity of the patent	88
(e) The existence of a contract which is null and void under Sect. 38	89
(5) What relief may be obtained	90
(a) An injunction	90
(b) Damages	91
(c) Delivery up or destruction of infringing articles	95
(d) Certificate of validity	96
(e) Costs	98
(6) The effect of the judgment	102
Section B. Actions to recover royalties	103
Section C. Register of patents	104
Section D. The transfer of patent rights	106
(1) Assignments	107
(a) Legal assignments	107
(b) Equitable assignments	108
(i) Covenants to communicate improvements	109
(ii) Contracts of service	109
(c) Mortgages	110
(2) Transfers by the operation of law	110
Section E. Licences under patents	111
(1) Express licences	112
(2) Implied licences	113
(3) Statutory licences	114
(a) Compulsory licences	114
(b) Licences under patents indorsed "Licences of right"	114
Section F. The amendment of specifications	115
(1) What amendments are allowable	117
(2) Applications to the Comptroller	119
(3) Applications to the Court	120

	PAGE
Section G. Extension of the normal term of a patent	122
(1) Petitions on the ground of inadequacy of remuneration	123
(a) The petition	123
(b) What the petitioner has to prove	124
(i) That the invention is one of merit	125
(ii) That he has done everything possible to introduce the invention and make a profit	125
(iii) That there has been inadequacy of remunera- tion due to circumstances not under his control	125
(c) Opposition to the petition	126
(d) Procedure	127
(e) Principles and conditions on which the extension is granted	129
(2) Applications on the ground of loss or damage arising from war	130
Section H. Restoration of lapsed patents	132
Section I. Surrender of patents	134
Section J. Rights of co-patentees <i>inter se</i>	135
Section K. Rights of a patentee in relation to the Crown	137
Section L. Rights as affected by war legislation	140
(1) Patents granted with abnormal priority of date	140
(2) Patents restored under the Treaties of Peace	142
(3) Infringement of certain patents during the war	143

CHAPTER VII

LIABILITIES OF A PATENTEE

Section A. Revocation of patents	144
(1) Petition to the High Court	145
(a) The grounds on which a petition may be presented	145
(b) Persons entitled to petition	145
(c) Procedure	146
(d) The judgment and its effect	148
(2) Applications to the Comptroller	149
Section B. Compulsory licences	149
(1) Compulsory licences as a relief from the abuse of monopoly rights	151
(a) Who is entitled to apply	151
(b) What the applicant has to prove	151
(c) How the patentee may meet the case	152
(d) Procedure	153

Section B. Compulsory licences (<i>contd.</i>)	PAGE
(e) What relief can be obtained	155
(i) An order to indorse the patent "Licences of right"	155
(ii) An order for the grant to the applicant of a licence	155
(iii) An order to revoke the patent	157
(2) Compulsory licences in respect of patents indorsed "Licences of right"	157
(3) Compulsory licences in respect of patents for food and medicine	159
(4) Compulsory licences under the provisions of the Treaties of Peace	159
Section C. Actions to restrain threats	160
(1) Who may bring an action	161
(2) Against whom it may be brought	161
(3) In respect of what acts it may be brought	162
(4) What defences are open	162
(a) Justification	162
(b) Due diligence in taking action for infringement	163
(5) What remedies may be obtained	164
(a) Injunction	164
(b) Damages	164
(c) Costs	165
(6) Procedure	165
Section D. Patents restored under the Treaties of Peace	165

APPENDICES

(I) Statute of Monopolies	169
(II) Patents and Designs Act, 1907, as amended by the Patents and Designs Act, 1914, and the Patents and Designs Act, 1919	170
(III) Patents and Designs Act, 1919	220
(IV) Patents Rules, 1920	222
(V) Forms of Restricted Grant	305
(VI) Treaty of Peace Order, 1919	306
(VII) Order regarding patents of German Nationals vested in the Custodian	332
(VIII) Patents (Treaty of Peace) Rules, 1920	336
(IX) Order regarding patents of Austrian and Bulgarian Nationals vested in the Custodian	345
(X) Table of Cases cited	346
INDEX	363

ABBREVIATIONS USED IN TEXT AND FOOTNOTES

- I.O.J.* . . . *Illustrated Official Journal (Patents).*
R.S.C. . . . Rules of the Supreme Court.
Rule . . . Patents Rules, 1920, set out in Appendix IV
p. 222.
Sect. . . . Section of the Patents Acts, 1907-1919, set
out in Appendix II, p. 170.
S.R. & O. . . . Statutory Rules and Orders.



PATENTS FOR INVENTIONS

CHAPTER I

INTRODUCTORY

THE purpose of this chapter is to give a general survey of the whole subject.

LETTERS PATENT.

Letters Patent are open letters under the Great Seal addressed by the Sovereign to all his subjects and are the recognized means by which the prerogative of the Crown is exercised in conferring certain rights and privileges on one or more individuals. The Letters Patent with which this volume is concerned are grants of monopoly of trade made by the Crown in respect of inventions. They are commonly referred to shortly as "Patents"^(a). Patents are sealed with the Seal of the Patent Office which, for this purpose, is the equivalent of the Great Seal.

WHAT CAN BE PATENTED ; SUBJECT-MATTER.

A patent can only be granted for an invention, but it is not every invention that can be patented. To be patentable an invention must be a "manner of new manufacture" within the meaning of Sect. 6 of the Statute of Monopolies^(b); this means in the first place that it must be an article or process of or relating to manufacture, and in the second place that it must be new. By definition in the Acts^(c) an invention includes "an alleged invention"; this does not mean that it is possible to obtain a patent for anything by merely alleging that it is an invention. An "alleged invention" must be a manner of manufacture in the sense above explained, but its novelty may

(a) For Forms of Patents *see* Appendix IV., p. 299 and *seq.*

(b) Appendix I.

(c) Sect. 93

be "alleged" (d), and before the grant of the patent a limited investigation only is made in regard to that allegation(e). It must also be borne in mind that, even if an invention is patentable and a patent is granted, it does not follow as a matter of course that the patent will be a "valid" one so as to enable the patentee to enforce his rights; to support the validity of the patent the invention, in addition to being a new article or process of manufacture, must also be useful and ingenious. Where a patent is invalid because the invention is not an article or process of or relating to manufacture, or is not new or is not useful or is not ingenious, it is often said that it is invalid for want of "subject-matter." The term "subject-matter" thus includes four distinct things. These matters are more fully discussed in Chapter VI.

PATENT RIGHTS.

It is important to realize exactly what is the nature of the right conferred on an inventor by the grant to him of a patent. It does not confer upon him a substantive right to manufacture in accordance with his invention. He has a common law right to do this. The grant of a patent merely gives him a right for a limited period to stop, by process of law, anyone else from making, using, or selling his invention(f) or any part of it. A patent is known to lawyers as a "chose in action," because it has no substantive existence, but is a species of property giving only a right of action. A good illustration of the right conferred on a patentee is the case of an inventor who makes an improvement in an existing patented article, the patent for which is owned by some other person. The inventor of the improvement is entitled to obtain a patent for his improvement, but he cannot manufacture or sell the improved article, as that would be an infringement of the prior patent, but he can prevent the prior patentee from adopting his patented improvement without his sanction and may exact royalties as the price of such sanction.

A patent may be considered as a contract between the

(d) Cases 107 and 477.

(e) Sects. 7 and 8 and p. 25 *post*.

(f) Case 438.

Crown and the inventor ; as a reward for enterprise and in consideration of the disclosure to and for the benefit of the public of a new and useful invention, the Crown confers on the inventor a monopoly for a term of years. Such a contract requires the utmost good faith on the part of the inventor ; false suggestions or representations or the failure to comply with certain statutory or any common law requirements or obligations is considered to have misled the Crown and vitiates the whole transaction.

Patent rights are transferable like any other form of property, and the person whose name is on the Register of Patents, kept at the Patent Office, as the grantee or proprietor of the patent, is called the "patentee"(g). A patentee has also other obligations and liabilities : his exact legal position and his remedies against infringers are discussed at greater length hereafter(h).

ACTS IN FORCE.

The following Statutes govern the law and practice relating to patents, namely—

(a) The Statute of Monopolies (Sect. 6)(i).

(b) The Patents and Designs Act, 1907, as amended by the Patents and Designs Act, 1914, and the Patents and Designs Act, 1919(j).

Further, by virtue of the Patents and Designs Acts, 1907 and 1919, there are a number of Patents Rules(k) framed by the Board of Trade which, whilst in force, have the same effect as if they were contained in the Acts.

The Statute of Monopolies, enacted in the year 1623, declared all grants of monopolies to be void unless they fell within certain exceptions specified in the Statute. By Sect. 6 of the Statute, the Crown was left free to grant monopolies for fourteen years or less to the true and first inventor or inventors of "any manner of new manufactures. . . . provided they be not contrary to law nor mischievous to the State by raising prices of commodities at home, or hurt of trade or

(g) See Sect. 93.

(i) Appendix I.

(k) Appendix IV.

(h) Chaps. VI and VII.

(j) Appendix II.

generally inconvenient.” This section forms the basis of the present patent law, as only those grants which fall within its terms are valid. It is a principle of English law that, if the Crown purports to grant any monopoly which is larger than it is entitled to grant, such grant is totally void. Whilst Sect. 6 of the Statute of Monopolies forms the origin and basis of the present law relating to patents, the exact words of the Statute are now of historical interest and importance only, as the Courts have, in numerous cases, decided their meaning and laid down the requisites for a valid patent. The Act of 1907 was brought in to amend and consolidate previous enactments relating to patents; the Act of 1914 amends Sect. 91 (1) of the Act of 1907; the Act of 1919 further amends the Act of 1907 and makes extensive provisions for licences in respect of patents and for preventing the abuse of monopoly rights.

THE INTERNATIONAL CONVENTION.

The International Convention is an agreement made between certain countries for the purpose of affording reciprocal rights to their respective nationals in regard to industrial property, including patents. Where a person has applied for a patent in any one of the contracting countries, he or his legal representative or assignee may, within twelve months, file an application for the same invention in any other of the contracting countries, and claim protection and priority from the date of the first application made. Sect. 91^(l) applies to these applications and the procedure is regulated by Rules 15 to 18^(m).

ADMINISTRATION OF THE PATENTS ACTS.

The duties of administering the Patents Acts are delegated to the Patent Office, which is a branch of the Board of Trade. The head of the Patent Office is the Comptroller General of Patents (commonly called the Comptroller) and under him is a large staff of examiners and others. In addition to dealing with applications for patents, oppositions to the grant of patents, applications in respect of “licences of right,” applications for compulsory licences, and, in certain cases, revocations

(l) Appendix, p. 213.

(m) Appendix IV, p. 225 and *post* p. 32.

of patents, applications to amend specifications already accepted, and a number of matters incidental thereto, the Patent Office also publishes for sale copies of British specifications, prepares and publishes weekly the *Illustrated Official Journal (Patents)*, containing abridgments of patent specifications, official notices, lists of patents applied for and applications accepted during the previous week, and other useful matter and information. Abridgment volumes of patents are also prepared, arranged according to classes of subject-matter, with classified lists of patents and name indexes; in fact, there is at the Patent Office almost every conceivable information that can be wanted regarding patents, classified and arranged for convenience of reference.

At the Patent Office there is also an up-to-date and complete Public Library of technical, scientific, and industrial literature, including magazines, copies of foreign patent specifications, legal treatises, and copies of all official publications. The library remains open until a late hour in the evening. There is also an Inland Revenue Stamp Office, where forms may be obtained and stamped.

The Patent Office does not undertake to give professional advice or assistance to applicants or to give opinions in connection with patents; such advice or opinions must be obtained from professional advisers.

The decisions of the Comptroller in the performance of duties imposed by the Acts are, in most cases, subject to an appeal to the "Law Officer," i.e. the Attorney-General or the Solicitor-General, whose decision is final. In some cases, an appeal lies from the Comptroller to the High Court.

The Courts will not interfere with the Comptroller in the performance of his duties under the Acts by Writ of Mandamus in cases where an appeal against his decision is provided for by the Acts. Nor will a Writ of Prohibition issue to the Law Officers⁽ⁿ⁾.

AGENCY.

With the exception of signing certain documents, all communications to the Comptroller relating to patents

(n) Cases, 391, 424.

may be signed by a duly authorized agent. Also, in all proceedings or hearings, parties may appear personally or be represented by counsel or by an agent duly authorized to the satisfaction of the Comptroller. It is, however, in the discretion of the Comptroller to require the personal signature to any document of the person filing the same^(o).

An agent may be a Registered Patent Agent (that is one whose name is on a Register kept by the Chartered Institute of Patent Agents), a solicitor, or any other person, provided that he has a place of business within the United Kingdom or the Isle of Man, but the Comptroller is not bound to recognize, and in practice would not recognize, an agent whose name has been removed from the Register of Patent Agents on account of misconduct.

In proceedings before the High Court parties must appear personally or be represented by counsel.

An applicant may at any time appoint or cancel the authority of an agent.

While it is not incumbent upon an applicant or other interested party to any patent proceedings to employ an agent, it will, in most cases, be highly advisable to do so. The reasons for this will be more apparent when the nature of the requirements incidental to the obtaining of patents and to all patent proceedings are discussed. There are many pitfalls into which the uninitiated may fall, and these are most likely to be avoided by obtaining professional assistance.

REGISTERED PATENT AGENTS.

Although there is no restriction in the selection of an agent to act in respect of applications for patents or other proceedings relating thereto, it is not everyone who can practise or describe himself, or hold himself out, as a "patent" agent. It is an offence for any person to do this unless his name is on the Register of Patent Agents, kept by the Chartered Institute of Patent Agents, a body incorporated by Royal Charter in 1891^(p). To become a Registered Patent Agent it

(o) Rule 9, p. 224.

(p) Sect. 84, p. 210.

is necessary to pass the examinations of the Institute and to comply with the rules made by the Board of Trade.

In the case of a firm, every partner of the firm has to be registered. In the case of a limited company, every director and manager (if any) has to be registered, unless the company commenced to carry on business as a patent agent prior to 1917, in which case a manager or a director has to be registered, and the name of such manager or director so registered has to be mentioned in all professional advertisements, circulars or letters, in which the name of the company appears^(q). It is a punishable offence not to observe these regulations.

OFFENCES UNDER THE ACTS.

In addition to offences referred to in the previous paragraph, it is a punishable offence to represent falsely on the sale of an article that it is patented, e.g. by selling the article with the words "patent" or "patented" falsely applied thereto. There is nothing, however, to prevent an article or process which forms the subject of an application being described or marked in such a manner as to indicate that a patent has been applied for, e.g. by using the words "patent applied for," or stamping these words on an article; but the word "patent" or "patented" must not be used by itself before the grant is actually made, and then the number and year of the patent should be given^(r).

The following are also punishable offences under Sect. 89 —

(1) To make or cause to be made a false entry in any register kept under the Acts, or a writing falsely purporting to be a copy of an entry in any such register, or to produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false.

(2) To use as a business address the words "Patent Office" or other words suggesting that the place of business is connected with the Patent Office.

(q) Section 84.

(r) Sects. 89 and 33.

The grant of a patent does not carry with it any authority to use the Royal Coat of Arms or to stamp the Royal Arms on any article, and it is an offence to use the Royal Arms or any imitation thereof without proper authority in connection with any business or profession (sec. 90).

WHO MAY APPLY FOR A PATENT.

An application may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not. "Any person" includes a corporation, a minor, and a married woman. The "true inventor" is that person who evolved the invention from his own mind or brought it or had it communicated to him from abroad. The "first inventor" is the inventor who is first to communicate the invention to the public, as by way of applying for a patent. A corporation may claim to be the true and first inventor in respect of an invention communicated from abroad, but cannot be the originator of the invention, as a corporation is wanting in mind. The true and first inventor (or all the inventors if there be more than one) of an invention must be a party or parties to an application for a patent, but other persons or companies may be joined as co-applicants. In the case of a deceased inventor, his personal representative may apply or prosecute the application if started. In the case of a minor or a lunatic, the guardian or committee may act.

FIRST STEPS TO ACQUIRE A PATENT.

The inventor, together with the persons (if any) desirous of joining with him in obtaining a patent, must fill up, sign and lodge at the Patent Office a form of application. These forms are of different kinds, according as the invention has been made by the applicant himself, or has been communicated to him from abroad, or according to whether he wishes to apply under the International Convention, or to obtain a patent of addition or a secret patent. These applications are further described in detail in Chapter II.

THE SPECIFICATION.

At the time of lodging the application a specification or written description of the invention must also be filed. This may be either a provisional specification, which must "describe the nature of the invention," or a complete specification, which must "particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed"(s). A provisional specification is often filed when the invention is not fully and completely worked out, and, there are certain advantages in filing a provisional specification(t).. When this course is adopted the complete specification must be filed within nine months.

The important subject of specifications is dealt with more fully in subsequent chapters.

EXAMINATION AND ACCEPTANCE.

When an application for a patent is lodged the documents are referred to an Examiner. If and when the requirements in respect of the application, the specification, and the drawings (if any) have been complied with, a notice of the acceptance of the application is sent to the applicant and is advertised in the Official Journal. When the complete specification is filed, the Examiner, in addition to the examination of the description and claims, makes a search through the Patent Office files of British specifications for the previous fifty years to ascertain whether the invention is wholly or in part anticipated. The investigations and the requirements of the Patent Office are more fully dealt with in Chapter II.

The Comptroller, acting on the reports of the Examiner, may require such amendments as are necessary before proceeding further. These amendments must be submitted in writing and, in cases of difficulty, a preliminary interview may be arranged with the Examiner. The applicant has always the right of a hearing before the Comptroller on any point on which he thinks the Examiner's requirements are unwarranted, and,

(s) Sect. 2 (1) and (2).

(t) *post* p. 29

if the applicant is dissatisfied with the decision of the Comptroller, he may further appeal to the Law Officer, whose decision is final. Subject to certain rules regarding the time within which amendments to meet the Examiner's objections must be filed, considerable latitude is allowed. It is, nevertheless, inadvisable for an applicant to allow matters to drift longer than necessary. The complete specification must be accepted within fifteen months from the date of application, unless additional fees are paid to extend the time, the limit being eighteen months, or unless there are other proceedings pending in connection with the application which make it impossible to accept the application, until these proceedings are concluded.

When the complete specification is in proper form it will be accepted by the Comptroller, and the acceptance notified to the applicant and advertised in the Official Journal. Fuller and more detailed information regarding the process of applying for and obtaining a patent is given in the next chapter.

OPPOSITION TO THE GRANT OF A PATENT.

Within two months of the advertised acceptance of an application, opposition may be entered to the grant of a patent by any person entitled to do so on one or more of the six specified grounds. The opposition is heard by the Comptroller from whose decision an appeal lies to the Law Officer. The grounds of opposition and the procedure are further discussed in Chapter III.

GRANT AND SEALING OF LETTERS PATENT.

If there is no opposition or if the opposition fails and it is decided to grant a patent, the Comptroller will on application and payment of the sealing fee cause a patent to be sealed. The patent is dated as of the date of the application, except in the case of an application under the International Convention, in which case the patent is given the date of the first application in a convention country. Subject to certain contingencies (and the possibility of deferring the sealing by

payment of certain fees), a patent must be sealed within eighteen months of the date of application.

In the event of an applicant being under an agreement to assign a patent when granted and refusing to proceed, or in the event of a dispute between joint applicants, the Comptroller may, on the application of the person entitled to the benefit of the patent, grant a patent, subject to an appeal to the Law Officer^(u).

REGISTER OF PATENTS.

A Register of Patents is kept at the Patent Office, in which are entered all particulars of patents and all subsequent proceedings, assignments or other matters which affect the validity or proprietorship of patents. The payment of renewal fees within the prescribed limits of time and the non-payment of such are entered in the Register. This Register is *prima facie* evidence of any matters properly entered therein. Copies of deeds, licences and any other documents affecting the proprietorship in any letters patent, or in any licences thereunder, must be supplied to the Comptroller in the manner prescribed in the Patent Rules^(v). Provision is also made whereby any person aggrieved by the non-insertion in or omission from the Register of an entry, or by the presence of an existing entry, may apply to have the Register rectified. This subject is further discussed in Chapter VI (C).

TERM, RENEWAL, AND LAPSE OF PATENTS.

The term of a patent is sixteen years from the date which the patent bears. A fee of £1 has to be paid on the application for a patent and a further fee of £3 on filing the complete specification. A fee of £1 is payable on sealing, so that fees amounting to £5 have to be paid before the patent is sealed. This keeps it in force for four years. After this the patentee has to pay annual renewal fees, otherwise the patent will lapse and become void. The first renewal fee is £5, payable before the expiration of the fourth year in respect of the fifth year, and the renewal fee increases by £1 each year, the renewal fee

(u) Sect. 12 (1).

(v) Rules 90, 91, p. 238.

after fifteen years being £16 in respect of the last year. All or any of the fees may be paid in advance. The time for payment of any renewal fee may be extended up to three months on payment of the prescribed extension fee(vv). In the case of a patent indorsed "Licences of right," the renewal fees payable are one-half the ordinary fees(w).

Patents which become void are advertised week by week in the *Illustrated Official Journal (Patents)*.

The term of a patent may, in certain circumstances, be extended. For example, where, having regard to the importance of the invention, the patentee has been unable to obtain adequate remuneration an extension of the term for a period of five years, or, in exceptional cases, of ten years may be obtained. The process for obtaining an extension on the ground of an inadequate recompense is by a petition to the High Court, which should be brought within six months previous to the expiration of the full term of the patent. Special provisions have also been introduced by the Act of 1919 for circumstances arising from a state of war. The subject is more fully considered in Chapter VI (C)(x).

RESTORATION OF LAPSED PATENTS.

Where any patent has become void, owing to the failure of a patentee to pay any prescribed fee within the prescribed time, and the failure is due to accident, inadvertence or mistake, an application may be made to the Comptroller to restore the patent. This matter is considered in detail in Chapter VI (H).

AMENDMENT OF PATENT SPECIFICATIONS.

A patentee may at any time apply to correct clerical errors in his specification and may also apply for leave otherwise to amend his specification by way of disclaimer, correction or explanation. No amendment will be allowed which would substantially alter, or enlarge the scope of, the invention. The subject is further dealt with in Chapter VI (F).

(vv) Rule 51.

(w) Sect. 2 and (1) (f).

(x) *post* p. 104

SURRENDER OF PATENTS.

A patentee may at any time by giving notice in the prescribed manner to the Comptroller, offer to surrender his patent, and the Comptroller may, after hearing all parties desiring to be heard and if he thinks fit, accept the offer and thereupon make an order for the revocation of the patent. This subject is further discussed in Chapter VI (I).

RIGHTS, OBLIGATIONS, AND LIABILITIES OF A PATENTEE.

It has already been pointed out that there are certain conditions with which an applicant for a patent must comply, some of which arise from common law and others are imposed by the Patents Acts and Rules. For example, it is incumbent upon an applicant to act with the utmost good faith and to include in the complete specification a full and complete description of the invention and the best method known to him of carrying it out. The specification must be so clear as to leave the public in no doubt as to what constitutes the invention for which the monopoly is claimed.

The grant of a patent does not, however, carry with it any guarantee that all the conditions have been fully complied with, and failure to comply with any common law condition and certain requirements of the Acts and Rules will render the patent invalid and so prevent the patentee from enforcing his rights at law.

Further, the grant does not carry any guarantee that that invention is one that can properly be patented, or that it is new, useful, or ingenious, all of which are necessary conditions for a valid patent. The grounds on which a patent may be held to be invalid are more fully discussed in Chapter V. If a patentee in the exercise of his rights seeks to prevent anyone from using his invention, or if he brings an action for damages in respect of infringement, or if there is any proceeding whatsoever in which the patentee is asserting or defending the rights arising from his patent, the patentee must be prepared

to substantiate the validity of the patent or of the claim which is infringed, if the validity is challenged.

Furthermore, the patentee is liable to have the patent challenged. Proceedings to revoke the patent may be brought either before the Comptroller or by petition to the High Court. The grounds on which revocation proceedings may be brought and the proceedings themselves are discussed in Chapter VII (A).

The patentee may also at any time have to meet an application by any person who alleges that there has been an abuse of monopoly rights under the patent and asks for relief by way of compulsory licence. The Patents and Designs Act, 1919, specifies the circumstances in which the monopoly rights shall be deemed to have been abused, and the powers which the Comptroller may exercise at his discretion, if he is satisfied that a case of abuse has been established. This subject is further considered in Chapter VII (B).

A patentee must not threaten anyone with proceedings for infringement unless he is prepared to substantiate the threats by bringing an action(y).

A patentee is also under certain restrictions in respect of contracts relating to the sale, lease or licence of a patented article; these are more fully dealt with in Chapter VI (A), (4), (e).

Where, after the 25th August, 1907, a patent is granted to two or more persons jointly, they are, unless otherwise specified in the patent, treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any agreement to the contrary, each patentee is entitled to use the invention for his own profit without accounting to the others, but is not entitled to grant a licence without their consent, and on the death of any patentee, his beneficial interest devolves upon his personal representatives as part of his personal estate(z).

Subject to such obligations and liabilities the patentee has, when the patent is sealed, the right to prevent others from making, using or selling his invention, and he can obtain

(y) See Chap. VII (C), p. 160

(z) Sect. 37.

damages for infringement, provided that he can establish the validity of one or more claims of the patent that have been infringed. Infringement is the unauthorized making, using or selling of the invention by a person who is not a patentee. Infringement actions are considered in Chapter VI (A).

The patentee after the patent is sealed is also at liberty to deal with his rights, either by way of assignment or licence, and provision is made for registering all assignments, or other dealings or interests in a patent, in the Register kept at the Patent Office. The transfer of patent rights is dealt with in Chapter VI (D).

At any time after the sealing of a patent a patentee has the right to have his patent indorsed with the words "licences of right," and to have this entered in the Register. Where this is done, any person is entitled as of right to a licence under the patent on such terms as, in default of agreement, may be settled by the Comptroller on the application of either the patentee or the applicant for a licence. This subject is further considered in Chapter VI (C).

TERRITORIAL EXTENT OF PATENT.

A British patent extends to, and affords protection throughout, England, Wales, Scotland, Ireland, and the Isle of Man. Subject to the use of an invention in a foreign vessel in British waters under certain conditions^(a), the protection also extends to territorial waters. With regard to certain legal proceedings, the application of the Patents Acts to Scotland, Ireland, and the Isle of Man is governed by Sects. 94, 95, and 96^(b).

(a) Sect. 48 and *post* p. 80.

(b) *Post* pp. 215–216.

CHAPTER II

HOW TO OBTAIN A PATENT

THIS chapter deals with the steps to be taken by a person who, being possessed of an invention wishes to protect it by obtaining a patent. The subject will be dealt with under the following heads—

- (1) The application.
- (2) The specification.
- (3) Procedure in the Patent Office.
- (4) Notes on special types of patents.

(1) THE APPLICATION.

The application must be made on an application form^(a), the particular form to be used depending upon who the applicant is, and the protection or type of patent sought. The ten application forms given in the second Schedule of the Patents Rules, 1920^(b), provide for different combinations of circumstances indicated by the headings on the forms and each includes marginal notes for guidance in filling up the forms. The following are important points to observe—

The applicant or joint applicants must sign the application form personally and must personally sign the authorization for an agent to act, if an agent is employed^(c).

In the case of an application to which a body corporate or limited company is a party, the seal of the company must be affixed, and the secretary or other responsible official should sign the form and state the capacity in which he signs, as, for example, "Secretary" or "Director." In the event of the official signing being the inventor or a party to the application as an individual, he must sign the form in his individual capacity in addition to signing in his representative capacity. Where a firm is a party to an application the individual members of the firm must sign the form.

(a) Sect. 1 (2); Rule 10. (b) Appendix IV, p. 222. (c) Rule 9.

In the case of an application being made by the legal representative of an inventor, the probate of the will or the letters of administration, or an official copy of such probate or letters, must be produced to show the applicant's title^(d). The Comptroller is empowered to require further evidence of the applicant's title to apply.

The application contains a declaration to the effect that the applicant is in possession of an invention whereof he, or in the case of a joint application, one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent^(e). It is thus important in filling up the application form that the name or names of the actual inventor or inventors should be correctly given, as if it is subsequently shown that the actual inventor was not a party to the application the application is bad. It will be noted that while for an ordinary application a body corporate (e.g. a limited company) cannot be an inventor, and the sole applicant (although it may be joined as an applicant with the inventor), in the case of a communication from abroad (*see* Form 1A), and in the case of an application under the International Convention (*see* Form 1B), a limited company may be the sole applicant^(f).

An application for a patent under the International Convention must be made within twelve months of the date of the first application made abroad^(g). The application must specify all the Foreign States or British Possessions in which applications for the invention have been made and the respective dates of application. A certified copy of the specification and drawings or documents filed with the first foreign application must accompany the application, or be filed within three months thereof. If these documents are not in English a translation, verified by statutory declaration, must also be furnished^(h).

Applicants for patents and patentees must supply an address for service in the United Kingdom. Alternative addresses for service may be subsequently entered in the Register of Patents⁽ⁱ⁾.

(d) Rule 11.
(e) Sect. 1 (3).

(f) ¹See p. 8.
(g) Sect. 91 (1) (a); Rule 15.

(h) Rule 16.
(i) Rule 8.

The application forms may be modified to meet any combination of circumstances that may arise which are not provided for(i), as, for example, where the invention is in part that of the applicant and has been in part communicated from abroad. In this case Form 1A may be modified to make this fact clear. Such cases are, however, comparatively rare. It is not necessary to use the official printed forms provided the formal parts are followed.

The title must appear on the application form as well as on the specification or specifications subsequently filed. It must sufficiently indicate the subject-matter of the invention(ii) but should not (1) be too wide and ambiguous, (2) be of a fancy nature, or (3) be too descriptive. A title, such as "Electrical Apparatus," would be too wide if, in fact, the invention relates to "electric bells." Titles which include the inventor's name, the word "patent" or a fancy word are not allowed, as, for example, "The John Jones Camera" or "An Infallible Calculator." The title should not, on the other hand, be descriptive or too prolix; it should indicate not what the invention is or its merits, but simply, and as precisely as possible, the subject-matter to which it relates. The choice of a title is not unimportant, inasmuch as the title forms part of the specification, and, in construing the specification, the scope of the invention is, to this extent, limited by the title(k).

When the appropriate application form has been filled up and stamped, it must be lodged at, or sent by post to, the Patent Office, together with either a provisional specification or a complete specification(kk). In the case of an application for a secret patent the form need not be stamped.

The difference between a provisional specification and a complete specification has already been indicated in Chapter I(l). If the invention is in an embryo state and not fully worked out, it is not necessary to delay making an application so long as the nature of the invention can be described, and in such a case a provisional specification can be filed. Even

(j) Rule 5.

(ji) Sect. 3 (2).

(k) Case 66 (c).

(kk) Sect. 1 (3).

(l) See p. 9.

if the invention is fully worked out a provisional specification can be filed and any further or better methods of carrying out the invention included in the subsequent complete specification.

(2) THE SPECIFICATION OF THE INVENTION.

(a) **Provisional Specifications.** For the provisional specification Form 2 is provided^(m) and must be filed in duplicate. The duplicate may be a carbon copy. The specification must commence with the title⁽ⁿ⁾, which should be identical with that on the application form.

A statement then follows that the applicant or applicants "hereby declare the nature of the invention to be as follows." A fair description of the nature of the invention must be given^(o). It is not necessary to go far into details nor to describe how the invention is carried into practice. The amount of detailed information to include will, to a great extent, depend upon how far the industry, art, or manufacture to which the invention relates has advanced. Although not necessary it is, generally speaking, advisable to include as much information as the applicant has at the time, and to include, by way of example, one or more methods of carrying out the invention which the inventor has proved to be successful, or has reason to believe will be so. The reason for this is that, if the information given in the provisional specification is very meagre, and as the result of the search made when the complete specification has been filed, it is found that all the matter disclosed in the provisional specification is anticipated, it may be difficult to amend the complete specification without introducing disconformity between the two specifications to which objection may be taken and on which difficulties arise^(p).

It is inadvisable to include in the provisional specification any claims such as must be included in the complete specification. This is liable to cause subsequent embarrassment.

The description should be a complete document on the

(m) Appendix IV, p. 261.

(n) Sect. 2 (4).

(o) Sects. 2(1); 3 (2).

(p) See p. 27 *post*.

face of it. This does not, however, preclude making a reference to another publication in aid of the description, provided that such reference is reasonable or necessary, and that the publication is readily accessible to the public. It is obviously therefore not permissible to make the sufficiency of the description dependent upon a reference to an unpublished British or other specification even though it be one previously filed by the applicant.

It is not generally necessary at the provisional stage to describe the invention with reference to drawings, but, if drawings are filed, they must be prepared in strict accordance with the requirements set out in Rules 19 to 25(q).

The specification must be dated and signed at the end by every applicant or by the authorized agent.

(b) Advantages and Drawbacks of Filing a Provisional Specification. The advantages are as follows—

(1) The applicant obtains provisional protection from the date of application and he is thus enabled to demonstrate his invention to others and exploit it without losing his rights through publication(r) or otherwise prejudicing his position.

(2) If the invention has not been thoroughly developed or worked out, the period of nine months before filing the complete specification may be utilized for this purpose(s).

(3) The expenditure need only be £1 in the first place and within nine months before filing the complete specification the applicant can decide whether to proceed or not.

(4) An applicant can put in two or more provisional specifications, which are cognate, or modifications, the one of the other, and, if together they comprise one invention only, include them in one patent(t).

The only drawback is that the complete specification will not be published and the patent issued as quickly as if the complete specification is filed in the first instance. It is only in respect of infringements, after the acceptance of the complete specification, that damages can be obtained, and an action

(q) See p. 226.

(r) Sect. 4.

(s) Sect. 5 (1).

(t) Sect. 16.

claiming damages for infringement can only be brought after the patent is sealed(u).

(c) **Complete Specifications.** The complete specification must either be filed in the first instance with the application form, or within nine months after filing a provisional specification. The fee on filing the complete specification is £3. An application for an extension of time of one month only for filing the complete specification can be made(v) for which the fee is £2(w).

For the complete specifications Form 3 is provided(x) and it must be filed in duplicate. The duplicate may be a carbon copy. If a provisional specification has been filed, the number and date of the provisional specification must be given.

The specification must commence with the title(y), which must be identical with that on the application form and the provisional specification, if any. Then follows a statement that the applicant or applicants "do hereby declare the nature of the invention and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement." The complete specification must comply with this(z) and must contain sufficient information to enable a person reasonably skilled in the art to put the invention into practice. The complete specification must not, however, travel outside the invention foreshadowed in the provisional specification, otherwise there will be disconformity between the specifications, and complications, described hereafter, will arise(a).

It is not incumbent upon the inventor to describe how he arrived at his invention, nor is it necessary in all cases to state what has been done before, or how near someone else has got to his invention. The duty of an inventor is a positive one, namely, with the fullest *bona fides*, to describe the best way known to him of carrying out the invention and to leave the public in no doubt as to what constitutes the invention which he claims as his monopoly(aa). It is necessary for him

(u) Sect. 10.

(v) Sect. 5 (1).

(w) Appendix, p. 243.

(x) Appendix, p. 262.

(y) Sect. 2 (4).

(z) Sect. 2 (2).

(a) See p. 27.

(aa) Case 68 (a).

so to draft his specification that a person having a competent knowledge of the art or industry concerned will be able readily to ascertain from it the relation the invention bears to existing knowledge in the art or industry, and some reference to such knowledge may be a virtual necessity in order to define the monopoly clearly.

Whenever the invention can be illustrated by drawings, this forms one of the simplest and most effective ways of describing the manner in which the invention is to be performed, and it is the practice of the Comptroller to require drawings in such cases. The drawings must, in all cases, be prepared in accordance with the Rules(b), and a special leaflet explaining the requirements is issued by the Patent Office and can be had on application.

A complete specification must end with a distinct statement of the invention claimed(c). This statement may comprise one or more separate claims(d), which must be clear and succinct(e). The statement of claim, in effect, defines the boundary of the industrial territory to which the patentee has or claims the exclusive right, and it is essential for a valid patent that the boundary should be clearly defined and that it should be new territory. Claims should not include matter which is not described. In the case of inventions relating to substances prepared or produced by chemical processes, or intended for food and medicine, claims must not be included for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed, or by their obvious chemical equivalents(f).

(d) **Chemical Inventions.** An applicant for a chemical invention may be required to furnish typical samples and specimens(g). Where this requirement is made the samples and specimens must be put up and furnished in the particular manner set out in the Rules(h). The fact that such samples or specimens have been furnished will be notified by a

(b) Rules 19-26.

(c) Sect. 2 (4).

(d) Sect. 14 (2).

(e) Rule 14.

(f) Sect. 38A (1).

(g) Sect. 2 (5).

(h) Rule 38.

statement to that effect on the published specification and by advertisement in the *Illustrated Official Journal*, when the specification is accepted.

(3) PROCEDURE IN THE PATENT OFFICE.

The application and specification, when lodged at the Patent Office, are referred to an Examiner(i), who examines the documents to see that the requirements of the Acts and Rules have been duly complied with. When the complete specification is filed, a search also is made through prior British patents of the previous fifty years to ascertain if the invention claimed is anticipated(j). If any of the requirements are not complied with, or if anticipations of the invention are found, the applicants are notified and an opportunity is given to remove the objections and meet the requirements. The Comptroller has power to post-date the application to the date on which the requirements are complied with(k). The more important matters that commonly arise are as follows—

(a) **“Pro forma” Requirements.** These relate generally to the sufficiency and correctness of the forms and documents lodged, and to such particulars as those of the names, addresses, and nationality of the applicants, which must be fully and correctly given, to the legibility of the description, the suitability of the drawings, the identity of the titles, names, and addresses in the different documents.

(b) **The Title.** This may be objected to if it does not comply with the requirements already indicated. Where the title on a provisional specification which has been accepted is subsequently found to be inaccurate, it will generally be possible to amend it before the complete specification is accepted.

(c) **The Description.** Objection will be taken to description which is insufficient or not sufficiently clear, and the applicant will have to revise it and, if necessary, supply further explanation or information. In the case of unreasonably meagre descriptions, with a consequential addition of material subject-matter, a considerable risk is incurred of having the application

(i) Sect. 3 (1).

(k) Sect. 3 (2).

(j) Sects. 7 and 8.

post-dated under the powers of the Comptroller, referred to above.

(d) **“Manner of Manufacture.”** If it appears to the Examiner that the application is not for a manner of manufacture within the meaning of “invention” as defined by Sect. 93, objection will be taken. This is a ground for refusing the application unless the applicant can satisfy the Comptroller (or the Law Officer on appeal) that the application should proceed. The meaning of the term “manner of manufacture” has been discussed in Chapter I, and cases and examples arising thereon are discussed in Chapter V (2).

(e) **One Invention.** As every patent is granted for one invention only^(l), the application and specification must not comprise more than one invention. Where a specification comprises several distinct matters, they do not constitute one invention by reason only that they are all applicable to, or may form parts of, an existing machine, apparatus, or process^(m). A patent cannot, however, be held invalid on the ground that it comprises more than one invention^(l), and the question of how much it is possible to include in one patent depends very largely on the existing state of the industry or art. No positive rule or definition of one invention can be given, but difficulties often arise in connection with machinery or processes. For a machine, or combination of parts, forming essentially a new type, generally speaking one application only is necessary, and may include separate claims for the various subsidiary features or parts, independently of the whole. If, however, the invention relates to a known type of machine or process, then separate improvements in different parts or steps, which are not inter-related or inter-dependent, except in so far as they form part of the particular type, would probably have to form the subject-matter of separate applications. When objection is taken to an application on the ground that it comprises more than one invention, the applicant will be required to amend the specification, so as to limit it to one invention. Any matter cancelled from a specification may form the subject-matter of a separate

(l) Sect. 14 (2).

(m) Rule 13 (1).

application, which will, generally, be allowed to bear the date on which it was first included in the specification(**mm**). Where one complete specification filed with two or more provisional specifications is divided, each application will proceed with the date of the corresponding provisional specification(**n**). When any application is divided into two or more, the fees payable are the same as would have been payable had separate applications been made originally.

(f) **Searches and Anticipations.** When the complete specification is filed, the Examiner makes a search through British complete specifications within the previous fifty years and published before the date of the application(**o**). If, on investigation, it appears that the invention claimed has been, wholly or in part, claimed or described, the anticipating specifications will be notified to the applicant so as to give an opportunity to amend the specification and remove the objections on the ground of anticipation.

A period of two months is allowed, which may be extended on payment of a fee of 10s. (*see* Form 7) for each month after this(**p**). The Comptroller has also discretionary powers to enlarge these prescribed times(**q**).

If the objections are not removed at the end of the two months, or extended period, the Comptroller appoints a time for hearing the applicant or his agent, giving ten days' notice of the appointment(**r**). Unless matters are negotiated before or at the hearing, and satisfactory amendments decided upon, the Comptroller determines whether reference ought to be made in the specification to any, and, if so, what prior specifications by way of notice to the public, and in the event of the invention claimed being wholly and specifically claimed in any prior specification, whether he should refuse to grant a patent(**s**).

As an alternative to the insertion of a reference to a prior specification the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction

(**mm**) Rule 13 (1)

(**n**) Rule 13 (2).

(**o**) Sect. 7 (1).

(**p**) Sect. 7 (2); Rule 30.

(**q**) Rule 111.

(**r**) Rule 31.

(**s**) Sect. 7 (4); Rule 31.

and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. Application for an extension of the fixed period may be made (*see* Form 7) on payment of the prescribed fee (10s. for each month). If no communication is received within the fixed or extended period (if allowed), the references will be inserted(s).

The reference to a prior specification, or as it is called, a "statutory reference," is inserted after the claims in prescribed wording(t). The insertion of the reference does not necessarily carry with it an inference that the patent is invalid. It is essentially an indorsement by way of notice to the public.

The search also extends to British specifications published on or after the date of the application, in respect of applications of prior date, but, in this case, the only question is whether the invention has been wholly or in part *claimed* in any of these specifications(u). If so, substantially the same issues arise as above, but the Comptroller has no power to refuse the application(v). Also, the insertion of a reference will be conditional on the grant of a patent on the earlier application(vv).

The periods allowed for amendment, with or without extensions, are always subject to the provision that the complete specification must be accepted within the statutory period, that is fifteen months from the date of application. This period may be extended up to eighteen months by payment of extension fees(w).

The amended specification must comply with all the other requirements for a specification and, in particular, must be so amended that the invention claimed, after amendment, is particularly described and ascertained. The specification as amended must not suggest that the invention is broader than the claims specify, and this requirement is particularly relevant to cases in which the claims have had to be curtailed as a result of anticipation. If the description is not consistent with an amended statement of claim, consequential amendment

(s) Sect. 7 (4); Rule 31.

(t) Rule 32.

(u) Sect. 8 (1), (3).

(v) Sect. 8 (2) (4); Rules 33, 34.

(vv) Case 404 (c).

(w) Sect. 6 (5); Rule 39.

of the description will be necessary. This is often done by amending the opening portions of the description and re-stating the general features of the invention in such a way as to make it consistent with the amended claims. No amendment will be allowed by way of introducing matter which was not comprised in the original specification as filed, nor an amendment which makes the invention substantially different from that originally described.

The result of any official search can be obtained by any member of the public by application, on the prescribed form, at any time after the complete specification is accepted(x). Undue importance should not, however, be attached to this information, nor must it be concluded that the invention is not new by reason of the prior specifications cited. Naturally, it is often a matter of difficulty to decide whether or not a particular prior specification wholly or in part describes the invention claimed. When such doubt exists it is not unusual to inform the applicant of the prior specification. It is in the interest of the applicant to have such information and gives him the opportunity of revising the drafting of his specification. Moreover, the specification in its final form will most probably have been amended, and, in the absence of a statutory reference provided for under Sects. 7 and 8 of the Acts, it must be assumed that the Comptroller is satisfied that no objection exists on the ground of a prior description of the invention in the prior specifications. This assumption, although not conclusive as to the absence of any prior description of the invention, is at any rate favourable to the applicant as regards the novelty of the invention.

(g) **Disconformity.** If the invention claimed in the first instance, or after amendment, is not substantially the same as that described in the provisional specification, the Comptroller may refuse the application, or, with the consent of the applicant, cancel the provisional specification and post-date the application to the date of the complete specification. Where the complete specification contains an invention not included in the provisional specification, this may be removed

(x) Sect. 68, Rule 37.

and the Comptroller may allow an application for the removed matter to be made and treated as an application made on the date the complete specification was left(y).

Disconformity not infrequently arises as a consequential result of amending a complete specification to meet objections on the ground of anticipation. If after meeting the objections an amended claim is only saved from complete anticipation by matter not included in the provisional specification, there is clearly disconformity between the invention described in the provisional specification and the invention claimed. The applicant will then have the alternatives of : (1) agreeing to the cancellation of the provisional specification, and to the treatment of the application as having been made on the date at which the complete specification was left ; or (2) restoring the anticipated claims and having the application accepted with a statutory reference ; otherwise the application may be refused. In no case can the provisional specification after acceptance be altered or amended to meet the objection.

(h) **Post-dating.** If the application, specification, or drawings do not comply with the requirements, the Comptroller will require amendment and may direct that the application be post-dated to the date on which the requirements are met(z). This power is only in practice exercised as a result of serious imperfections in an application. If, for example, the invention is very inadequately described in the first instance, it may be necessary to post-date the application to the date on which a sufficient description is supplied.

Where the complete specification does not disclose and define the invention sufficiently to enable the Examiner to make the investigation prescribed under Sects. 7 and 8, a report to this effect is made, and when the requirements in this respect are complied with, the Comptroller has a discretionary power to post-date the application to a date which will leave sufficient time for the subsequent proceedings relating to the application(zz).

As has already been stated, the Comptroller has also

(y) Sect. 6 (3).

(zz) Rule 28.

(z) Sect. 3 (2).

discretionary power to post-date an application if there is disconformity between a provisional specification and the complete specification.

(i) **Manner of Making Amendments.** When any pages of a specification are cancelled they must be returned to the Patent Office cancelled, together with the amended specification and duplicates of any substituted pages. The cancelled pages should indicate what amendments have been made, or these should be stated in a covering letter^(a). Simply to re-draft a whole specification would, obviously, entail an unnecessary and avoidable waste of the Examiner's time, especially if the specification is long or complicated. If drawings are altered it may be necessary to file additional true copy drawings corresponding to the amended original drawings.

(j) **Interviews, Hearings, and Appeals.** When difficulties arise in connection with objections taken and requirements made by the Patent Office, it is possible to arrange an interview with the Examiner to discuss the issues raised. An interview is often the most economical and satisfactory way of clearing issues and arriving at a settlement of the application. If the Examiner is not satisfied with the case, the applicant, or agent, is given an opportunity of a hearing before the Comptroller, or his official deputy, and the applicant has the right of an appeal to the Law Officer from a decision of the Comptroller to require an amendment or to refuse a patent or to insert statutory references to cases cited as anticipating the invention^(b). No fee is payable in respect of a hearing before the Comptroller with regard to the application for a patent, but, if an appeal is made to the Law Officer, notice must be filed within fourteen days of the Comptroller's decision in the Patent Office (Patents Form 4) ^(c), and a duplicate unstamped notice sent to the Chief Clerk, Law Officer's Department, Royal Courts of Justice, London. The procedure is set out in the Patents Rules, 1920^(d).

(j) **Acceptance and Sealing.** When all the requirements have been met and the complete specification is in order, it is

(a) *I.O.J.* 21st Dec., 1910.

(c) Appendix IV, p. 263.

(b) Sects. 3 (3); 6 (4); 7 (5); 8 (4).

(d) Appendix IV, p. 303.

accepted by the Comptroller ; the acceptance is advertised and the application and specifications, with the drawings (if any), are open to public inspection(e).

An application should normally be accepted within fifteen months of the date of application, but an extension of time, up to eighteen months, may be obtained by application and payment of £2 for each month's extension(f). If the applicants express a wish to defer acceptance for any reason, this will usually be allowed up to the fifteen months period without fee. This request is often made when applicants wish to postpone publication until they have made applications for patents in foreign countries. Two months are allowed after acceptance in which an opposition to the grant may be entered(g).

If there is no opposition, or if the opposition fails, the Comptroller will on the request of the applicants, accompanied by the sealing fee of £1, seal and issue the patent(h). The patent must be sealed within eighteen months from the date of application, but an extension of time for sealing may be obtained, not exceeding three months, by paying an extension fee of £2 for each month(i). Where the period for leaving or accepting the complete specification has been extended, the period of fifteen months for sealing a patent is extended automatically by four months(j). Normally, therefore, it is possible for the sealing to be held up until twenty-two months after application. Where the sealing is delayed by an appeal to the Law Officer, or by opposition proceedings, the patent may be sealed at such time as the Law Officer or the Comptroller, as the case may be, directs(k). In the case of an applicant who dies before the patent is due to be sealed, the patent may be sealed, on the application of his personal representative, any time within twelve months of the date of death(l).

In cases where : (a) an applicant has agreed in writing to assign a patent when granted to another party or a joint applicant and refuses to proceed with the application ; or

(e) Sect. 9, and Rules 40 and 41.

(f) Sect. 6 (5), and Rule 39.

(g) Sect. 11 (1), and *see* Chap. III.

(h) Sect. 12 (1), and Rule 50.

(i) Sect. 12 (2) (d), and Rule 51.

(j) Sect. 12 (2) (a).

(k) Sect. 12 (2) (b).

(l) Sect. 12 (2) (c).

(b) disputes arise between joint applicants as to proceeding with an application; the Comptroller, on proof of such agreement to his satisfaction, or if satisfied that one or more of such joint applicants ought to be allowed to proceed alone, may allow such other party or joint applicant to proceed with the application and may grant a patent to him. All parties are entitled to be heard, and can appeal from a decision of the Comptroller to the Law Officer(m).

An application which is not accepted becomes void and for practical purposes is non-existent, but if it is an application under the International Convention, the complete specification may already have been published, as it automatically becomes open to public inspection at the expiration of twelve months after the date of the first application made abroad.

(4) NOTES ON SPECIAL TYPES OF PATENTS.

(a) **Patents of Addition(n).** When an applicant has an invention for an "improvement in or modification of" a previous invention, for which a patent has been applied for by or granted to him, he can, if he wishes, make a request in his application that the term of the patent may run concurrently and terminate with the original or, as it is termed, the parent patent. A patent granted with such conditions is known as a "Patent of Addition," and no renewal fees are payable beyond those payable in respect of the parent patent, but it remains in force only so long as the parent patent remains in force.

If the parent patent is revoked the patent of addition will, if the Court or Comptroller so orders, become an independent patent and the fees payable and the dates when they become payable are determined by its date. Its duration will not exceed the unexpired term of the parent patent.

There may be a patent of addition on a patent of addition, and so on. The test is whether all the inventions could have been protected under one patent(o). The specification must make it quite unambiguously clear that the invention comes fairly within the terms "an improvement in or modification of

(m) Sect. 12 (1), Proviso.
(n) Sect. 19.

(o) Case 306.

the original invention.” It may not cover an improvement on an invention not contained in the parent patent(p). Once granted, however, the validity of the patent cannot be challenged on the ground that the invention ought to have been the subject of an independent patent(q).

(b) **International Convention Applications.** Where an application is made under the International Convention, the application and complete specification must be lodged within twelve months from the first application for protection in any foreign state or British possession, in which the Convention is in force(r). The application must be made in accordance with special rules(s). Every application, which has been made in convention countries, must be declared, and if for the purpose of obtaining any advantage one or more of such applications is or are omitted, the patent, if granted, will be invalid. If the application is not accepted within twelve months from the date of the first foreign application, the application becomes open to public inspection(t). An abridgment is forthwith made and published in the *Illustrated Official Journal (Patents)*. The application must be for the same invention as is applied for abroad, and the claims must not include anything not comprised in the application made abroad. No modification or enlargement is possible, as it would then clearly not be for the invention applied for abroad. The applicant gets protection from the date of the first foreign application, and after this date the invention can be freely published without jeopardizing the patent rights, but the patentee obtains no rights to recover damages for infringements happening prior to the date on which the specification is accepted(u).

(c) **Secret Patents.** A secret patent is only obtainable in respect of an invention relating to instruments or munitions of war, the benefit whereof has been assigned to the Secretary of State for War or to the Admiralty, or to the President of the Air Council. The inventor ceases to have any rights or

(p) Case 195.

(q) Sect. 19 (4).

(r) Sect. 91 (1) (a).

(s) Rules 15 and 16 and p. 17 *ante*.

(t) Sect. 91 (3) (a).

(u) Sect. 91 (1) (b).

interest in the patent, but must look to his agreement with the Government for his remuneration. Special provisions and procedure relating to secret patents are prescribed by the Acts and Rules(v). No fees are payable in respect of such patents.

(d) **Single Patents for Cognate Inventions.** Where an applicant has put in two or more applications, accompanied by provisional specifications, for inventions, which are cognate or modifications one of the other, and has obtained provisional protection for these, it is possible, if the two or more specifications comprise a single invention, to file one complete specification in respect thereof(w). If a single patent is granted, it bears the date of the earliest of such applications, but, in considering the validity of the patent, and in determining any other questions that may arise, regard will be had to the respective dates of the provisional specifications relating to the several matters claimed in the complete specification(x).

(v) Sect. 30, and Rules 98-100.

(x) Sect. 16 (2).

(w) Sect. 16 (1).

CHAPTER III

OPPOSITION TO THE GRANT OF A PATENT

AFTER the advertisement of the acceptance of the complete specification has appeared in the *Illustrated Official Journal (Patents)*, and before the patent is sealed, two months are allowed to elapse in which opposition may be entered to the grant(a). If opposition is entered, the sealing is delayed, pending the decision of the Comptroller, and any appeal from that decision to the Law Officer(b).

THE GROUNDS OF OPPOSITION.

The opposition must be based on one or more of the following grounds.

(1) That the applicant obtained the invention from the opponent or from a person of whom he is the legal representative(c).

(2) That the invention has been published in any complete specification, or in any provisional specification followed by a complete specification, deposited pursuant to any application made in the United Kingdom within fifty years next before the date of the application for the patent the grant of which is being opposed, or has been made available to the public by publication in any document (other than a British specification) published in the United Kingdom prior to the application(d).

(3) That the invention has been claimed in any complete specification for a British patent which, though not published at the date of the application for a patent, the grant of which is opposed, was deposited pursuant to an application for a patent which is, or will be, of prior date to such patent(e).

(4) That the nature of the invention, or the manner in which it is to be performed, is not sufficiently or fairly described and ascertained in the complete specification(f).

(a) Sect. 11 (1).

(b) Sect. 12 (2) (b).

(c) Sect. 11 (1) (a).

(d) Sect. 11 (1) (b).

(e) Sect. 11 (1) (bb).

(f) Sect. 11 (1) (c).

(5) That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification(g).

(6) That in the case of an application under Sect. 91 of the Act, the specification describes or claims an invention other than that for which protection has been applied for in a foreign state or British possession, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the application in the foreign state or British possession and the leaving of the application in the United Kingdom(h).

These grounds will now be considered separately in detail.

The First Ground. This is that the applicant obtained the invention from the opponent or from a person of whom the opponent is the legal representative. The only person who can oppose on this ground is the person from whom the invention has been obtained or the legal representative of such person if deceased; a legal representative does not include an attorney or assignee(i).

The obtaining must have taken place within the United Kingdom or the Isle of Man, for the Courts will not take cognizance of the methods, whether fraudulent or otherwise, by which the invention was obtained abroad(j).

There are two classes of cases—

(a) Cases of fraud, where the applicant has stolen an invention from the inventor and in fraud of him attempts to get a patent.

(b) Joint inventions where the applicant and the opponent have consulted together or where ideas and suggestions of the opponent have been communicated to or worked out by the applicant and incorporated into the patent.

(a) **CASES OF FRAUD.** These cases involve moral turpitude, and if the facts be adequately proved, the Comptroller will refuse the grant to the applicant; but the applicant will be

(g) Sect. 11 (1) (d).

(i) Case 434.

(h) Sect. 11 (1) (e).

(j) Cases 310, 113.

given the benefit of any doubt, as it will still be open to the opponent, after the patent is sealed, to present a petition to the High Court for its revocation on this ground^(k).

Where the opponent is successful on this ground and the patent is refused, he may apply for a patent in respect of the whole, or any part, of the invention, which, in fact, is really his, and ask that it may bear the date which the application successfully opposed would otherwise have borne^(l).

It may be noted here that a fraudulent application for an invention, or the publication or use thereof between the date of such fraudulent application and the sealing thereof, do not invalidate a patent granted to the true and first inventor, so that if the latter successfully opposes the fraudulent application, his application and patent are in no way jeopardized by any action of the fraudulent applicant^(m).

(b) JOINT INVENTIONS. These cases do not necessarily involve moral turpitude. It may happen that there is a *bona fide* difference of opinion as to who was responsible for certain ideas or suggestions, and after the lapse of some months an applicant, who is the chief inventor and has developed the ideas underlying the invention, is very prone to forget the assistance he has received from others in evolving the invention.

If such a case is made out, the grant would probably not be refused but allowed subject to certain conditions⁽ⁿ⁾, such, for example, as—

(1) to disclaiming or cutting out that part (if severable from the rest) suggested by or obtained from the opponent ; or

(2) to the opponent being joined as a patentee in the grant, i.e. as if there had been a joint application ; or

(3) to the opponent being given some interest of the patent, e.g. by being given some shares in a limited company to which the patent is to be assigned.

The Second Ground. This enables a patent to be opposed if the invention has been published in any British patent specification within the fifty years previous to the

(k) Case 442.

(l) Sect. 15 (2).

(m) Sect. 15 (1).

(n) Case 22.

date of the opposed application (other than in a published provisional specification not followed by a complete specification), or in any publication other than a British specification at any prior time. Where such other publication is relied on, it must be shown that the information it contains is not merely published in the strict legal sense, but that it is "made available to the public," e.g. as in the case of a magazine, trade journal or even, perhaps, a foreign specification(o). Where a British specification is relied on, it is not necessary that a patent should actually have been granted and sealed at the date of the opposition, but the specification must have been published.

Two sets of cases may arise.

(1) The whole or some definite part of the invention in the application opposed may be substantially anticipated. The question at issue will not be whether in view of the alleged anticipation, inventive ingenuity would be required to arrive at the invention in the application opposed, but whether there is or is not substantial prior publication(p). In other words, identity of invention is the real issue. One test which may be applied is whether the difference is such as might prevent an action for infringement, based upon the former patent, from succeeding(pp). In considering the prior publications, however, it may be necessary to consider not only whether the prior publication amounts to a prior disclosure of the invention, but also whether the difference, if any, is real and substantial. The validity of prior patents alleged to anticipate is not material(q), and only in special circumstances will experimental proof of utility be required(r). If the inventions are identical, or if the difference depends merely upon mechanical equivalents and comprises nothing really new and patentable, the patent will not be saved(s). If the whole invention is not anticipated amendment will generally be possible, and will be required so as to limit the application to matter which is new.

(o) As to publications *see* Chap. V,
post p. 60

(p) Case 455.

(pp) Case 41 (a).

(q) Case 454.

(r) Case 404 (a).

(s) Cases 402, 473, 429 (b).

(2) The invention in the application opposed may, wholly or partly or in some definite way, embody or be dependent on an invention claimed in a prior patent. In such cases the grant would not be refused, but the opposition may be met by a disclaimer or an amendment of the description^(t).

When the opposition is not strong enough to justify the Comptroller in refusing to grant a patent, he may still insist on an amendment of the specification with the object of clearly defining it and limiting the claim to what is new. Whilst reasonable amendments are generally allowable, they are not allowed as a matter of course, and extensive amendments or alterations, which amount to a re-casting or re-writing of the specification, will not be allowed^(u).

Amendment is sometimes made by way of disclaimer, the object of which is to give notice to the public that some part of the invention, or the basis or principle underlying it, is itself old. A disclaimer may be in the form of a general statement, or may contain a specific reference to a prior patent.

SPECIFIC REFERENCES are generally inserted in such cases as the following^(v)—

(i) Where the prior patent relied on is one which discloses a new and important pioneer principle and claims in general terms its practical applications. Such patents are frequently referred to as “master patents.” They do not, however, include patents which comprise merely improvements in a machine or process^(w).

(ii) Where the prior patent, although not a master patent, clearly claims a distinct invention, which is free from anticipation and is wholly or substantially claimed in the patent opposed with some small improvement, addition, or variation.

(iii) Where the specification of the patent opposed is so drafted that it would be impossible or difficult, by mere amendment or general reference, to limit it to the true scope of the invention and distinguish that invention from what has gone before.

(t) Cases 237, 478.

(u) Cases 169, 176.

(v) Case 237.

(w) Case 278.

Specific references are not inserted for the benefit of prior patentees, but for the information of the public(x).

In view of the extension of the ground of opposition to prior publications, other than British specifications, there would not appear to be any reason why in the future specific reference should be confined to prior patents only, and should not include specific references to other prior publications.

“*LOCUS STANDI*.” An opponent must have some interest at stake to entitle him to oppose on the above ground. He may be interested as an original applicant or assignee in a prior patent cited, or he may be conducting a *bona fide* business (manufacturing or trading), which may be interfered with by the patent if granted, but, in any case, the interest must be real, definite, and substantial, and must be a present, not a prospective interest(y).

The Third Ground. This enables a grant to be opposed if the invention is claimed in the specification for a British patent which bears, or will bear, a prior date, although the specification was not published at the date of the application for the patent the grant of which is opposed. For example, it may happen that an application (A) is made for an invention, and that a subsequent application (B) is made for the same invention which, under the International Convention, receives a date earlier than (A). In these circumstances the specification (B) could be relied on in an opposition on the third ground(z). It will be noticed that the invention must be *claimed* in the specification relied on, whereas in the second ground a *description* in the prior specification is sufficient. Also, any adverse decision will be conditional upon the grant of a patent on the application on which the opposition is based(a). With these limitations the issues that may arise are substantially the same as those which arise on the second ground, and they are determined solely by the extent to which the invention is claimed in the opposing specification(aa). The opponent must also have a *locus standi*, as above.

The Fourth Ground. This refers to the fact that the

(x) Cases 479.

(z) Case 404 (i).

(aa) Case 404 (g).

(y) Cases 321, 347, 404 (e) and (f).

(a) Case 404 (c).

nature of the invention, or the manner in which it is performed, is not sufficiently or fairly described and ascertained in the complete specification. The opponent must show that some of the statements in the complete specification are insufficient or misleading or irrelevant or unfair. The owner of a trade mark, consisting of a word, is entitled to oppose on this ground where the specification uses that word as a general descriptive term(b). The complete specification should be clear and accurate in fact, free from doubt and ambiguity, and should not describe things which have no connection with the invention claimed(c).

An opposition on this ground may be met by amending the specification, but not by alterations amounting to a re-casting or re-writing of the specification, and extensive amendments may not be allowed(d).

This ground of opposition should always be taken where the second ground (prior publication) is relied on ; for, although the Comptroller has a wide discretion to insist on amendments in cases falling within the second ground, his jurisdiction, under the fourth ground, is clearer and probably wider(e). To oppose on this ground an opponent must have a *locus standi*, that is he must show *bona fide* and satisfactory reasons for wishing to oppose(ee).

The Fifth Ground. This is known as the ground of disconformity. It may be noted here that a patent cannot be held invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof(f). The only person who is entitled to oppose on this ground is one who has between the dates of the provisional and complete specifications actually applied in the British Patent Office for a patent for the invention which is described in the complete, but not in the provisional, specification(g).

(b) Case 404 (k).

(c) Case 169.

(d) Cases 169, 176.

(e) Case 478.

(ee) Case 404(e).

(f) Sect. 42.

(g) Case 404 (h).

It does not follow that because there are differences between the invention described in the provisional specification and that described in the complete, therefore there is disconformity; an allowance must be made for legitimate development^(h).

The proper test is, first, to ascertain what is the invention claimed in the complete specification, and then to read the provisional specification to see if the invention is adumbrated or foreshadowed therein, or is a legitimate development of what is there described⁽ⁱ⁾.

If disconformity is shown to exist, the opposition will, generally, be met by an amendment of the specification, if this is reasonably possible.

The Sixth Ground. This ground applies only to applications under the International Convention; as has already been pointed out, such applications are antedated and given the earliest date on which application has been made in any convention country or colony.

The person to whom this ground of opposition is available is one who has applied for a British patent during the interval between the date to which the application opposed is antedated and the actual date of such application in the British Patent Office.

The opponent must prove that the invention in the patent opposed is: (i) the same as that applied for by him; and (ii) different from that for which protection was applied for in the foreign state or British possession.

THE PROCEDURE IN OPPOSITION CASES.

(a) **Notice of Opposition.** A formal stamped notice of opposition must be sent to the Comptroller within the prescribed time of two months from the advertisement of the acceptance of the application opposed. The notice must state the ground or grounds of opposition, which must be one or more of those set out above. The notice must be signed by the opponent or opponents personally^(j). Any person possessing the requisite interest may be an opponent, and this includes a limited company.

(h) Case 150.

(i) Case 172 (c).

(j) Rule 42.

In the case of two or more sets of opponents to the grant of one and the same application, the oppositions are, usually, disposed of at one hearing.

Where a party giving notice of opposition neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller may order such party to give security for costs and, in default, the proceedings may be treated as abandoned(k).

The formal notice of opposition must be accompanied by : (1) an unstamped copy of the notice ; and (2) a statement in duplicate setting out fully : the nature of the opponents' interest ; the facts upon which he relies in support of his case ; and the relief which he seeks(l). It should be stated whether it is desired that the application should be refused or merely amended, and, in the latter case, the general nature of the amendments desired should be indicated. The portions of prior specifications or publications relied on should be clearly indicated, and, where the fourth ground of opposition is relied on, the statement should indicate in what respects the complete specification is insufficient or the description of the invention unfair.

The Comptroller sends a copy of the notice (1) and the statement (2) to the applicant, whose patent is opposed. The normal procedure after this is as follows—

(b) **Counter-statement by Applicant.** If the applicant wishes, he can contest the opposition by submitting a counter-statement, setting out fully the grounds upon which the opposition is contested. This counter-statement must be sent to the Comptroller within fourteen days, or such longer period as the Comptroller may allow, and a copy must be sent to the opponent(m).

(c) **Evidence to Support the Opponent's Case.** Within fourteen days, or such extended time as allowed subsequent to the delivery of the applicant's counter-statement, the opponent may file evidence by way of statutory declaration in support of his case and must send a copy thereof to the

(k) Sect. 73A (2).

(l) Rule 42.

(m) Rule 43.

applicant⁽ⁿ⁾. Evidence should be submitted in the following cases—

(i) Where the first ground of opposition is relied on.

(ii) Where the opponent relies on what he alleges is a master patent^(o).

The failure to leave evidence in the first of these cases would probably be interpreted as an indication that the opposition on the first ground is abandoned, and, in the second case, that it will not be contended that the prior patent relied on is a master patent.

(d) **Applicant's Evidence.** The applicant may, if he chooses, file similar evidence by way of statutory declarations in answer to the opponent's statutory declarations; or, in any case, if the opponent does not file such evidence, the applicant may still file his evidence. In the former case, the applicant's evidence must be filed within a fortnight after receiving the opponent's evidence, or such further time as allowed by the Comptroller. If the opponent does not file evidence the applicant may file evidence within fourteen days (or extended time specially allowed) after the expiry of the time allowed to the opponent to file his evidence^(p).

(e) **Opponent's Reply.** The opponent has a further opportunity of filing further statutory declarations in reply, but such declarations must be confined to issues already raised. After this, further evidence can only be given by leave or at the request of the Comptroller^(q).

(f) **The Hearing.** This is fixed by the Comptroller and the parties are entitled to ten days' notice. If either party does not desire to appear at the hearing, or be heard, he should forthwith notify the Comptroller. If either party desires to be heard it is equally necessary to give notice by filing the prescribed form. The Comptroller may refuse to hear a party who has not given notice^(r).

The applicant has the right to open the case and this is usually exercised, except in cases of opposition on the first ground. After the case is opened by one party and the

(n) Rule 44.

(o) Cases 433, 404 (d).

(p) Rule 45.

(q) Rules 45, 46.

(r) Rule 48.

evidence read or heard, the other party, or parties, are heard, and the party who opened is heard in reply. Witnesses who make declarations for any party may, by application to the Comptroller, be required to attend and be cross-examined by the other party or parties. The Comptroller may also order discovery and require the production of documents(s).

If any party intends at the hearing to refer to any publication or specification, which has not been specified in prior notices, or evidence, or declarations, notice must be given to the other party or parties, and to the Comptroller, five days before the hearing(t).

Witnesses may be examined on oath, and where there is any serious dispute of fact (which rarely happens except in cases of opposition under the first ground), the attendance will probably be required of persons who have made declarations, or other witnesses whose evidence may be required.

Where patents alleged to be master patents are relied on, evidence should be given that careful search has been made to discover if the principle has been previously disclosed. The applicant may, of course, rebut the evidence by citing prior publications which anticipate the invention in the alleged master patent.

(g) **“Locus Standi.”** Where, at any preliminary stage of the opposition proceedings, there is a doubt as to whether an opponent is entitled to oppose, the Comptroller may appoint a hearing to determine this matter before further steps are taken in connection with the opposition proceedings(u).

(h) **Decision and Costs.** After the hearing or, when there is no hearing, after considering the evidence and the specifications or other publications referred to, the Comptroller may give his decision forthwith or reserve it and give it subsequently in writing(v). In arriving at his decision the Comptroller may take into consideration any other specifications not referred to by the parties(w), but, if he intends so to do, notice thereof is usually sent to the parties.

The Comptroller has a discretion to award costs of opposition

(s) Sect. 77.

(t) Rule 48.

(u) Case 347.

(v) [Rule] 48.

(w) Case 244.

proceedings to either party and to direct that such costs should be paid by any other party(**x**). It is usual to award costs to the successful and against the unsuccessful party, or parties, and a fixed sum is usually awarded, which may be only a small part of the expenses actually incurred. An order for payment of costs may be made a rule of the High Court to enable its enforcement by execution or otherwise(**x**).

(i) **Appeal to Law Officer.** Any party may appeal from the decision of the Comptroller to the Law Officer, by filing, within fourteen days at the Patent Office, a notice of his intention, stating the nature of the decision appealed against and whether the whole or part only (and if so, what part) is objected to ; a copy of the notice must be sent to the Chief Clerk, Law Officer's Department, Room 549, Royal Courts of Justice, London, and also to the other party or parties.

The Law Officer appoints a day for hearing the appeal and seven days' notice is given to the parties.

The hearing of the appeal takes place in the Law Officer's Room, in the Royal Courts of Justice, London, and the practice as to security for costs, awarding costs, the attendance of witnesses for cross-examination, and other matters is set out in the Patents Rules, 1920(**y**).

Where the matter is one of great technical difficulty, the Law Officer may, if he thinks fit, appoint an expert to sit with him ; but this power is seldom exercised(**z**).

(**x**) Sect. 73A (1).

(**y**) Appendix IV, p. 303.

(**z**) Sect. 11 (3).

CHAPTER IV

THE CONSTRUCTION OR INTERPRETATION OF THE COMPLETE SPECIFICATION

GENERAL CONSIDERATIONS AND PRINCIPLES.

WHENEVER a patent comes before the Court (e.g. in infringement proceedings or on a petition to revoke it), it is from a consideration of the complete specification^(a), that the nature, extent and limits of the invention are determined, and for this purpose it is necessary to construe the specification. This construction is the province of the Court (i.e. of the Judge, not the witnesses^(b)), and it is of the greatest importance to the patentee to know what construction the Court will put upon the document. In this respect, there are two dangers which face all patentees; on the one hand, the specification may be construed so broadly as to include something which is wanting in novelty, utility or inventive ingenuity, and hence the claim or claims covering that feature will be found invalid; or, on the other hand, the specification may be construed so narrowly that others may be able to use the essence of the invention and yet not infringe the patent^(c). The patentee is naturally anxious as to whether or not his specification oversteps one or other of these extremes or occupies a position between the two.

As a general rule, in construing a document, the Court has regard only to the language and words used, and will not hear evidence as to their meaning; but a patent specification is an exception to this general rule, as it is assumed to be addressed to a person possessing a competent knowledge of the art or arts concerned, and its true construction is the meaning it would convey to such a person at the date of the patent^(d). To find that meaning the Court has to be informed about the state of knowledge in the art, including the meaning

(a) Case 79.

(b) Cases 464 and 79.

(c) Case 276 (a).

(d) Cases 360 (a) and (b), 35 (d),
145 (a), 62.

of technical terms and the exact method in which the invention works. This often involves the education of the Court in a very advanced branch of science, and for this purpose it is necessary to call expert witnesses, who are skilled in the art.

The terms "well informed artisan," "skilled workman," etc.(e), have often been used to designate the person to whom a specification is addressed; these and similar terms must be understood in the sense above explained.

When once the Court has construed a specification, that construction is binding in subsequent cases, unless it can be shown that the judge was misled by the omission of material evidence or by false evidence(f).

RULES OF CONSTRUCTION.

The principal rules which the Courts follow in construing a patent specification are as follows—

- (1) It is considered as a whole.
- (2) Its meaning is gathered from the words used.
- (3) It is construed in the light of the state of knowledge in the art or manufacture at the date it was published.
- (4) It is construed with a desire to preserve property rather than destroy it (*ut res magis valeat quam pereat*).
- (5) The extent and limits of the monopoly granted (i.e. of the invention claimed) are gathered from the claims, read in the light of the rest of the specification and the drawings (if any).

These rules of construction will now be further considered and explained.

(1) **It is considered as a whole.** The separate clauses or sentences of the specification must be read so as to bring them in harmony with the rest of the document. If a part or an extract be detached from the rest, it may appear to have a wider or different meaning to what it has in its proper context; therefore the whole specification must be looked at(g), and particular words must not be construed so as to defeat the meaning of the whole(h).

(e) Case 459 (c).

(f) Cases 73 (a), 166 (a), 361 (a),
145 (b).

(g) Cases 286, 295, 443 (a), 105,
362 (d).

(h) Case 111.

The Court will look at every part of the specification, including the drawings, and endeavour to give an effective meaning to each part(i).

This rule is most important when dealing with the claims (see Rule 5 *infra*) because, although the claims are separate and distinct from the body of the specification, they must not be read separately as if they stood alone, but in conjunction with the whole, and a strained or unnatural meaning must be avoided(j).

(2) **Its meaning is gathered from the words used.** The language of the specification will be construed according to the ordinary and natural meaning of the words used(k); that is to say, the meaning those words have in the art or manufacture with which the specification deals. The use of wide or general expressions, such as "or any other suitable means," will not, as a rule, have any effect on the construction of the specification; the invention will not be strictly construed because they are absent, nor will their presence make it broad enough to cover something essentially or substantially different(l).

Subject to evidence as to the state of knowledge in the art and meaning of scientific or technical terms, no extrinsic evidence may be given for the purpose of showing what the specification means. For instance, it is not admissible for the inventor to state what he meant when he used the words. If an expression unknown in the art or manufacture be used, or a known expression be used in a new sense, the patentee must make the meaning intended quite clear by giving his own definition in the specification. Evidence cannot subsequently be called to show the reason an amendment was made in the specification in order to throw light on its meaning(m); but after a specification has been amended, the Court in construing it is now, by virtue of the Act of 1919, entitled to refer to the specification as it was when accepted and published(n).

The provisional specification cannot be referred to in order

(i) Case 362 (a).

(j) Case 152 (a).

(k) Case 443 (a).

(l) Case 338.

(m) Case 55.

(n) Sect. 21 (7).

to supply a defect in the complete specification(o). The provisional specification may, however, be looked at to find what is the object of the invention(p), and where a particular variation of the invention is specifically mentioned in the provisional specification, but omitted in the complete, it must not be assumed that that variation is not covered by the complete specification, if on a fair construction of its language it appears to be so(q).

From this it may perhaps legitimately be deduced that, as the function of the provisional specification is to describe the nature of the invention, it may be referred to for that purpose, but it must not be referred to for the purpose of amplifying, supplementing, or limiting the proper construction to be put on the complete specification.

The natural and proper meaning must be given to the words of the specification, irrespective of what the result of so doing would be, and the meaning must not be strained in favour either of the patentee or of the public(r).

The Court will not refrain from putting the proper construction on the specification by reason of small errors or apparent and minor inconsistencies, nor, on the other hand, will it violate the obvious meaning of the words used ; it will not strain at a gnat or swallow a camel.

(3) It must be construed in the light of the state of knowledge in the art or manufacture at the date it was published. With the constant advance of knowledge in art and manufacture, it often happens that some years after it is published a specification may appear to bear a different meaning to that which it bore on the day it was published. It is the province of the Court to find out by means of evidence the state of knowledge at the date of the publication, and this means the knowledge in the art or manufacture, i.e. the knowledge of a person well versed in the art or arts concerned(s) ; not the knowledge of the scientific expert investigator on the one hand, or that of the man in the street on the other.

The knowledge of the art does not include everything which

(o) Case 307.

(q) Case 410.

(s) Cases 62, 386, 459 (c).

(p) Case 362 (b).

(r) Cases 105, 386, 111.

has been published, but simply comprises the common knowledge which one would expect to find among men experienced and well versed in the art. For instance, a complete specification of a patent, published in 1878, referred to a substance as naphthylamine; at that date there were known, chemically, two naphthylamines, viz., alpha- and beta-naphthylamine. Of these two, only the former was known in the art or manufacture of the chemical industry, and was commonly referred to simply as naphthylamine, beta-naphthylamine being a scientific or laboratory curiosity. Some few years later, beta-naphthylamine became known commercially, so that at the date when the Court was called upon to construe the specification, the term naphthylamine would include both the alpha as well as the beta variety, and this would have invalidated the patent, as beta-naphthylamine was useless for the purpose of the invention. But the Court held the patent valid, because in the art or manufacture at the time of publication, the term naphthylamine meant only alpha-naphthylamine^(t).

It is often said that it is the province of the Court to ascertain what the inventor meant by the language he used in his specification^(u); but this is only true on the assumption that the inventor was in the position of a person of competent knowledge in the art or manufacture; if the inventor, for instance, were an eminent professor, the question would be, not what he meant, but what meaning would be conveyed by the specification to the person of competent knowledge—often a very different thing.

The question whether a specification is to be construed broadly or narrowly, that is to say whether a patentee is confined to the details as described in his specification, or is entitled to a broader interpretation for his invention, is decided by the application of this rule. Where, according to the true interpretation of the specification in the light of the existing state of the art, the invention is found to consist of a new principle or idea, and a method of applying it, or a new combination or process which produces a new and useful result, then the Court will construe the patent as covering

(t) Case 35 (f).

(u) Case 360 (b).

any other devices which are equivalents of the parts actually specified by the inventor(v). But if the invention is one of detail or mere improvement it will be construed strictly(w).

For example, a claim which calls for the use in a chemical process of a particular chemical compound will not be held to cover the use of any other chemical compound, unless it was known as an equivalent therefor at the date of the patent(x).

The so-called principle of "equivalents" should not be looked on as a rule of construction applicable to certain patent specifications and not to others; the rules of construction are the same for all, but a person of competent knowledge to whom the patent is presumed to be addressed, and who is acquainted with the state of the art or manufacture, will naturally give a broad interpretation to an invention, the importance and far-reaching qualities of which are obvious to him, although from a mere consideration of the words of the complete specification, the ordinary person would be inclined to look upon the invention as a narrow one(y).

A patentee is not bound in terms to point out any or all of the advantages of the invention, but to describe fairly and definitely what his invention is. The Court will not, however, construe the specification so as to limit the invention to the achievement of certain advantages unless those advantages are set out as being vital(z).

(4) **It must be construed with a desire to preserve property rather than destroy it** (*ut res magis valeat quam pereat*). This rule means that where a specification is fairly capable of two constructions, one of which would be fatal to validity, but the other avoids invalidation, the valid construction will be preferred(b). Apart from this, it is wrong to suppose that the Court will give the specification a benevolent construction(c). The Court will not lean towards either the patentee or the infringer, nor, on the other hand, will it take hold of small verbal inaccuracies or technical difficulties in order to deprive

(v) Cases 388, 151 (a), 350, 468, (y) Case 220.
35 (a), 312. (z) Case 98.

(w) Cases 461 (b), 56, 476 (a), 44. (b) Cases 443 (a), 362 (e), 365 (a);

(x) Cases 35 (a), 350. (c) Cases 365 (b), 362 (d).

the genuine inventor of the benefit of a real and genuine invention^(d); it will construe not malevolently but fairly, with a mind willing to understand and not desirous of misunderstanding^(e).

(5) The extents and limits of the monopoly granted (i.e. of the invention claimed) must be gathered from the claims read in the light of the rest of the specification and the drawings (if any). The claims are to be looked at as intending to define the invention and to point out what is new and for what protection is claimed^(f). They are for the security of the patentee, to prevent it being said that he has claimed more than can really be supported^(g). They are also intended to enable the public readily to ascertain what they are to refrain from doing. If something is described in the body of the specification, but omitted from the claims, it is not a part of the invention and must be considered as disclaimed^(g).

Generally speaking, where a claim is clearly for the combination of certain definite parts or elements, the protection thereby granted is for the entire combination and not for the parts or elements by themselves or for other combinations thereof, even if they might have been validly so claimed; to be protected, the separate elements or different combinations must be separately claimed^(h). Theoretically, therefore, it cannot be said that one part of a combination is more important than the others, or constitutes the novelty of the invention, but, in practice, such an inquiry often becomes necessary to decide questions of infringement⁽ⁱ⁾. The Court will not allow an infringer to escape who borrows the substance of an invention merely because he makes variations in unimportant details in the claim⁽ⁱ⁾.

A claim must not be extended to something which its language does not naturally include^(k), but must be construed according to the fair meaning of its language read in conjunction with the specification as a whole. The proper way is

(d) Case 105.

(e) Case 295.

(f) Cases 105, 205.

(g) Cases 253, 233 (a).

(h) Cases 142, 136.

(i) Case 346.

(j) Case 312.

(k) Case 276 (b).

to read the specification first and then consider the claim, not the claim first and then the specification(l).

If the patentee desires to claim all methods of applying a new principle, or of producing a given effect, it is his duty to make that intention reasonably clear, and he must state in explicit terms what the principle is. The Court ought not to be called upon to spell out such an intention from the use of ambiguous language. A claim for the universal application of a principle must appear from the words of the claim itself, and must not be left to an inference resting on a general review of the specification, or "a general research among the language employed therein for the meritorious element of principle or idea"(m).

A different meaning must, if possible, be given to each claim(n), where there are more than one, but if two or more claims cover the same ground the patent is not thereby invalid.

It is important, where there are several claims, to ascertain whether the subsidiary ones are appendant(o) or claims for subordinate integers(p). An appendant claim is one that claims some small or subordinate feature or element combined with the main invention; the novelty, utility, or inventive ingenuity to support it may be found in the main invention. A claim for a subordinate integer is a claim which protects some subsidiary feature or element independently of the main invention(q), and in such a case there must be novelty, utility, and inventive ingenuity in the subordinate integer itself.

Claims very often end with the words "substantially as described," or "substantially as and for the purposes described," or some similar words. As each claim must be read in conjunction with the specification which precedes it, these words, in the majority of cases, have practically no effect on the construction to be put on the specification or on the breadth of the claim; but, in some cases, they have a limiting effect and are inconsistent with a wide interpretation

(l) Cases 21, 459 (a), 251.

(m) Cases 3, 396, 204.

(n) Cases 362 (c), 66 (a).

(o) Case 470.

(p) Case 69.

(q) Case 152 (b).

of the claim(r). They will be read as applying to the whole claim and may limit it to a user of the invention in the manner described in the specification(s). Where certain elements or features are specifically mentioned in the claim, the words "substantially as described" will not by inference incorporate into the claim other elements or features not mentioned therein, although described in the body of the specification; they simply mean that the elements or features mentioned in the claim are to be substantially present in the combination which forms the invention(t).

(r) Case 322 (a).

(s) Case 78.

(t) Case 236.

CHAPTER V

THE VALIDITY OF THE PATENT

GENERAL CONSIDERATIONS AND GROUNDS ON WHICH A PATENT MAY BE HELD INVALID.

As already pointed out, the grant of Letters Patent does not convey with it any guarantee that the requirements for a valid patent have been complied with. This is so, notwithstanding that, prior to the grant of the patent, the examination and investigations, described in Chapter II, have been made in the Patent Office and that opposition proceedings may have been taken and have proved unsuccessful. If, in any legal proceedings subsequent to the grant of a patent (e.g. in an action for infringement), the validity of the patent is challenged, any issue or question which may have arisen and been decided at any stage prior to the grant of the patent can be raised again. The patentee is usually compelled to give *prima facie* evidence of the validity of his patent and, generally speaking, the enforcement of a patentee's rights at law depend upon his ability to establish the validity of the patent. An invalid patent is liable to be revoked^(a).

The Act of 1919 introduced a new provision, whereby the presence of one or more invalid claims does not prevent a patentee from obtaining redress for infringement of claims which are valid^(b), but a patent which includes invalid, as well as valid, claims is still presumably liable to be revoked, and revocation may be counter-claimed by a defendant in an infringement action. The combined effect of this possibility with the new provision is not altogether clear.

In determining the question of validity it is necessary, first, to ascertain what the invention really is, and this must be ascertained by construing the specification in accordance with the principles given in the previous chapter. It does not matter what the inventor thinks he has invented, or what

(a) Sect. 25.

(b) Sect. 32A.

article has been sold, or what process has been used as the invention ; with these matters the Court is not concerned.

The grounds on which a patent may be held to be invalid are—

- (1) That the grantee is not the true and first inventor.
- (2) That the invention is not a “ manner of manufacture ” within the meaning of Sect. 6 of the Statute of Monopolies.
- (3) That the invention is contrary to public policy.
- (4) That the invention is not novel.
- (5) That the invention is not useful.
- (6) That the invention is wanting in inventive ingenuity.
- (7) That the invention is insufficiently or improperly described or claimed in the complete specification.
- (8) That there is disconformity between the provisional and complete specifications.

In considering the validity of any claim of a patent it must be borne in mind that an objection is equally fatal if it applies to any material part of the invention claimed. Any part of the invention includes any aspect, phase, modification, or application of the invention covered by the claim in question. Thus, suppose an inventor describes and claims as the invention a certain process to be applied to a number of different articles or substances, it would be fatal to the validity of the claim that the process as applied to one of those articles or substances is not novel, or not useful, or not ingenious. The question must, however, be looked at broadly, and the Court will ask itself if the objection is a substantial one. If, for example, the objection were shown to apply to one *only* of 100 articles, the Court would probably support the patent on the principle of *de minimis non curat lex*. Similar considerations apply where several improvements in an article, or process, are separately claimed as parts of the invention(c).

Where, however, the invention claimed is a combination of certain elements, say, A, B, C, and D, whether they be steps in a process or ingredients in an artificial substance or parts of a machine, the combination of some of those elements, say, A, B, and C, or A, B, and D, does not constitute a part

of the invention, and it would, for instance, be no objection to validity to show that any of those last-mentioned combinations was not novel, or not useful, or not ingenious.

The grounds on which a patent may be held to be invalid will now be considered seriatim.

(1) **That the grantee is not the true and first inventor.** As previously explained, the inventor, or all the inventors if more than one, must be a party, or parties, to the original application, and, if the invention has been made either wholly or in part by a person who is not one of the persons to whom the patent is originally granted, then the patent is invalid(cc): except in the case of a patent granted under the provisions of Sect 12 (1) (a) to a person who may be the assignee of, or joint applicant with, an applicant who is the true and first inventor(d).

The "true" inventor is the person who has either himself evolved the invention or has imported it or introduced it from abroad.

The "first" inventor is the one who is first to impart the knowledge of, or give the benefit of, the invention to the public(dd). Where the imparting takes the form of obtaining a patent then the material date, and the one which determines the priority of an inventor, is the date of the patent, i.e. the date from which the monopoly or protection starts. In ordinary cases this is the date of the application. In the case of an application under the International Convention, it is the date of the first foreign application in a convention country(e). This is so, although the public may obtain no knowledge of the invention until the specification is published. Where the application for a patent is accompanied by a provisional specification, and the complete specification, when filed, is found to contain a further or different invention, then the material date, so far as the further or different invention is concerned, is the date of filing the complete specification(f).

In cognate patents, where there are two or more provisional

(cc) Cases 153.

(dd) Case 128.

(f) Sect. 42.

(d) See also pp. 11, 30.

(e) ante p. 32.

specifications, of different dates, each containing a part of the invention ; as regards each part, the patentee is entitled to the date of the earliest provisional specification covering that part(g).

If, however, no patent is granted on an application, or if the patent is revoked or is held invalid, then, for the purpose of determining the question of "first" inventor, the only material date is that of actual publication, whether by way of documentary or other description or by demonstration or use or sale. Thus, if two persons, A and B, make the same invention independently of each other, so that each is a true inventor, and A applies for a patent before B does so, then A is considered the first inventor, provided that he obtains a valid patent on his application, even if it can be shown that B had thought out his patent years before it occurred to A. But if B applies for a patent before any actual publication of the invention has taken place, and if A does not obtain a patent on his application, or obtains an invalid patent which is liable to be revoked, then B is the first inventor, subject to the possibility that A might cure the invalidity of his patent by amendment of the complete specification.

A patent is also invalid if the invention protected is validly protected by another patent of a prior date, even if the applicant for both patents is the same person(h). The reason for this is that the Crown cannot legally grant the same monopoly twice, and therefore the subsequent grant must be invalid, if the former one is valid ; but a patent granted under a Treaty of Peace Act, with an abnormal priority of date, does not invalidate a patent granted on an earlier application(i).

A person who has obtained an invention, fraudulently or otherwise, from another, cannot be a true inventor, and, therefore, cannot get a valid patent, unless the obtaining has taken place out of the United Kingdom and the Isle of Man ; the importer of an invention, however fraudulent he may have been in obtaining it abroad, is entitled to be considered as the true inventor(j).

(g) Sect. 16 (2). (h) Case 390 (a). (i) Chap. VI (L), p. 142. (j) Cases 113, 404 (i).

(2) That the invention is not a "manner of manufacture" within the meaning of Sect. 6 of the Statute of Monopolies. As previously explained, to satisfy this requirement, the invention must be some substantive article of manufacture or some process of or relating to manufacture^(k).

An article of manufacture is some substance or article which is produced wholly or partly by some one or more artificial processes. A process of or relating to manufacture is some step or series of steps or methods of working, affecting directly or indirectly an article of manufacture. For example, a process used in the manufacture of an article or substance or in its treatment so as to change its state or condition.

A mere discovery, a scientific fact, a law of nature, a scheme, an idea or a principle, cannot form the subject-matter of a valid patent^(l); but the practical application or use of any of the above in a manufacturing process may do so^(m).

A natural substance cannot form the subject-matter of a valid patent, but an artificial substance and a method of making it may, and also methods of using or applying or treating any article or substance in a manufacturing process.

The grant of Letters Patent has been refused for applications in which the alleged invention has been for a system of book-keeping, a system of business, a method of indexing or arrangement, or the mere use of a known substance, article or process which does not result in a new article or process of manufacture^(l).

(3) That the invention is contrary to public policy. Anything is contrary to public policy if its sole use be for a purpose contrary to public morals, or the laws of the land. If, however, the invention has a legitimate, as well as an illegitimate, use, it is not open to objection on this ground.

If an invention, for instance, could be used only for house-breaking purposes, or for gambling, then a patent for it (even if granted) would probably be held to be invalid⁽ⁿ⁾.

(4) That the invention is not novel. A valid patent cannot

(k) Chap. I, p. 1.

(m) Cases 107, 476 (b), 2 (b), 35 (b).

(l) Cases 2 (a), 325, 200, 257, 1, 485,

(n) Case 371.

477, 85, 30.

be obtained for an invention which is not new, and where the invention has, prior to the date of the patent, been used publicly or a description thereof has been published, within the United Kingdom or the Isle of Man, it is not new^(o). In other words, it has been anticipated.

Novelty must be judged by what has happened prior to the date of the patent in the United Kingdom or the Isle of Man. Nothing that has happened or existed abroad is relevant to this question. Where there is any substantial difference between the invention and what was public before, there is novelty, and a very small difference will usually be sufficient.

There are two ways in which an invention may be anticipated, viz. : (a) By user ; (b) By publication orally or in writing.

(a) PRIOR USER. By this is meant the public use of the invention prior to the date of the patent within the United Kingdom or the Isle of Man ; private or secret user will not invalidate the patent^(p), unless such user had resulted in the production of something which has been publicly sold^(q). Public use is not limited to use by the public, but includes use by anyone (including the patentee) in a manner open to the public^(r) ; e.g. in a place from which the public are not excluded.

Prior experiment will not invalidate a patent, whether carried out by the patentee or other persons^(s), and, where the alleged prior use has been abandoned, it will be presumed that it was mere experiment^(t), unless it is clearly shown that what was done was a complete anticipation of the invention^(u).

There are other special circumstances in which prior user will not invalidate a patent, and these are specified hereafter^(v).

(b) PRIOR PUBLICATION, ORAL OR WRITTEN. By this is meant making the invention known to another person or persons either orally, or in writing, as distinguished from publication by user. User is often referred to as publication, but it is more convenient to deal with the subject under different heads.

(o) Cases 366, 245, 128.

(p) Cases 229, 128.

(q) Cases 330, 323, 449.

(r) Cases 87, 446.

(s) Cases 174, 235, 344.

(t) Cases 241 (a), 334

(u) Cases 241 (b), 398, 435.

(v) *Post* p. 62

The publication must have been prior to the date of the patent, and have taken place within the United Kingdom or the Isle of Man. It is not publication for an inventor confidentially to communicate his invention to others, or to do so in circumstances which would impose a trust of secrecy on those other persons(w); nor will publication in the special circumstances(x) mentioned hereafter invalidate the patent. Otherwise any communication to another person of the invention, or the placing of a document describing the invention in a position open to the public, and where persons seeking information on the subject would naturally go(y), however short a time before the date of the patent(z), and whether by the inventor or other person or persons, will be fatal to validity.

The mere placing of a book, containing a description of the invention, in the inner room of the Library of the British Museum, has been held not to constitute publication(a); but any document open for public inspection in the Patent Office is taken as published on the day when it is so laid open(b).

Publication is always a question to be decided on the particular facts of each case, and, therefore, earlier decisions, in which the facts are even slightly different, may not be reliable as precedents(c).

The publication need not have been in the English language if it be in a language generally understood(d), or not occult, nor is it material to inquire whether or not the inventor derived any knowledge from it(e).

Unless the publication is such as to disclose the invention, and to instruct persons reading or hearing it in all essential details, and in a practical mode of producing the results, it will not invalidate a subsequent patent(f). For this reason it is very difficult to convince the Court that a patent, which has been abandoned as worthless, is an anticipation of an invention that has proved successful, and the judges have often protested against such efforts(f); but an abandoned patent may

(w) Case 40.

(x) *Post* p. 62

(y) Case 203.

(z) Case 168.

(a) Case 361 (b).

(b) Case 168.

(c) Cases 378 (a), 376 (b).

(d) Case 203.

(e) Case 437.

(f) Cases 64 (a), 232.

be an anticipation of a subsequent invention if it describes such invention in terms which fully and sufficiently disclose it and the manner in which it is to be practised(g). It is not sufficient to show that by taking a mosaic of extracts from prior publications, the invention may be arrived at; each alleged anticipation must be considered separately(h).

(c) TESTS OF PRIOR PUBLICATION. In order to test whether or not a prior publication is an anticipation of a patented invention, it must be read in the light of the general public knowledge at the date of the patent(i), and with the educated eye of one skilled in the art(j); the question then is whether, so read, it published to the world the whole invention, i.e. all that is material to instruct the public how to put the invention into practice; the prior publication must contain such information as is necessary to support a valid patent on the ground of sufficiency of specification(k).

A patent cannot be anticipated by a description of the invention in the specification of a prior British patent dated fifty years or more previously, or in any provisional specification which has not been followed by a complete specification(l); subject to this, however, it does not matter whether or not the prior patent is valid, provided that the invention alleged to be anticipated is sufficiently described therein(m).

(d) SPECIAL CIRCUMSTANCES IN WHICH PRIOR USE OR PUBLICATION DOES NOT INVALIDATE. There are special circumstances (referred to above) in which prior use or publication will not invalidate a patent, viz.—

(i) Where an application for a patent has been made in fraud of the true and first inventor, use or publication of the invention during the period of the provisional protection thereby granted does not invalidate a patent subsequently granted to the true and first inventor(n).

(ii) Where the patentee proves that the prior publication was without his knowledge and consent, that the information was derived or obtained from him and, if he learnt of

(g) Case 263 (a).

(h) Cases 475 (b), 316, 66 (b).

(i) Case 341.

(j) Case 64 (a)

(k) Case 232.

(l) Sect. 41 (1).

(m) Case 189 (a).

(n) Sect. 15 (1).

it before he had applied for his patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication(o). The publication here referred to would probably include both user and written or oral publication. This protection does not, however, apply to a person who has worked his invention commercially in the United Kingdom otherwise than for the purpose of trial ; as, for example, to a person who has been working his invention secretly.

(iii) The invention may, in certain circumstances and conditions, be exhibited at industrial or international exhibitions, or communicated in the form of a paper to a learned society, or published in the society's journal without prejudice to a patent for the invention. Due notice must be given to the Comptroller of such exhibition or publication or communication by the inventor, and the application for the invention must be made within the subsequent six months(p).

(5) That the invention is not useful. No patent will be valid unless the invention is useful. Utility is not a statutory requirement, but is a requirement at common law, and a corollary to the provision, under the Statute of Monopolies, that the invention must not be one which is mischievous to the State. It is part of the consideration on which the inventor is granted his monopoly. Utility must be judged according to the state of the art at the date of the patent, and according to the purposes of the invention, and there are two things which are essential : (a) that the invention works in the way described(q) ; and (b) that the end attained is useful(r).

Tests of Utility

(a) **THAT THE INVENTION WORKS IN THE WAY DESCRIBED.** With regard to this, if there is no representation in the specification that the invention is useful for a particular purpose, the patentee is at liberty to show utility in any

(o) Sect. 41 (2).

(p) Sect. 45 and Rules 102-103.

(q) Cases 458, 144, 500, 210.

(r) Case 160 (a).

direction(s), but if the invention does not work as described(t), or effect all the purposes, or produce all the results claimed for it(u), then the patent is not valid. If, however, the invention does produce all the results claimed for it, the patent is not necessarily invalid, because the specification says that the results can be applied to certain purposes whereas, in fact, they cannot be so applied(u).

(b) THAT THE END ATTAINED IS USEFUL. With regard to this, utility does not mean abstract utility, or comparative or competitive utility, or even commercial utility. The condition of utility will be satisfied if the invention is an article or process which is better in some respects but not necessarily in every respect than what was known before(v). So that, for instance, an article which is good, though not so good as that previously known, but which can be produced more cheaply by another process, is better in point of cost, though it may not be so good in point of quality. Or, again, the condition is satisfied if the public are enabled to do something which they could not do before, or to do in a more advantageous manner something which they could do before; or to express it in another way, if the invention offers the public a useful choice(w). A very small amount of utility will be sufficient to support a patent(x), especially so far as subsidiary parts or modifications are concerned(y).

(c) COMMERCIAL SUCCESS. Commercial success is not a test of utility, though, when present, it is very good evidence thereof(z). Commercial success depends upon many factors and considerations, of which utility is only one, as for example, changing fashions or passing moods of fancy of the public, the possibility of variations in prices of materials used for the invention, and competing articles or processes, and competing vested interests and monopolies. The fact that the invention has never been used is not necessarily fatal.

The fact that the invention has been infringed will be good

(s) Case 483 (b).

(t) Cases 15 (a), 360 (c).

(u) Cases 429, 210.

(v) Case 494.

(w) Cases 266, 483 (b).

(x) Case 374 (a).

(y) Case 151 (b).

(z) Cases 35 (c), 91.

evidence of utility in respect of the particular part of the invention infringed.

(6) That the invention is wanting in inventive ingenuity.

(a) GENERAL PRINCIPLES. To support a valid patent there must be something more than a new and useful article or process of manufacture; it must have involved somehow the application of the inventive mind(a). In other words, the invention must have required for its evolution some, if only a small, amount of ingenuity; what the minimum amount is varies according to the facts of the particular case, and it is therefore very difficult to lay down any general principle(b).

The question of inventive ingenuity is, in some respects, very similar to that of novelty; as, for instance, where a publication is relied on as an anticipation, and is also shown to be part of the general common knowledge. By reason, however, of this apparent overlapping, it must not be supposed that the two questions are the same. In deciding the question of novelty each alleged anticipation must be considered separately, to ascertain whether it published the whole invention and gave all material instructions for putting it into practice. If there is no novelty there can be no inventive ingenuity, but, assuming that there is novelty, then, in deciding whether there is inventive ingenuity, it must be determined whether the step in advance of the common general knowledge at the time (taking no account of any publications which form no part of the common general knowledge) is one which required the exercise of the inventive faculty, or is one which any competent person skilled in the art might be expected to take(c).

What constitutes the common general knowledge must be determined by evidence in each case. It must not be assumed that everything published in prior specifications or other publications forms part of that knowledge merely because it has been so published(d). Prior publications emanating from well-known inventors, or persons or firms engaged in the particular branch of industry, are, however, usually taken as

(a) Case 309.

(b) Cases 172 (a), 499, 46.

(c) Cases 316, 66 (b), 409.

(d) Case 64 (a).

contributions to the common general knowledge, and there is a tendency for the Courts to judge the ingenuity of an invention from the basis of the contents of any prior specifications or publications brought to their notice(cc).

Underlying an invention there is always some idea or conception from the carrying out or practical application of which the invention results. The inventive ingenuity necessary to support a valid patent may be found either in the underlying idea, or in the practical application of that idea, or in both. It may happen that the idea or conception is a meritorious one, but that once suggested, its practical application is very simple. For instance, the mere idea of using an old system, known as "shogging," for the purpose of equalizing the amount of thread used in the different bobbins of a lace machine, was considered sufficiently meritorious to support a patent although, once suggested, there was no difficulty in carrying out the idea(dd).

It may, again, be that the idea is an obvious or even an old one, but that ingenuity is required to put it into practice. For instance, in connection with a patent for a vacuum cleaner it was shown that the idea of extracting dust from carpets, etc., by means of suction, was old, but the inventor showed how to apply the idea so as to make it a practical success; this he did by making a high vacuum and using a nozzle which could make a tight joint with the carpet round its edges, and the Courts held that in this method of applying the idea there was sufficient inventive ingenuity to support validity(e).

Or, again, the idea itself may have merit, and the method of carrying it into practice also require inventive ingenuity. For instance, the idea of employing the power of steam for locomotion was the inspiration of genius, but it also required ingenuity to devise the first locomotive after the idea had been suggested. The idea or conception may be the perception of some useful end, defect or problem, which, when once properly recognized, may be easily attained, removed or solved, yet

(cc) Case 444 (a).

(dd) Cases 228, 318.

(e) Cases 72, 74.

the perception itself may be sufficiently ingenious to support a valid patent(f).

In cases where the invention has proved to be of very great utility, or has created a new industry, or has solved a problem or overcome a difficulty which others have long tried in vain to solve or overcome, the Courts readily infer the presence of inventive ingenuity(g); and in all cases where the invention has proved of practical importance, there need be only the merest scintilla of ingenuity(h). Where there has been for some time an unsatisfied demand and then suddenly an art springs into existence and satisfies it, the length of time during which the demand has remained unsatisfied is a matter from which inventive ingenuity may be inferred. But it may be that the demand is new and that the novelty of the demand has produced immediately, and without any exercise of ingenuity, an obvious article to satisfy it(i).

The question as to whether or not there is inventive ingenuity must be decided apart from the method by which the inventor actually arrived at the invention. For instance, it may have been a dream or the inspiration of a moment, or even a lucky accident, which gave him the idea of an invention having great merits. On the other hand, he may have undertaken long search and experiments and devoted much money, labour, and thought in completing an invention having no merits(j).

The merit of the invention must be judged from a consideration of the state of the art existing at the date of the patent, and on the assumption that the inventor had access to everything which was commonly known. The merit of an invention must not, however, be belittled because on an *ex post facto* analysis it appears that the invention might have been arrived at by one or more easy steps from a starting point which was known at the date of the patent(k). Many of the greatest inventions have been rendered available and useful to the public by some very small and comparatively insignificant step which the inventor has discovered. Where, in an industry, a want is felt and recognized, there are always many persons

(f) Cases 160 (b), 158.

(h) Cases 16 (a), 110, 216. (j) Case 110.

(g) Cases 135, 300, 191, 233 (b)

(i) Case 191.

(k) Case 76.

trying to satisfy it, and some of these may come very near to doing so but just fail at the last step. The person who makes this last step is the meritorious inventor, though, viewed from the standpoint of the unsuccessful efforts of his predecessors, what he has done may appear quite trifling. The road of the meritorious inventor is paved with the failures of his predecessors.

On the other hand, the greatest amount of utility will not make up for an absolute deficiency of inventive ingenuity^(l). For instance, the Haskell Golf Ball was the first rubber cored golf ball put on the market and it revolutionized the game of golf. The patent was for a ball with a core of rubber threads or strips wound under tension, surrounded with a cover of gutta-percha; it was shown that balls consisting of rubber wound under tension had been used in other games, also, it was old to cover balls with a cover of gutta-percha, and it was held the patent was bad for want of sufficient inventive ingenuity^(m).

If the invention is obvious, or if it merely amounts to the application by an old method of a well-known article or principle to a use analogous to that to which it has been put before, then the patent is void for want of inventive ingenuity⁽ⁿ⁾, but it may require ingenuity to discover that an old method may be applied in the manufacture of a new article or substance^(o). An invention, consisting of the selection amongst possible alternatives, can be the subject-matter of a valid patent only if such selection secures some advantage or avoids some disadvantage^(p).

Generally speaking, there is no inventive ingenuity in applying a known article to an analogous use; but this principle does not apply in the following cases—

(1) Where the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study^(q).

(l) Cases 331, 50.

(m) Case 209 (a).

(n) Cases 153, 206, 185.

(o) Case 360 (c).

(p) Case 100.

(q) Case 370.

(2) Where the result is to produce a new machine(**r**).

(3) Where there is some difficulty to be overcome in the application(**s**).

(4) Where there is inventive ingenuity in the adaptation(**t**).

In all such cases it is an argument in favour of the patent that the alleged prior use, although possibly described in prior literature, was not known commercially(**u**). A new and beneficial effect for a new application is, however, probably not in itself sufficient(**v**).

The combination of two or more elements, known *per se*, may involve sufficient ingenuity to support a valid patent; but if the combination does not require any special or ingenious arrangement, and each element performs only its own function separately, then there is not sufficient inventive ingenuity(**w**). The same principle applies to the combination of two old results(**x**). If, however, the function of the combination is different from the mere combined or super-added functions of the two elements, then there may be sufficient inventive ingenuity to support a patent(**y**).

It is impossible to frame any rule to show at once whether any particular instance is one involving inventive ingenuity or not. Each case must be decided on its own merits and with reference to its own particular circumstances(**z**). The decided cases on this question, apart from those which lay down the principles above mentioned, must only be relied on as decisions on their own particular facts. From the facts of one case it is practically impossible to determine what the decision in another case will or should be, and it is often dangerous to argue on a supposed or assumed analogy of facts.

(b) ILLUSTRATIONS OF CASES RELATING TO INVENTIVE INGENUITY. As illustrations of the way the Courts apply the above principles in particular circumstances, the following two lists of cases are given—

(1) Cases in which there was held to be insufficient inventive ingenuity.

(**r**) Case 423 (*b*).

(**s**) Case 2 (*b*).

(**t**) Case 153.

(**u**) Cases 16 (*a*), 425.

(**v**) Case 77.

(**w**) Cases 290, 170.

(**x**) Case 394.

(**y**) Cases 265, 501.

(**z**) Case 377.

(2) Cases in which there was held to be sufficient inventive ingenuity.

(1) CASES IN WHICH THERE WAS HELD TO BE INSUFFICIENT INVENTIVE INGENUITY—

A known addition to a known article for a known purpose (Case 501).

Making a surface adapted for a spirit level on an old article (Case 134).

Putting celluloid flanges on eyelets of boots (Case 396a).

Old process applied to substances similar to those to which it has been previously applied (Cases 77 and 186).

Combining two known articles by merely joining them together (Cases 89 and 358).

Small improvement in known article (Cases 38 and 484).

Altering the drive from the bottom to the top of a machine (Case 37).

Applying to tramway rails a method of joining previously suggested for railway lines (Case 106).

Adapting a side guard previously used for trams to motor omnibuses (Case 50).

Making articles in a known manner with a known material, not previously used for that purpose (Case 242).

Placing two machines end to end so as to make a continuous process out of two processes (Case 355).

The alteration of the screw attachment in the hub of a wheel (Case 390b).

A known combination used in a known way for a known purpose (Case 311).

In a device for connecting together tubular electric conduits, the duplication of a similar part in a known device (Case 394).

A tool for use in pressing nuts which obtained the same results on cold blanks as had been previously obtained by a similar tool on hot blanks (Case 161).

The combination with the well-known parts of a machine of a friction brake for the purpose of checking the movement of those parts (Case 71).

(2) CASES IN WHICH THERE WAS HELD TO BE SUFFICIENT INVENTIVE INGENUITY—

The new use of an old machine to produce a new result (Case 130).

The selection of one machine from many known ones and its application to a new purpose (Case 7).

The use of steam at high pressure where it has been previously used at ordinary pressures for the same purpose (Case 187).

A new combination of old parts (Cases 135, 160*b*, and 381).

The use of an excess of one ingredient in a known chemical process (Case 406).

The addition of a lever and spring to an old valve (Case 180).

The application of a form of known protector to a known article (Case 222).

The application of a truss as used in bridges to the framework of a bicycle saddle (Case 78).

The application to the tapering amplifying horn of a gramophone, of a universal joint, both the tapering and universal joint *per se* being known in amplifying horns (Case 192).

The tilting of a gas retort to such an angle that the contents will gradually feed down by gravity to one end (Case 25).

The substitution in a chemical preparation of a long boiling process for a short melting process (Case 4).

In a steam heating system putting a thermostatic valve on the inlet, instead of the outlet pipe (Case 348).

(7) That the invention is insufficiently or improperly described or claimed in the complete specification. The consideration for which the patentee is granted his monopoly is that he discloses a new, useful, and ingenious invention to the public; this disclosure must take the form of a specification which must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed^(a). It is therefore necessary in the public interest that the complete specification should comply with certain requirements, failure in respect of any one of which will invalidate the patent.

(a) Sect. 2 (2).

These requirements are—

- (a) Intelligibility.
- (b) Sufficiency.
- (c) *Bona fides*.

In considering whether the complete specification fulfils these requirements, it must be remembered that it must be looked at from the point of view of a competent person skilled in the art with which it deals, at the date on which it is published ; it is not addressed to persons wholly ignorant of the subject-matter.

(a) INTELLIGIBILITY. The complete specification must particularly describe and ascertain the nature of the invention, and must be drafted in such a way that it is readily possible to find out from reading it what the invention is and what are the limits of the protection granted by the patent(b).

The public are entitled to be informed, without ambiguity or reasonable doubt and in reasonably accurate language, what is the prohibited ground and what they are not to do. It is the duty of the patentee to state clearly and distinctly either in direct words or by clear and distinct inference the nature and limits of his invention(c).

If, after carefully reading and considering the complete specification, it appears to be merely a problem(d) or there is any reasonable doubt as to what the invention really is or as to the extent of the monopoly claimed(e), the patent will be invalid ; but the ambit of the invention need not be stated with mathematical precision and in the case of some inventions it is impossible rigidly to define the limits of variation from the example given(f).

A specification may be unintelligible by reason of vagueness or ambiguity of language or multiplicity of claims(g) or imperfections in drawings(h). Absolute accuracy is impossible, but it should be as accurate as may reasonably be expected(i). It is, however, incumbent on the inventor to be explicit(j).

(b) Case 67.

(c) Cases 342, 64 (b).

(d) Case 378 (b).

(e) Cases 474 (b), 58, 459 (b), 34 (b),
295, 271, 403, 374 (b).

(f) Case 67 and 4.

(g) Cases 294 (a), 269.

(h) Case 270.

(i) Case 374 (b).

(j) Case 186.

Vagueness of language will invalidate a patent if it be such as would enable a patentee to claim a monopoly for more than his real invention; but the language may be sufficiently general to preserve the patentee's legitimate rights and to prevent the invasion of those rights by others(k). A redundant claim will not render the patent invalid(l). If for the proper comprehension of the invention the knowledge contained in recently published and advanced treatises is necessary, such knowledge must be set out in the specification or the publications must be referred to(m).

(b) SUFFICIENCY. The complete specification must particularly describe and ascertain the manner in which the invention is to be performed(n). This requirement is closely allied to that of intelligibility, but is, nevertheless, quite a distinct one. The method of carrying out the invention must be described in such a way as will enable a competent person, skilled in the art or manufacture with which it deals, to follow the directions and put the invention into practice(o), by using that amount of skill and intelligence which is to be fairly expected from him(p). The description may be so wide and indefinite that the patent is thereby invalid(q).

It is not necessary to give more than one method of carrying out the invention, but if two or more methods be given, each must be sufficient in the sense above indicated(r). The specification need not be a text-book or manual of instruction in the art as commonly known in the industry at the date of the patent(s). All that may be taken for granted, and technical terms and expressions may be used; but when dealing with the particular points which constitute the advance made in the art by the invention, the greatest particularity must be adopted, and the inventor must disclose everything which it is necessary to add to the previously existing knowledge of the art to enable the invention to be carried into effect(t). The degree of particularity will vary according to the nature of the invention.

(k) Case 488 (a). (o) Cases 146 (a), 62, 474 (c).

(l) Case 495. (p) Cases 378 (c), 59 (a).

(m) Case 112. (q) Case 315.

(n) Sect. 2 (2).

(r) Case 463 (a).

(s) Case 35 (c), 68 (a).

(t) Cases 209 (b), 429 (a),

447.

In cases where the merit of the invention is an idea or conception, which once suggested is easily carried out, it is unnecessary to describe the method of carrying it out with the same detail as would be essential in other cases(u). It may be that before being able to make the invention work successfully according to the description, it would be necessary to make trials or experiments(v). This will not necessarily invalidate the patent; but if extended experiments and research are necessary(w), or experiments involving more than the application of ordinary skill and knowledge before the invention can be successfully carried out(x), then the patent will be invalid. If, for instance, it requires the exercise of inventive skill to follow out the instructions so as to make the invention work successfully, the patent will be invalid(x).

In deciding the question of sufficiency, the art with which the invention deals has to be considered because, in some arts, the person of competent knowledge (to whom the specification is addressed), is one of great learning and scientific ability, whereas, in others, he is of very limited intellectual capacity.

Sufficiency and intelligibility of the specification must be judged from a consideration of the whole of the specification including the title, the letterpress, and the drawings (if any)(y). In some cases, patents have been upheld where the only description of the invention is to be found in the drawings(z).

If a theory be stated in the specification and it turns out to be a false one, it may, but does not necessarily, invalidate the patent(a). A false theory will invalidate the patent if it is misleading, so as to deceive(b), or amounts to a claim to do something which it is impossible to achieve by the process, or in the manner, described(c).

Errors, omissions, and ambiguities will invalidate a patent if they are such as to be misleading(d) or only discoverable by experiment and further inquiry(e). But, if they are manifest on the face of the specification, and would not mislead, they are not fatal(f). Where certain precautions are essential to

(u) Case 474 (a).

(v) Case 145 (c).

(w) Case 313.

(x) Case 488 (b).

(y) Case 47.

(z) Cases 300, 214.

(a) Cases 125, 24.

(b) Case 510.

(c) Case 326 (a).

(d) Cases 327 (a), 459 (c).

(e) Cases 474 (d), 426.

(f) Case 291.

success, in putting the invention into practice, an adequate warning must be given, unless the danger is such as common knowledge or ordinary practice will avert, otherwise the specification will be held to be insufficient(g).

The test of any objection urged on the ground of unintelligibility or insufficiency is whether a competent person, skilled in the art could understand the invention and put it into practice from a perusal of the specification(h). If the Court believes that he could, then the objections under these heads must fail(i). This is, of course, a question to be decided on the evidence(j).

Provided the description and directions are otherwise intelligible and sufficient, it is not usually necessary that the advantages, or even the results achieved by the invention, should be stated or claimed(k); but there are cases where a statement of the advantages or results is necessary for the proper delimitation of the invention, and then it is essential to set them out(l), for without them the description and directions would be deficient.

The above remarks about errors and omissions apply equally to the drawings as to the other parts of the specification(m). The function of the drawings is to aid in making the description capable of being understood and the invention put into practice; they must not be regarded as a representation that the best results will be obtained by following them exactly(n). In many cases, the drawings are diagrammatic, and omit small parts which are essential to success but which a competent person would insert without special instructions.

(c) "BONA FIDES." It is necessary that the inventor should show the utmost *bona fides* in the drafting of the complete specification; he must do his best to instruct the public as to what his invention is and the method of putting it into practice(o). A full and complete disclosure is necessary(p), together with the best method of carrying out the invention known to him at the time(q).

(g) Case 189 (b).

(h) Case 238.

(i) Case 146 (a).

(j) Case 175.

(k) Case 376 (a).

(l) Case 98.

(m) Case 68 (a).

(n) Case 488 (b).

(o) Case 474 (e).

(p) Case 209 (b).

(q) Case 202, 68 (a).

If the inventor keeps back information(^r), or misleads the public(^s), or gives a false description of the invention(^t), or makes any material misrepresentation or false suggestion the patent will be invalid; also if the specification and claims are framed to puzzle the student and to frighten men of business into taking a licence, the patent will be invalid(^u).

(8) That there is disconformity between the provisional and complete specifications. By disconformity is here meant that the complete specification claims a further or different invention from that contained in the provisional. If, however, the further or different invention was novel at the date of the complete specification, and the grantee the first and true inventor thereof, then disconformity will not invalidate the patent(^v).

Disconformity, therefore, when shown to exist, apparently raises a *prima facie* case of invalidity, and it then rests with those supporting the patent to show that the disconforming part of the invention was novel at the date of the complete specification, and that the grantee was the first and true inventor thereof.

The question of disconformity is the same as that which arises on the investigation of the complete specification, when it is filed in the Patent Office; this is discussed in Chapter II.

If disconformity exists, the novelty of the disconforming portion must be judged, as at the date of the complete specification, by applying the principles set out under heading (4) of this chapter.

The question whether the grantee was the first and true inventor of the disconforming portion must be decided by applying the principles set out under heading (1) of this chapter, but, presumably in this case also, the material date will be that of the complete specification, instead of that of the patent.

(^r) Cases 491, 330, 502.

(^s) Cases 460, 288.

(^t) Case 450.

(^u) Cases 294 (*a*), 269.

(^v) Sect. 42.

CHAPTER VI

THE RIGHTS OF A PATENTEE

AMBIT OF THE CHAPTER.

THE purpose of this chapter is primarily to deal with the several rights of a patentee and the ways in which a patentee may maintain, enforce or deal with these rights. The devolution of letters patent, and matters relating to the register of patents are also considered. The subjects will be dealt with under the following section headings—

- A. Infringement actions.
- B. Recovery of royalties.
- C. Register of patents.
- D. Transfer of patent rights.
- E. Licences under patents.
- F. Amendment of the complete specification.
- G. Extension of the normal term of a patent.
- H. Restoration of lapsed patents.
- I. Surrender of patents.
- J. Rights of co-patentees *inter se*.
- K. Rights of patentees in relation to the Crown.
- L. Rights as affected by War Legislation.

Section A.—INFRINGEMENT ACTIONS.

This subject is most conveniently considered under the following heads—

- (1) Who may bring an action and in what Court.
- (2) In respect of what Acts it may be brought.
- (3) The procedure.
- (4) What defences are open.
- (5) What relief may be obtained.
- (6) The effect of the Judgment.

(1) **Who may bring an action and in what Court.** An action for the infringement of a patent may be brought by any person whose name is entered as proprietor of the patent on the

Register of Patents kept at the Patent Office, even if such person has assigned his interest in the patent, as by way of mortgage(a). The assignee of any share of a patent may sue for infringement. The equitable owner of a patent cannot sue unless notice of his document of title (if any) is entered on the Register and in any case he must join the registered owner as either plaintiff or defendant. If two or more persons are registered as owners any one or more of them may sue, but it is advisable that all the registered proprietors should be parties; those who consent as plaintiffs, and those who do not consent as defendants(b). It is also usual and advisable, though not absolutely necessary, to add any person or persons beneficially or equitably interested in the patent. In all cases, the registered owner or owners of a patent should be joined as a party or parties to the action. If, however, a judge thinks an action defective for want of parties, he can, by order, join the necessary parties in order to cure the defect(c).

A mere licensee cannot maintain an action for infringement(d) unless the licence is one granted as a "licence of right," or is a compulsory licence granted as the result of an application for relief from the abuse of monopoly rights. In these latter cases the licensee can call on the registered patentee to take proceedings, and if he refuses, or neglects to do so within two months, can sue in his own name as if he were the patentee(e).

So far as England is concerned, the action may be brought in the High Court of Justice, in either the King's Bench or the Chancery Division, or in the Court of the County Palatine of Lancaster. The jurisdiction of the latter seems to be founded on the fact that it has the same jurisdiction, within its district, as the High Court of Chancery, and there are probably other local Courts to which the same reasoning applies, e.g. the Mayor's Court of London. As a matter of fact, however, the Court of the County Palatine of Lancaster is the only local Court in which the infringement actions are

(a) Cases 137, 471.

(b) Case 61.

(c) Case 471

(d) Case 219 (b).

(e) Sects. 24 (1) (d), and 27 (3) (b).

brought. The County Courts have no jurisdiction where the validity of the patent is challenged(f).

(2) **In respect of what acts it may be brought.** An action may be brought in respect of any infringement of the patent or any intention to infringe. The infringement of two or more patents may be made the subject-matter of one action, and all persons may be joined as defendants who have participated in the same act or acts complained of. But where several persons have committed different acts of infringement, even of the same patent, a separate action should be started against each ; these may, where convenient, be subsequently consolidated. The burden of proof is on the plaintiff to show that the defendant has committed, or has the intention to commit, an act of infringement in respect of an invention which is covered by one or more of the claims of his patent.

By his patent the patentee is granted the sole privilege to make, use, exercise and vend the invention ; the invention being that specified and claimed in the complete specification. When it is ascertained, in the way pointed out in Chapter IV, what the invention is, the question arises whether the act complained of amounts to a making, using, exercising(g) or vending(h) the invention. It is an infringement of a patent for a process or a machine to sell or use an article made according to that process or by that machine(i). Mere buying, or mere possession, or transportation, does not constitute infringement, unless in circumstances which indicate an intention to use or sell, e.g. where a manufacturer buys, or is found in possession of, an article which is, or is capable of being used as, an infringement of the patent, the Court will infer an intention to use the invention, and this *prima facie* is infringement, the burden of disproving which will be on the defendant(j). If an infringing article is on the defendant's premises as a reserve or stand-by, or for the purpose of facilitating the sale of a non-infringing article, this amounts to a use of the invention, and is therefore an infringement(k).

Under Sect. 48 a patent will not prevent the use of an

(f) Case 391 (a).

(g) Case 407.

(h) Case 31 (a).

(i) Case 475 (a).

(j) Case 70.

(k) Case 139.

invention on a foreign vessel within the territorial waters of the United Kingdom (e.g. for the purposes of navigation), provided the invention is not used for the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom ; but these provisions only apply to the vessels of foreign states, the laws of which provide similar reciprocal provisions in favour of British vessels.

The importation into the realm of an infringing article is an infringement^(l), even if it be re-exported^(m) ; but if a patented article is imported in a foreign vessel and, without being unloaded, is re-exported it would presumably come within the provisions of Sect. 48, referred to above. Acts done abroad cannot be interfered with or controlled, as a patent is only of local force ; hence an agreement by a person in the United Kingdom to sell to another in the United Kingdom an article to be delivered abroad, cannot be an infringement⁽ⁿ⁾, even if it be known to the seller that it is intended to import the article^(o). Nor is it infringement for a person abroad to aid and abet importation of an infringing article^(p). In the most restricted sense to aid and abet infringement within the realm may not constitute infringement^(q), but it is infringement for a person to procure others to infringe for his own benefit or to be concerned in carrying on a business of infringement^(r).

Experimental use is not an infringement^(s). To make or sell a machine, which, not being an infringement itself, is capable of being used as an infringement, or is capable of being so altered as to infringe, is not an infringement^(t), unless the maker or seller fraudulently intends it to be so used or altered^(u).

Fair repair of a patented article is not infringement^(v), but if the repair be such as practically to amount to reconstruction, it constitutes a making of the invention, and hence infringement^(w).

(l) Cases 154, 475 (a).

(m) Case 466 (a).

(n) Case 33.

(o) Case 407.

(p) Case 33.

(q) Case 250.

(r) Case 247.

(s) Case 416.

(t) Cases 61, 142.

(u) Cases 252, 420 (a).

(v) Cases 143, 427.

(w) Cases 140, 141.

The taking out of a patent(*x*), or the licensing(*y*) of any article or process, cannot be an infringement.

It is not infringement to sell parts of an article, which parts are not of themselves separately claimed; but, if a person is, in substance, selling the whole article, he will not escape merely because he does so in parts(*z*).

Where no actual acts of infringement are proved, but an intention to infringe is relied on, this intention may be gathered from either the acts or the words of the defendant. Certain acts are *prima facie* proof of infringement (e.g. the purchase of an article implies an intention to use it), and then the burden of disproving it lies on the defendant; but where words (e.g. offers to sell or threats to infringe) are relied on, it is often difficult to show that the offers or threats, if carried out, will necessarily constitute infringement; for instance, if there is an offer to sell an article which will produce a given effect, this is not a threat to infringe a patent, unless that patent can be shown to cover all methods of producing the said effect(*a*).

Infringements of enemy patents during the war are protected by war legislation; this subject is dealt with in Section L of this chapter.

(3) Procedure. Procedure in an infringement action is similar to that in other actions, and the more important points of difference only will be indicated and discussed.

(*a*) INTERLOCUTORY INJUNCTIONS. After the issue of the writ, the plaintiff may desire to obtain an *interim* or interlocutory injunction to restrain the defendant from infringing the patent until the trial. Such an injunction will only be granted in exceptional cases, even when the plaintiff has been guilty of no delay and there is strong *prima facie* evidence of infringement.

The cases in which such an injunction may be granted are—

- (i) Where the validity of the patent has been established in a former action.
- (ii) Where the defendant does not, or is not permitted to,

(*x*) Case 461 (*a*).
(*y*) Case 327 (*b*).

(*z*) Case 142.
(*a*) Case 45.

dispute the validity, e.g. when he is a licensee (exceeding his licence) or an assignor.

(iii) Where the invention has for many years been put largely into practice and the whole trade has acquiesced in the plaintiff's title.

In practice, it is very unusual for the Courts to grant an interlocutory injunction, unless the case comes under (i) or (ii)(b). Although there have been cases of interlocutory injunctions being granted on patents the validity of which was disputed and which had been in existence six or more years, yet these cases are not now followed. If the defendant is willing to undertake to keep accounts, the motion for an injunction is usually ordered to stand till the trial.

An *ex parte* injunction will only be granted in the clearest and most urgent case, and the supporting affidavits must make a full and impartial disclosure of the facts. Where the Court grants an interlocutory injunction, it will only do so on an undertaking being given by the plaintiff to abide by any order which the Court may make as to damages, in case the Court should thereafter be of opinion that the defendant has sustained any by reason of the order, which the plaintiff ought to pay. If, for instance, an interlocutory injunction be granted restraining the defendant from making, using or selling a particular article, and at the trial it is found that the article is not an infringement, or that the patent is invalid, then the defendant will probably have suffered damages by his business being disturbed through the injunction, and the Court will order the plaintiff to pay this damage, to be assessed on an inquiry (if necessary). The rules and procedure on such an inquiry are the same as when the plaintiffs succeed in the action, and an inquiry as to the damages he has suffered through the defendant's infringements is ordered(c).

(b) PLEADINGS. The statement of claim must be accompanied by particulars of breaches, which must specify the facts on which the plaintiff intends to rely as constituting infringement and the claims infringed. It is sufficient to allege and prove one act of each type of infringement relied on, prior

(b) Case 456.

(c) *Post* p^{re}91.

to the issue of the writ and within the preceding six years, to entitle the plaintiff to an inquiry as to damages in respect of that type up to the date when damages are assessed. The plaintiff is not entitled to rely at the trial on any act of infringement, not specified in the particulars of breaches, unless he obtains leave to amend.

The defence must set out the facts on which the defendant relies as a defence to the action, and if one of these is that the patent sued on is invalid, there must be delivered with the defence particulars of objection, setting out the grounds for alleging invalidity. If one of the grounds of defence is that the patentee has inserted in a contract or contracts of sale, lease or licence of the patented article or process, conditions, declared unlawful by Sect. 38 of the Act, particulars must be given of the dates and parties to such contracts and of the conditions complained of. The particulars of objection must state every ground on which the validity of the patent is disputed; such particulars must be given as will clearly define every issue which it is intended to raise. The rule as to giving particulars is particularly stringent where want of novelty is relied on as a ground of invalidity^(d). If the patent sued on bears a date subsequent to the year 1904, nothing contained only in the specification of a British patent, applied for fifty years or more before that date, may be relied on as anticipation, nor may the defendant rely on anything contained only in a provisional specification which has not been followed by a complete specification^(e).

A defendant in an action for infringement of a patent may counterclaim for revocation of the patent^(f). If the defendant does not establish one or more of the grounds specified in Sect. 25 (3) (b) of the Acts, it is necessary for him to obtain the fiat of the Attorney-General, and the procedure is in every respect similar to that in a Petition to Revoke (*post* p. 144).

(c) THE TRIAL. Each party is confined at the trial to evidence supporting the particulars given in the pleadings^(g), unless leave is obtained from the Judge to travel outside such

(d) Case 157; R.S.C., O.53A, r. 21.

(f) Sect. 32.

(e) Sect. 41 (1).

(g) Case 225.

particulars^(h). But, if evidence outside the particulars be given at the trial without objection, it is too late to object on an appeal in the Court of Appeal or the House of Lords⁽ⁱ⁾.

The trial of an infringement action takes place before a Judge sitting without a jury, unless a special order be made that it should be tried with a jury. This, however, is practically never done, and an application for a jury would almost certainly be refused unless there were issues of fraud or other similar issues to be tried.

At the trial, the plaintiff has to bring evidence in support of his case if infringement is denied or the validity of the patent is challenged. If the defendant alleges that some person other than the original patentee (whose name must be mentioned in the particulars of objection) was the true and first inventor, the burden of proving this lies on the defendant^(j). Apart from this, if validity is attacked on any other ground, the plaintiff must be prepared to establish by evidence that his patent is valid. If, however, infringement and validity are admitted, but the defendant relies on the special defence that a subsisting contract with the plaintiff contains conditions which render the contract null and void by virtue of Sect. 38 of the Patents Act, then the burden of proof lies on the defendant, and he is bound to open his case and call his evidence first.

(4) What defences are open. The following are the defences which are available to defendants in infringement actions—

(a) Want of title to sue.

(b) Non-infringement.

(c) Licence.

(d) Invalidity of the patent.

(e) That there is in force a contract made after the 28th August, 1907, whereby the patentee has sold, leased or licensed to use or work, the patented article or process, which contract contains a provision rendered null and void by Sect. 38.

The defence must clearly state each and every defence which is to be relied on and full and proper particulars must be

(h) R.S.C., O. 53A, r. 21.

(j) Case 483 (a).

(i) Case 474 (f).

given. Ignorance is no defence to an infringement action^(k), so far as the plaintiff's right to an injunction is concerned, but the defendant can escape liability to damages if he proves that he was unaware of the existence of the patent and had no reasonable means of making himself aware of it^(l). An innocent infringer might also escape liability to an injunction by ceasing infringing directly the patent is brought to his attention and at once giving an undertaking not to continue.

If the defendant succeeds in establishing any one or more of the above defences he is entitled to judgment dismissing the action against him. It is the general rule of practice in the English Courts that any number of defences may be raised, although they may be inconsistent with each other. It has been stated, however, that in an infringement action the defendant is not allowed to plead that he is a licensee or, in the alternative, that the patent is invalid. The case of *Post Card Automatic Supply Co. v. Samuel*^(m) is quoted as the authority for that proposition, but it is doubtful if it was intended in that case to lay down any such general rule⁽ⁿ⁾.

The different defences will now be shortly considered.

(a) WANT OF TITLE TO SUE. Except in the case of a licensee holding a compulsory licence^(o), or a licence of right^(p), the action cannot be maintained unless one or more of the parties is or are registered as owner or owners of the patent. Certified copies of any entry in the Register can always be obtained, and the Comptroller's certificate is *prima facie* evidence of the entry^(q). A person whose document of title is not entered on the Register cannot prove his title in an action, unless the Court otherwise directs^(r).

(b) NON-INFRINGEMENT. This includes a denial that the acts complained of were committed by the defendant, and also that such acts (if committed) amount to an infringement of the patent. Whether the acts complained of were or were not committed by the defendant is a simple question of fact to be decided (if denied) on the evidence.

(k) Case 509.

(l) Sect. 33.

(m) Case 385.

(n) Cases 482, 5.

(o) Sect. 27 (3) (b).

(p) Sect. 24 (1) (d).

(q) Sect. 78.

(r) Sect. 71 (4).

Whether the acts complained of (if committed) are infringements of the patent depends on questions of law arising from a consideration as to whether the acts amount to making, using, exercising or vending the invention. When the complete specification has been construed and it has been ascertained what the invention is, the principles, already discussed, must be applied to decide whether there has been infringement(s). In practice, however, there is sometimes a difficulty. It seldom happens that an infringer copies the exact thing. No infringer is such a blunderer at the work of infringing as to go and make a thing exactly like the patent(t), and the question then arises whether he has taken the pith and marrow(u) or (more accurately expressed) the substance(v) or essence of the invention. A colourable imitation(w) or the variation of an immaterial detail will not escape infringement(x), nor does it matter that the defendant has introduced improvements(y).

It is not necessary for the purpose of infringement to show that every part of a combination claim has been taken in the exact form described in the specification(z). If important or essential parts of a combination are taken and equivalents for the rest, this is infringement(a), provided that the equivalents are known as such at the date of the patent(b). The entire omission of one material element may be sufficient to enable the defendant to escape(c).

Infringement must not be judged by the result achieved, but by the means adopted to achieve that result(d), and the plaintiff must show that the means used by the defendant fall within the monopoly granted him by his patent. In respect of patents granted after the Patents Act of 1919 came into force, where the patent is for the production of a new substance, it will protect only such substance when made in the way described, but any substance of the same chemical

(s) Sub-sect. (2), *ante* p 79.

(t) Case 369.

(u) Cases 328, 495.

(v) Case 249.

(w) Cases 508, 346.

(x) Cases 464, 109 (a), 273.

(y) Cases 151 (c), 353, 299.

(z) Cases 322 (b), 263 (b).

(a) Cases 451, 369.

(b) Case 35 (a).

(c) Case 194.

(d) Cases 191, 302, 443 (b).

composition is, in the absence of proof to the contrary, deemed to have been produced by the patented process^(e).

Certain persons are immune from infringement actions under patents granted with abnormal priority of date under war legislation^(f).

(c) LICENCE. It is a complete defence to an infringement action to prove that the act complained of was done by leave or licence of the patentee. If there are two or more registered owners, a licence will be effective only against those who actually granted the licence and those who have acquiesced. If A and B are therefore registered owners of a patent and B sues C for infringement, it is no defence for C to show that he has a licence from A, unless he also shows that B consented to or acquiesced in the licence^(g).

Moreover, the defendant must show that the act complained of as an infringement comes within the ambit of the licence in respect of the duration, the area, the extent, and all other limits of the licence. For instance, if a licence purports to be for three years from the date of the patent, it will not be a defence to an alleged act of infringement committed four years from that date. Similarly, a licence limited to England (or any part thereof) will not excuse an infringement in Scotland or Ireland (or any other part of England than that mentioned in the licence). Again, a licence to *use* a patented article will not be a defence to an alleged *making* or *selling* of the article.

It does not matter whether the licence is express or implied. An express licence is made either orally or by writing. An oral licence is a permission given or granted by word of mouth, and its terms and extent must be ascertained from the evidence of witnesses. A written licence is one which is made the subject-matter of a written agreement between the parties; its terms and extent must be gathered from the written agreement alone, read in the light of the circumstances in which it was entered into. A written licence requires to be registered before it can be given in evidence as proof of title

(e) Sect. 38A.

(g) Sect. J of this chap., *post* p. 136.

(f) Sect. L of this chap., *post* p. 141.

in any Court, unless the Court otherwise directs^(h). An implied licence is one which is presumed from the circumstances of the case ; for instance, if an act be done in the presence of the patentee without any objection or protest on his part, it will be presumed that he gave his consent ; again, if a patented article be bought directly or indirectly from a patentee or a person licensed by him, there is an implied authority to the purchaser to use or re-sell the article, and this is so even if the article is bought in a foreign country⁽ⁱ⁾.

A patentee is at liberty to sell the patented article with restrictions as to its use or re-sale (other than certain specified restrictions declared void by Sect. 38 of the Patents Acts), but such restrictions only bind a purchaser if and so far as they are brought to his attention, or are within his knowledge at the time of purchase^(j).

A licensee under an express licence is, during the continuance of the licence, estopped or debarred from disputing the validity of the patent, unless it is an expressed term of the licence that he shall be permitted to do so.

(d) **INVALIDITY OF THE PATENT.** When the complete specification has been construed and the exact nature and scope of the invention ascertained, the Court will consider whether or not the patent is valid in the respects in which the validity is challenged in the particulars of objection. The defendant is not allowed to travel outside the particulars of objection, so far as the grounds on which the validity is challenged are concerned ; nor is he allowed to call evidence in support of any one of those grounds, unless that evidence is clearly within the particulars given under that ground of objection. The presence of one or more invalid claims does not prevent the plaintiff from obtaining an injunction if there is one valid claim which has been infringed ; but the Court may award damages in respect only of infringements after a given date, may deprive the plaintiff of costs, and may put him on terms as to amending the specification. The decision of the Court will depend upon the conduct of the parties in inserting invalid claims and allowing these to remain^(jj).

(h) Sect. 71 (4).

(i) Cases 42, 431.

(j) Case 248.

(jj) Sect. 32A.

(e) THE EXISTENCE OF A CONTRACT WHICH IS NULL AND VOID UNDER THE PATENTS ACTS (SECT. 38). Sect. 38 is intended to prevent patentees from imposing unfair and onerous terms on persons wanting to buy or hire a patented article or to use a patented process. Purchasers, hirers, or licensees are not to be prohibited from, or restricted to, using any article or articles, or any patented process, supplied by or belonging to third parties ; nor are they to be required to purchase from the patentee or his nominees any articles not protected by the patent. Any such terms in a contract for sale, hiring or licence are to be null and void unless the patentee can show that the purchaser, hirer or licensee had the opportunity of buying, hiring or taking a licence on reasonable terms, or unless there is in the contract a provision enabling the purchaser, hirer or licensee to give a three-months' notice and put an end to the obnoxious term, submitting the amount to be paid as compensation to the seller, lessor or licensor, to an arbitrator, to be nominated by the Board of Trade.

The section does not, however, render invalid a contract whereby a person is debarred from selling goods, other than those of a particular person, nor a provision in a contract whereby a patented article is leased or licensed and the lessor or licensor has the right of supplying new parts for repair. If any contract, containing terms so declared null and void and entered into by the patentee after the 28th August, 1907, is in force at the time an infringement action is brought, it will be a good ground of defence, and it does not matter if the defendant is not a party to the contract(k).

In relying upon this ground of defence the defendant has to prove—

(1) That there is a contract containing a term rendered null and void by Sect. 38 (i) entered into by the patentee, i.e. the person for the time being entered on the Register as the grantee or the proprietor.

(2) That the said contract was entered into subsequent to the 28th August, 1907, and was in force at the date the writ was issued in the infringement action.

(k) Case 411.

(3) That the contract does not provide that the purchaser, hirer or licensee is entitled to get rid of the obnoxious term or terms by giving three months' notice and paying, as compensation, an amount to be fixed by an arbitrator appointed by the Board of Trade.

If the defendant succeeds in proving these points his defence will still fail if the plaintiff can show that the purchaser, hirer or licensee had the option of entering into a contract on reasonable terms without the obnoxious conditions.

(5) What relief may be obtained. If the plaintiff succeeds on the issues raised in the action he may obtain relief by way of: (a) an injunction; (b) damages; (c) delivery up or destruction of infringing articles; (d) a certificate that the validity of the patent came in question; (e) costs.

(a) **AN INJUNCTION.** To be entitled to an injunction the plaintiff must show that the defendant had the intention at the date of the writ to infringe the patent. An injunction is an extraordinary jurisdiction, and one that is in the discretion of the Court to exercise^(l). There are, however, well-established rules by which the Court is guided in exercising its discretion. If the defendant has infringed in the past or claims the right to do so, the Court will assume that he intends to infringe and will grant an injunction; but if the infringement has been long abandoned, and the defendant has expressed his intention before the action was brought of not repeating or continuing the infringement, the Court will not grant an injunction. An intention to infringe may be inferred from acts in regard to which the plaintiff is not entitled to claim damages as infringements^(m). For instance, if the defendant has used the invention before the acceptance of the complete specification (which is not an actionable infringement)⁽ⁿ⁾, and has done so again since the writ was issued, the Court will infer an intention to infringe at the date of the writ and will grant an injunction. But it is only where an injunction is claimed that evidence of acts subsequent to the writ may be given^(o). An injunction against infringement will only be granted for the unexpired period of the patent sued upon,

(l) Case 387.

(m) Case 130.

(n) Sect. 13.

(o) Case 493.

and will therefore not be granted after the patent has expired or lapsed or been revoked ; but the mere fact that the patent has been declared invalid, as between the plaintiff and some other person, is not fatal to the plaintiff's right to an injunction. Thus, where there were two defendants, one of whom did not defend the action, but the other successfully attacked the validity of the patent, the Court nevertheless granted an injunction against the former(p). The same result would have followed if that party had defended the action but had been estopped from denying the validity of the patent, e.g. if he were an assignor of, or licensee under, the patent. To obtain an injunction it is not necessary to prove actual infringement ; the proof of a threat to infringe is sufficient(q), but as already pointed out, this is often a difficult matter(r). When an injunction is granted, the Court may, in exceptional cases, suspend its operation for a stated period, where it might work a great injustice to the defendant(s), but it is not usual for a Court to suspend an injunction pending an appeal, unless the interests of the plaintiff can be adequately protected by terms to which the defendant is willing to submit ; e.g. that he should keep an account of infringements and pay certain sums into Court.

It has been held that subsequent amendment of the specification dissolves an injunction(ss), but Sect. 32A, introduced by the Act of 1919, provides that a patentee can obtain relief in respect of the infringement of a valid claim in spite of the presence of invalid claims in the specification. Where an injunction has been granted in such circumstances, the provisions of Sect. 32A, and more particularly the provision that the relief is obtainable subject to such terms as to amendment which the Court may deem desirable, suggest that it was not the intention of the legislature that an injunction should be automatically dissolved if the patentee amended his specification by removing invalid claims.

(b) DAMAGES. If the plaintiff has succeeded in proving one actionable act of infringement prior to the date of the writ,

(p) Case 412.

(q) Case 171.

(r) *Ante* p. 81.

(s) Case 238.

(ss) Case 136.

and within the previous six years, he is entitled to damages^(t). In very simple cases the judge may assess the damages forthwith, but it is almost an invariable rule for an inquiry to be ordered. This inquiry takes place before a Master or Referee, and although in the King's Bench Division there is power to order it to be taken before a jury, yet in patent actions this is never done. The inquiry will extend to damages arising from infringements within six years of the writ subsequent to the acceptance of the complete specification^(tt), and up to the expiration of the patent or the date of assessment, whichever is the earlier date. When the plaintiff is an assignee of the patent, no damages are given in respect of infringements before the date of his assignment^(u).

A patentee's rights are limited in the following cases—

(1) Where the complete specification has been amended, no damages can be obtained in respect of acts of infringement committed before amendment, unless the patentee satisfies the Court that the original specification was framed in good faith and with reasonable skill and knowledge^(v).

(2) Where the patent was granted after 28th August, 1907, no damages can be recovered from an infringer who proves that at the date of the infringement he was not aware, and had no reasonable means of making himself aware, of the existence of the patent. The mere fact that there are words on or applied to the patented article, implying that it is protected by a patent is not deemed to be notice of the existence of the patent, unless these words are accompanied by the year and the number of the patent^(w).

(3) Where the patentee has failed to pay a renewal or other fee in the prescribed time, but subsequently obtains an enlargement of the time for payment of such fees, the Court may, if it thinks fit, refuse to award any damages for an infringement committed after the prescribed time had elapsed and before the enlargement thereof^(x).

(4) Where a patent has lapsed owing to the non-payment

(t) Sect. 34.

(tt) Sect. 13.

(u) Case 137.

(v) Sect. 23 and Cases 238, 262, 496.

(w) Sect. 33.

(x) Sect. 17 (3).

of a prescribed fee within the prescribed time but has been restored, certain restrictions as to bringing actions in respect of infringement committed after the lapsing are inserted in the order of restoration(y).

On the inquiry as to damages the defendant is obliged to give on oath a full disclosure of the number and extent of his infringements, and the names and addresses of the persons with whom he has dealt, but not the names of his agents; the plaintiff is entitled to the production of books and to administer interrogatories.

Where the plaintiff has been guilty of a long delay in bringing his action after knowledge of infringement, and has thereby lulled the defendant into a sense of security and allowed him to build up a business and expend money and labour, the Court will not give the plaintiff damages unless he satisfactorily explains the delay.

If the defendant by his defence admits certain specified acts of infringement, and the plaintiff elects to take his judgment on these admissions, the inquiry will be limited to the damages suffered through those admitted infringements alone(z). If, before the inquiry, the defendant admits or offers a particular sum, this sum may be inserted in the order; if the plaintiff does not succeed in recovering more than such sum he will usually be ordered to pay the costs of the inquiry(a).

As a rule, an inquiry will not be stayed pending an appeal(b), but this may be done if the defendant is willing to give certain undertakings as to keeping accounts and payment into Court(c). The order for inquiry usually states the time within which payment of the amount found due must be paid.

In an inquiry as to damages, the inquiry will be as to the loss the plaintiff has suffered through the defendant's infringements, not the profit made by the infringer(d). The elements of damage which may be considered are—

- (1) The loss of profit the plaintiff has suffered in being deprived of the sale or hire of the infringing articles(e).

(y) Sect. 20 (5) and Sect. H of this chap., *post* p. 132.

(z) Case 465.

(a) Cases 73 (b), 256.

(b) Case 68 (a).

(c) Case 166 (b).

(d) Cases 373, 463 (b).

(e) Case 82.

(2) The reduction of prices which the plaintiff has been compelled to adopt through the defendant's competition(f).

(3) The reduced price at which the plaintiff might have produced or obtained the articles, if the total number had been made or obtained by him(f).

The mere fact that the plaintiff has reduced his prices, in consequence of the defendant's infringement, will not entitle him to damages on the basis of that reduction. The reduction may have been a voluntary act with the object of driving the defendant out of the market, and then it is not a measure of the plaintiff's damages(g). But if the reduction is unwillingly resorted to for the purpose of retaining the plaintiff's trade, then it will be taken as a basis of damages. Where there is other competition than that due to the defendant's infringement, the plaintiff must show that the reduction in his prices was not due to this other competition(h). It must be assumed against the defendant, as a wrongdoer, that, if he had not infringed, the plaintiff would have got the trade and thereby made a profit(i), and this presumption is difficult to displace(j). It may, nevertheless, be displaced, and where the defendant had infringed by using an infringing article, and he proved that the plaintiff's price for his article was so high that he could not possibly have bought from the plaintiff, it was held that the plaintiff had suffered no damage(k).

If the plaintiff has received damages from others, in respect of certain infringing articles, this will reduce the amount the defendant will be liable for on account of acts of infringement in respect of these identical articles, for instance where the plaintiff has received damages from a previous or subsequent seller or user of a particular article, the sale or use of which by the defendant, is complained of as an infringement. Where, however, the plaintiff has compromised an action against another infringer it must not be assumed that the damages, which he thus agreed to take, were the full measure to which he was entitled(l).

(f) Case 287.

(g) Case 16 (b).

(h) Case 463 (c).

(i) Cases 68 (b), 127, 57.

(j) Case 488 (c).

(k) Case 179.

(l) Cases 467, 57.

If the plaintiff regularly licenses his invention on certain terms, the measure of damages will be taken as the amount which he would have received from his licensees as royalties(^m), but if the plaintiff is not in the habit of granting licences, such a measure of damages cannot be adopted(ⁿ).

In the case of an infringement of a patent indorsed "Licences of right," Sect 24 (1) (e) limits the damages recoverable to double royalties; but this does not apply to infringement by importation.

Where the patented article is a comparatively small part of a large machine, the question arises whether the plaintiff is entitled to damages on the basis of the loss of sale of the small part or of the whole machine. In a case where the small part was an accessory, commonly sold separately from the machine, and the machine could be sold without that accessory or with a substituted and non-infringing accessory, the plaintiff was only allowed damages as on the sale of the accessory(^o). It is otherwise if the small part is not capable of being or is not, in fact, sold or dealt with separately; in such case the plaintiff is entitled to loss of profit on the whole machine, and this would presumably apply if the whole machine was incapable of being sold unless the patented part was attached(^p).

The defendant is not allowed credit in mitigation of damages for any infringing articles he may have been compelled to hand over to the plaintiff(^q).

(c) DELIVERY UP OR DESTRUCTION OF INFRINGING ARTICLES. A defendant, who has been found guilty of infringement, will not be allowed to retain the infringing articles, but will be ordered to state on oath the number he has in his possession and will be compelled to deliver these up to the plaintiff or to destroy them. An order of this sort is discretionary(^r) and does not affect the property in the articles, but is only for the purpose of preventing the defendant from profiting further by his infringement.

The option between delivery up and destruction is not for

(m) Cases 319 (b), 379 (a).

(o) Case 99.

(q) Case 467.

(n) Case 379 (b).

(p) Case 319 (a).

(r) Case 423 (a).

the plaintiff to exercise, but is in the discretion of the Court. If only part of the article infringes, the order will be made as to that part only(s) and, if the articles can readily be altered so as not to infringe, or if the infringing part can be removed, this will usually be ordered in preference to total destruction, if the defendant desires it. The plaintiff is usually allowed to be present or represented at the alteration or removal. An order for delivery up or destruction only affects articles at the time in the possession or control of, and belonging to, the defendant; it has not the effect of following and tainting articles which before that time have left the defendant's possession and control; nor presumably would it affect the title of a *bona fide* purchaser without notice, even if he bought after the order.

An order of this sort will never be made until after final judgment has been delivered. It may(t), but will not necessarily(u), be stayed pending an appeal. If the defendant does appeal and is successful he is entitled to a return of the articles he may have delivered up to the plaintiff(v).

(d) CERTIFICATE OF VALIDITY. Such a certificate may be granted in respect of any claim of the patent(w). Its effect is that in a subsequent action for infringement of a certified claim of the patent, the plaintiff (if successful) is entitled to his full costs, charges, and expenses as between solicitor and client, unless the Court trying the action otherwise directs. A further effect is that it enables the plaintiff in any subsequent action, if he can adduce any reasonably strong *prima facie* evidence of infringement, to obtain an interlocutory or *interim* injunction(x). In other words, it creates a presumption of validity in favour of the patent. It is presumed that such a certificate may be given of all the claims the validity of which has been established.

A certificate will only be granted where the validity of the claim is unsuccessfully challenged(y), but it may be granted even after the patent has expired(z), or where the plaintiff

(s) Case 145 (d).

(t) Case 234.

(u) Case 487.

(v) Case 492 (b).

(w) Sect. 35.

(x) *Ante* p. 81.

(y) Case 2 (c).

(z) Case 262.

fails in the action on the ground of non-infringement or any other ground than that of invalidity(a). It is usually, though not necessarily(b), refused if the action is disposed of without the Court having heard all the evidence on validity(c). For instance, it may be granted where the action is settled after some evidence has been called for the plaintiff(d).

If the defendant does not appear at the trial, or having appeared does not contest the case, the plaintiff may, on giving evidence in support of his case, obtain a certificate of validity(e); but this will not readily be given, as it would open the door to collusion(f). The certificate may be given by the Court of Appeal(g) and the House of Lords may so direct(h). It will only be given once in respect of the same claim(i) unless fresh grounds of objection are raised to the validity of the patent in a subsequent action(j), or unless the patent has been subsequently amended(k), when another certificate may (in a subsequent action) be granted. Prior to the Act of 1919 it was decided that a certificate granted before amendment of a patent ceased to be effective after amendment(l). In view, however, of the changes introduced by the Act of 1919 there are grounds for suggesting that where a particular claim of a patent has been certified an amendment of the specification which does not affect the scope of the certified claim will not render the certificate ineffective.

The granting of a certificate is in the uncontrolled discretion of the Court, and is therefore not subject to an appeal(m), and the only action in which statutory provision is made for a certificate of validity is an infringement action. A certificate was, however, in fact granted (without prejudice to its validity) in a threats action(n). It is only subsequent infringement actions (i.e. infringement actions, the writs in which are issued after the date of the certificate) that are affected by the certificate.

(a) Cases 461 (a), 444, 333.

(b) Cases 126, 461 (a).

(c) Case 255.

(d) Case 182.

(e) Cases 215, 148, 147.

(f) Cases 489, 173, 97.

(g) Case 44.

(h) Case 332.

(i) Cases 145 (c), 380.

(j) Case 167.

(k) Case 81.

(l) Case 207.

(m) Case 109 (b).

The certificate should be asked for immediately after judgment has been given at the trial, otherwise a summons should be issued or a motion made for the purpose.

(e) **COSTS.** The successful party is usually awarded costs(n). These are party and party costs and do not by any means amount to an indemnity for, nor are they as high as, the solicitor and client costs for which the party is liable to his own solicitors. Costs are in the discretion of the Judge, and the Court of Appeal will not readily interfere with the Judge's order as to costs unless it appears that he has proceeded on a wrong principle.

Where the action has proceeded to trial on any patent, any party to whom costs are awarded must also obtain a certificate as to the particulars of breaches or of objection (as the case may be) relating to that patent being reasonable and proper. No costs can be recovered in respect of any such particulars not so certified by the Judge(o). The certificate should be asked for directly judgment is delivered at the trial; if not, the party entitled to the certificate may be ordered to pay the costs of the summons or motion which would then be necessary.

A certificate is only granted to the party to whom costs are awarded(p), and is usually granted in respect of all those particulars (and those only)(q) proved or referred to at the trial(r), but it may be more restricted or more extended(s) and may be granted even where the issue raised by the particulars in question is not decided(t). It may be refused if the particulars are delivered late(u).

If the defendant does not appear at the trial the plaintiff may give sufficient evidence to justify his particulars and thus obtain a certificate. If the action does not proceed to trial on any patent the costs in respect of the particulars relating to that patent are in the discretion of the taxing master, who may deal with them without a certificate(uu).

(n) Case 492 (a).

(o) R.S.C., O LIIIA, r 22.

(p) Case 183.

(q) Case 372.

(r) Case 13.

(s) Cases 311, 297, 343, 357.

(t) Case 255.

(u) Case 12.

(uu) R.S.C., O LIIIA, r, 22. †

Where either side submits to judgment before trial, or if the plaintiff does not appear at the trial, the case is considered not to have proceeded to trial, and where the action is brought on two or more patents, and one or more of them is, or are, abandoned at the commencement of the trial, the case, so far as abandoned patents are concerned, is considered not to have proceeded to trial(v), and it is not necessary to obtain a certificate as to the particulars being reasonable and proper so far as the abandoned patents are concerned.

The Court of Appeal can, on reversing the judgment of the Court below, grant a certificate as to particulars(vv). When the House of Lords reverses the judgments of the Courts below, the successful appellant may apply to the Court of first instance for a certificate(w).

When there are two or more distinct issues in the action, and each party succeeds in respect of one or more of them, it is usual to give the costs of each particular issue to the party successful on that issue(x), and the general costs of the action to the plaintiff if he is found entitled to any relief(y), or to the defendant if the plaintiff is not entitled to any relief(z). If there are two distinct causes of action, and the plaintiff succeeds on one and the defendant on the other, costs may be awarded on the assumption that there were two actions(a).

A successful party may be deprived of all costs (e.g. where he succeeded by reason of an issue which was only raised by amendment at the trial)(b); or may be given only a fraction of the costs(c); or may simply not be given the costs of certain issues(d); or may be given full costs even of issues on which he was unsuccessful(e); or may be given the costs of certain issues but not the general costs of the action; or may be ordered to pay the costs of issues on which he was not successful(f). Where the unsuccessful party has given notice to the other party to admit a fact and he has refused, the costs of proving that fact may be given to the unsuccessful

(v) Case 75.

(vv) Case 102.

(w) Case 331.

(x) Cases 415, 382, 263 (c).

(y) Case 284.

(z) Cases 350, 444.

(a) Case 31 (b).

(b) Case 12.

(c) Case 326 (b).

(d) Case 375.

(e) Case 46.

(f) Case 28.

party(g). Where the plaintiff sues on two or more patents, but does not succeed on all of them, he will usually be ordered to pay the costs occasioned by those on which he lost(h). Where certain costs are given to one party and other costs to the other, the total amounts are ordered to be set off against each other and only the balance is recoverable. If the successful party has presented his case in such a way that the costs have been thereby increased, he will only be given such costs as would have been incurred had he adopted the proper course : e.g. where two actions were brought against the same defendant, each in respect of the infringement of a separate patent, the successful plaintiff was only given the costs which would have been incurred if both causes of action had been included in one action(i).

In cases of very exceptional difficulty, and where involved scientific questions arise, costs may be given on the higher scale(j), but this is not as a rule done in chemical cases, and even when allowed in the Court below will not necessarily be allowed on appeal(k).

The costs of a shorthand note and transcript of the evidence is usually agreed to between the parties in a patent action as being costs in the action, but apart from agreement, the judge has a discretion to allow such costs(l), though this is seldom done. The costs of the shorthand notes and transcript of the speeches of counsel are never allowed apart from agreement(m).

The question of allowing three counsel is now usually left to the taxing master, who has a discretion in the matter(n).

If the plaintiff succeeds on a claim on which a certificate of validity has been granted, he is entitled to his costs as between solicitor and client, so far as that claim is concerned, unless the judge makes an order depriving him of those costs ; and the solicitor and client costs may be awarded on the higher scale(o). The certificate of validity must have been granted before the writ in the action was issued(p). In a case where the certificate

(g) Case 414.

(h) Cases 146 (b), 234.

(i) Case 466.

(j) Cases 159, 238, 16 (b), 172 (b).

(k) Cases 28, 94 (b), 63.

(l) Cases 146 (b), 422.

(m) Case 249.

(n) Cases 164, 18.

(o) Case 167.

(p) Cases 27, 26.

was granted between the date of the writ and judgment, the plaintiff on succeeding was only awarded party and party costs(q).

As a rule, a successful plaintiff, suing on a certificated claim, will only get party and party costs if the only issue in the case is infringement or damages(r), but this is not an invariable rule(s). Solicitor and client costs may also be refused on the ground that the validity of the patent is attacked on different grounds(t) or on the ground that the action is vexatious(u).

If the plaintiff succeeds on two patents, one certificated and the other not, costs as between solicitor and client are only awarded in respect of the certificated patent and the costs attributed to the other patent are given as between party and party.

As a rule, the defendant can never get his costs as between solicitor and client, but if a Public Authority successfully defends an action, it is by virtue of Sect. 1 of the Public Authorities Protection Act, 1893, entitled to costs as between solicitor and client, and this is so even when the Public Authority is fighting the case for other parties and is indemnified by them(v).

When judgment is given in favour of the plaintiff, and an inquiry as to damages is ordered, costs of inquiry will be reserved, and the defendant is at liberty to make an offer of an amount which he thinks will be sufficient. If the defendant offers a certain sum and pays it into Court and the plaintiff is eventually awarded a sum not greater than the sum so offered and paid in, the plaintiff will be ordered to pay the costs of the inquiry subsequent to the offer or payment. A similar order was made where the offer was made in a letter, although the money was not paid into Court(w).

If either party desires to amend his pleadings or particulars he will usually be allowed to do so on the terms of paying the costs of the amendment and all costs thereby thrown away(x).

(q) Case 27.
(r) Cases 27, 57.
(s) Case 73 (b).

(t) Case 361 (c).
(u) Case 389.
(v) Case 94 (a).

(w) Case 379 (a).
(x) Case 34 (a).



If the amendment is asked for at, or shortly before, the trial, so that the other party may be prejudiced, the trial may be adjourned, and the party seeking to amend will be ordered to pay the costs of the adjournment ; or, if there is no adjournment, the amending party, if successful, may not be given any costs(y). Leave to amend may be refused if it appears that the party seeking it has deliberately kept back his case or has not used due diligence in discovering the new evidence. If the defendant seeks to amend his particulars of objection, the plaintiff will be allowed a certain time to decide whether or not he will go on, and, if he decides not to, judgment will be given for the defendant with costs up to the time of delivering the original particulars of objection, but the costs after that date will be given to the plaintiff.

Formerly, where the plaintiff sought leave to amend his specification after an action was brought, he was allowed to do so only on certain terms, including the payment of all the costs of, and occasioned by, the application to amend, or all costs of the action up to and including the application to amend, except so far as the proceedings might be utilized eventually for the purpose of the trial. In view of the provisions of Sect. 32A, introduced by the Act of 1919, it is presumed that a plaintiff seeking to amend his specification merely by cutting out certain of the claims will be allowed to do so on payment only of the costs of applying for leave to amend in this manner.

(6) The Effect of the Judgment. The judgment in an infringement action is a judgment *in personam*, that is to say, in law, it affects and is binding only on the parties to the action. As between the parties it finally disposes of the matters in issue, so that in any subsequent proceedings (other than an appeal from the judgment) between the same parties, neither is allowed to dispute the accuracy of the facts or conclusions arrived at. The judgment does not bind any other persons nor does it operate to affect the patent sued on with the two following exceptions—

(1) If the plaintiff succeeds and obtains a certificate of validity, the defendants in subsequent actions for

infringement of the same patent may (if unsuccessful) have to pay costs as between solicitors and client instead of party and party costs.

(2) If the defendant counterclaims for revocation and succeeds on that counterclaim, this will have the effect of revoking the patent ; to this extent it is a judgment *in rem*.

If, however, in one action, the judge, on the evidence, is led to put a certain construction on a patent, in any subsequent action the Court would adopt the same construction unless convinced that the former judge was misled by false evidence or by want of evidence ; but, unless the patent is revoked, the plaintiff is at liberty to sue other infringers, and even if a former action has been dismissed on the ground of invalidity, the plaintiff may, by calling fresh evidence, succeed in convincing the Court that a valid claim of his patent has been infringed, or the defendant may be held estopped from denying validity ; in the latter case, the former finding of invalidity will not prejudice the case in any way. Moreover, the patentee may, after his patent has been held invalid, apply to amend the same and after amendment the former judgment has no binding effect, although it may presumably be referred to for the purposes of construing or deciding the validity of the amended patent⁽²⁾.

If an injunction has been granted and the defendant is guilty of a breach, the plaintiff may move for attachment (in the case of an individual) or sequestration (in the case of a company or corporation) ; but if, as often happens, the defendant makes some alteration in what has been found to be an infringement, in the hope of escaping the effects of the injunction, then, on the plaintiff's motion for attachment or sequestration, an issue will have to be decided, on the evidence, precisely similar to the question of infringement.

Section B.—ACTIONS TO RECOVER ROYALTIES.

An action to recover royalties is precisely similar to any other action so far as its procedure is concerned. If the defendant admits that he has a subsisting licence from the

(2) Sect. 21 (7).

plaintiff the only issue will be whether what the defendant has done comes within the licence granted; this usually resolves itself into a question whether the defendant has used the plaintiff's invention and is therefore precisely similar to a question of infringement. The defendant may not, during the subsistence of the licence, challenge the validity of the patent licensed, unless there is an express provision enabling him to do so, but he may call attention to the state of the art at the date of the patent so as to enable the Court to ascertain the limits of the monopoly thereby granted(a). When the royalties are an ascertained sum payable at a given date by reason of the written licence, then the plaintiff may recover interest at a prescribed rate.

Section C.—REGISTER OF PATENTS.

In any negotiations in respect of patent rights it is most important to be able to discover who is the legal owner of the patent and whether the title is clear of incumbrances. Several persons may have interests in the patent either as part proprietors, licensees, mortgagees or otherwise. Pursuant to the provisions of the Patents Acts(b), a Register of Patents is kept at the Patent Office, which contains the above and other useful information respecting every patent granted.

The following are matters which are entered on the Register—

- (1) The title of the invention(c).
- (2) The names, addresses, and nationality of the grantees(c).
- (3) The address for service(c).
- (4) The date of the patent and of the grant of the patent(d).
- (5) The payment of renewal fees(e).
- (6) Amendments of the complete specification(f).
- (7) Extension of the term of the patent(f).
- (8) Compulsory licences and licences of right(f).
- (9) Revocation(f).
- (10) Restoration(f).
- (11) Assignments(g).

(a) Case 508. (c) Rules, 86, 88. (e) Rule 94. (g) Sects. 28 (1), 71 (1).
 (b) Sect. 28. (d) Rules, 86, 87. (f) Sect. 28 (1).

(12) Mortgages(h).

(13) Transmissions by operation of law(g).

(14) Notices of any equitable interests(h) but not including trusts(i).

(15) Licences(h).

An opposition to the grant of a patent is not noted on the Register, but the notice of opposition and the decision of the Comptroller can be inspected at the Patent Office. The Acts provide that any person entitled by assignment, transmission or other operation of law to a patent, or entitled as mortgagee, licensee or otherwise to an interest in a patent *shall* apply to the Comptroller to register his title or notice of his interest(j). Patents Forms 30 to 35 are provided for notifications, corrections of clerical errors in, and applications to the Comptroller to amend the Register or to enter the title to, or notice of an interest in, the patent(k). Such applications must be supported by attested copies of documents of title, and the original documents or further proofs of title may be called for(l). The entry with regard to an interest in the patent, other than an assignment, is limited to a notice of the interest, and does not extend to all the particulars and considerations governing the interest(m).

The legality of documents is not queried provided they are in order(n), but no notice is entered of any document which does not give a definite interest, legal or equitable(o). No entry is made in the Register until a patent is granted, but notices of documents of prior date can subsequently be entered(p).

The Register is open to inspection during official hours(q), and a certified copy of any entry may be obtained by application (Patents Form 36)(r).

It is very important that any person acquiring a patent, or any interest therein, should have his title or notice thereof entered in the Register, as no unregistered document of title to a patent, or to any interest therein (including licences), can

(g) Sects. 28 (1), 71 (1).	(k) Rules 88, 89, 93, 96; Sect. 70 (c).	(o) Case 165.
(h) Sects. 28 (1), 71 (2).	(l) Sect. 28 (4); Rules 90, 91.	(p) Case 364.
(i) Sect. 66.	(m) Rule 92.	(q) Rule 95.
(j) Sects. 71 (1), (2).	(n) Case 404 (b).	(r) Rule 97.

be put in evidence in any Court of Law as proof of such title unless the Court otherwise directs(s), except on an application to the Court to rectify the Register(t). Any person aggrieved by an entry in or omission from the Register of Patents may apply to the Court to obtain rectification(t). Such an application is made by summons. Further, a person registered as the proprietor of a patent has the right to assign, grant licences under or otherwise deal with the patent and to give effectual receipts for any consideration for such assignment, licence or dealing, subject to any rights appearing from the Register to be vested in any other person(u). Equities in respect of a patent can be enforced as in respect of any other personal property(u). The Register of Patents is *prima facie* evidence of any matters directed by the Acts or authorized to be inserted(v), and any entry can be proved by a certified copy(w).

Section D.—THE TRANSFER OF PATENT RIGHTS.

Patent rights are a recognized species of property and can pass or be transferred from the original or any subsequent patentee to any other person or persons. It has previously been pointed out that a patent does not give the patentee the right to make, use or sell the invention but merely to prevent others from so doing(a). A patentee can therefore deal with his patent rights in two ways ; he may either transfer to another person the right or a part of the right (or the benefit thereof) to prevent others from making, using or selling the invention, or he may by agreement (express or implied) debar himself from exercising those rights or part of them against certain persons, ascertained or ascertainable.

The former is called an assignment and the latter a licence.

Licences are thus not transfers of patent rights and will be considered hereafter(b). In this section we deal with the transfer of patent rights ; this may result by either—

- (1) Assignment ; or
- (2) The operation of law.

(s) Sect. 71 (4).

(v) Sect. 28 (3).

(a) Chap. I, *ante* p. 2.

(t) Sect. 72.

(w) Sect. 79.

(b) *post* p. 111.

(u) Sect. 71 (3).

(1) **Assignments.** An assignment is an act of a patentee whereby the patent rights are wholly or in part transferred and the assignee receives the right to prevent others from making, using or selling the invention(e). An assignment may be that of the whole or any share of the patent(d), or any part of the invention protected(e), and for the whole or any part of the United Kingdom and the Isle of Man(f), and for the whole or any fraction of the term of the patent. If the assignee does not become the sole owner, it should be agreed who is to pay the renewal fees. Where, by assignment, two or more persons become co-owners of the patent, they may, according to the form of the assignment, be either joint tenants or tenants in common. In the former case, the property passes on the death to the survivor or survivors; and in both cases each owner is entitled (apart from agreement) to use the invention for his own benefit without any liability to account to the other or others(g). One co-owner cannot by himself grant an effective licence without the consent of the other or others(g). Joint owners form one legal *persona* and can therefore only deal with their patent rights collectively, whereas a tenant in common is at liberty to assign his share as he pleases.

An assignee is *prima facie* entitled to the profits flowing from the patent subsequent to the date of his assignment, and is therefore entitled to the damages for any infringements which have taken place after that date(h).

There are three kinds of assignments—

- (a) Legal assignments.
- (b) Equitable assignments.
- (c) Mortgages.

(a) **LEGAL ASSIGNMENTS.** A legal assignment is an assignment of (or an agreement to assign) an existing patent by deed(i); i.e. by a document under seal and acknowledged or delivered as such by the assignor or his agent appointed by deed(j). A legal assignment may operate as from its date or

(c) Case 219 (b).

(f) Sect. 14 (1).

(i) Case 440.

(d) Case 17.

(g) Sect. 37 and *post* p. 136.

(j) Case 217.

(e) Case 481.

(h) Case 137.

on the happening of a specified future event(k). No special form of words is necessary, provided that the intention to assign is made sufficiently clear, and no consideration need be shown. If a legal assignee has notice of a prior equitable interest or a right to a share of the profits(l), or a charge(m) in a third party, he takes subject to that interest or right or charge, but his title cannot be affected by such interests, rights or charges of which he had no notice at the date of the assignment, and even notice will not affect his title unless his assignor's title is similarly affected(n). The above rules will not, however, protect a person guilty of fraud or a trustee who obtains possession of the trust estate(n). A legal assignee is entitled on application to the Comptroller to have his name entered on the Register of Patents as the proprietor of the patent(o). He may then sue infringers and exercise all other rights as patentee.

(b) EQUITABLE ASSIGNMENTS. An equitable assignment is any document or agreement (not under seal) affecting the proprietorship of an existing patent, and any document (whether under seal or not) or agreement (whether oral or in writing) purporting or agreeing to transfer a patent not then granted(p). The difference between a legal and an equitable assignment lies in this, that, whereas a legal assignee is entitled to be registered and can then sue infringers and exercise all the other rights of an owner of the patent, an equitable assignee must first obtain a legal assignment before he is in that position(q), but he can sue his assignor and compel him to execute such an assignment in the event of refusal(r).

If the assignment of a patent before it is granted does not identify the invention clearly and is not made conditional on the grant being obtained in a particular form, the purchaser may find himself liable to pay the purchase consideration for a patent which is so limited as to be practically worthless. The assignment of (or agreement to assign) an invention together with all benefits and privileges attaching thereto may,

(k) Case 90.

(n) Case 5.

(q) Cases 267, 404 (b).

(l) Case 497.

(o) *ante* p. 104.

(r) Case 440.

(m) Case 116.

(p) Cases 440, 54.

and usually does, include more than the assignment of a particular patent. Considerable care is therefore necessary in drawing up agreements relating to an invention for which a patent has not been granted.

Although an equitable assignee cannot have his name entered on the Register as owner of the patent, he may have notice of his document of title (if any) so entered^(s). Where an inventor makes an application for a patent which he in writing agrees, or has agreed, to assign, and subsequently refuses to proceed with the application, the Comptroller may (subject to an appeal to the Law Officer) allow the assignee to proceed with the application and may grant a patent to him^(t).

There are two classes of cases where agreements relating to future patents require particular consideration, namely—

(i) Where an inventor on assigning an existing patent covenants to communicate improvements.

(ii) Where a servant, by the terms of his contract of service, agrees to give his master the benefit of all inventions made by him.

(i) *Covenants to communicate improvements.* In deciding the effect and ambit of such a covenant, the actual words used must be considered in relation to the surrounding circumstances and the language of the rest of the agreement; no hard and fast rules can be laid down. It is important first to consider whether the covenant is to communicate improvements on an invention claimed in a specified patent or on an article of commerce which (or part of which) is protected by a patent; in the former case, the covenant will be limited to improvements of the elements or combinations which constitute the novel features of the claims^(u); in the latter case, the covenant may extend to anything which makes the article more serviceable or to any substituted article which performs the same function whilst retaining one or more of the essential or characteristic parts^(v). Where the words are “improvements in or addition to,” they have a somewhat wider effect.

(ii) *Contracts of service.* If the contract of service is in

(s) Rule 92 and *ante* p. 105.

(t) Sect. 12 (1) (a).

(u) Case 408.

(v) Case 294 (b).

writing and there is a specific clause to the effect that the inventions of the servant shall belong to the master, no difficulty arises. If the contract is oral then its terms have to be ascertained from the evidence of witnesses. Even if there is no specific term to such effect, it may, in some cases, be implied from the circumstances. Generally speaking, apart from such specific term, the invention of a servant does not belong to his master, even if made in the master's time, with the use of his materials, and at his expense^(w); but where it is a fair inference from the circumstances of the case, having regard to the obligations arising from the service and the good faith which is imposed on both sides, the Courts will infer an agreement that the master should have the benefit of the servant's inventions^(x). It must not, however, be forgotten that the right of one person to the benefit of another's invention does not obviate the necessity of the real inventor being a party to an application for a patent.

(c) **MORTGAGES.** A mortgage is a document which transfers the patent rights (or some part of them) to the mortgagee in order to secure the payment of a sum or sums of money. When the money has been repaid the mortgagor is entitled to a re-transfer of the patent. Mortgages may be either legal or equitable, and the same principles apply to them as to the other forms of assignments. A mortgagee is not entitled to have his name entered on the Register as patentee, but he can have notice of his mortgage so entered^(y).

(2) Transfers by the operation of law. On the death of the patentee, the question as to how his interest in the patent devolves depends on how he held the patent.

On the death of a sole patentee, or the sole owner of a part of a patent, or one of two or more joint grantees of a patent granted since 28th August, 1907, or of a tenant in common of a patent, his beneficial interest passes to his personal representative as part of his personal estate^(z). On the death of one of two or more joint owners (by assignment) of any patent (or part of a patent) or joint grantees of a patent, granted

(w) Cases 218, 47.

(x) Case 505.

(y) Sect. 71 (2); Rule 89; *ante* p. 105.

(z) Sect. 37.

before 28th August, 1907, his interest in the patent passes to the survivor or survivors. On the bankruptcy of a patentee, his interest passes to the receiver, trustee or assignee of his estate in bankruptcy.

If, after executing an equitable assignment, the patentee disappears, so that the assignee cannot complete his title by obtaining a legal assignment, the Court may, on application, make a vesting order under Sect. 35 of the Trustee Act, 1893^(a).

If a company, the registered owner of a patent, be wound up and dissolved without the patent being legally assigned, a person entitled to such assignment may, it is conceived, apply under Sect. 223 of the Companies (Consolidation) Act, 1908, for an order declaring the dissolution to have been void, and the Court may within two years of the dissolution make such order. If the two years have elapsed, or in other cases where the above procedure will not apply, it may be possible to get the Board of Trade to direct the Comptroller to enter the name of the equitable assignee as proprietor on the Register^(b).

Section E.—LICENCES UNDER PATENTS.

The grant of a licence by a patentee is one of the ways in which he may deal with his patent rights. As already pointed out, in the preceding section^(c), a licence does not transfer any rights of the patentee, but is merely a permission to do what otherwise would be illegal^(d), and the patentee simply divests himself of his rights to the extent of debarring himself from enforcing his rights under the patent against the licensee in respect of acts which fall within, and are in conformity with, the terms of the licence. The permission may be granted in express terms or may be implied from circumstances. In addition, there are statutory provisions which enable certain persons to obtain licences in given circumstances even against the wish of the patentee.

The subject may be conveniently dealt with under the following heads—

(1) Express licences. (2) Implied licences. (3) Statutory licences.

(a) Cases 181, 349, 445.

(b) Case 445.

(c) *Ante* p. 106.

(d) Case 219 (b).

(1) **Express licences.** An express licence is one in which the permission is given in express terms. It is not essential that it should be in writing, though for the sake of certainty it is extremely advisable, and in practice a licence is usually granted by deed, which must be stamped like other agreements. A mere licence is revocable unless coupled with an interest, or unless there are mutual obligations(e), but a specific power given to one party to revoke, negatives such power in the other party(f), and if the licence is revocable in certain events, it can only be revoked if those events happen. Where the licence is in writing, covenants and terms will not be implied unless, on considering the agreement in a reasonable and business manner, the implication necessarily arises that the parties intended that the covenants and terms should exist(g). In the case of a carefully prepared deed, covenants and terms can only be implied where the inference that they were in the contemplation of, and intended by, the parties is irresistible(h). It is therefore important that a licence should state explicitly what is to happen in case the patent lapses, or is revoked, or is declared invalid, or the licensee is sued by other parties on the ground that the licensed invention is an infringement of their patent rights. A covenant by the licensor to sue infringers implies a covenant on his part to pay renewal fees, and failure to pay these fees may amount to a total failure of consideration(h). A licensee may find himself liable to pay royalties after the patent is revoked(i), or after he has been restrained by an injunction at the suit of other parties from exercising the licensed invention. Where there are covenants on one side and the other, the breach of a covenant by one party does not release the other party from his obligations, unless the covenants are made conditional or dependent on, or co-extensive with each other(i). A failure to pay renewal fees on some of the patents licensed may amount to a total failure of consideration and relieve the licensee from the obligation to pay royalties(k). Where mutual covenants go

(e) Cases 395, 108, 193.

(h) Cases 324, 114.

(j) Case 324.

(f) Case 115.

(i) Cases 9, 324.

(k) Case 114.

(g) Case 201.

to the whole consideration on each side they are mutual conditions, the one precedent to the other⁽¹⁾. If the liability to pay royalties is dependent on the patent being kept in force, a licensee can recover royalties paid subsequently to and without knowledge of the lapsing of the patent^(m).

A licence is not assignable unless there is a specific clause to that effect ; but if a licensor recognizes, and accepts royalties from an assignee of the licence, he may not afterwards dispute the assignee's right to the licence⁽ⁿ⁾.

A licence may be for the term or extended term of the patent or any shorter period ; it may be exclusive, in which case the licensor is not at liberty to grant other licences or exercise the invention himself ; it may license only the manufacture, or only the use, or only the sale of the invention, or any two or all three ; it may license the whole invention or any particular phase, or modification or part of it, or the subject-matter of one or more of the claims ; and, finally, it may be restricted to any defined area or extend to the whole of the United Kingdom and the Isle of Man. An irrevocable and exclusive licence amounts to an assignment. The effect of inserting certain onerous terms in a licence, imposing unfair conditions on the licensee, is dealt with in Section A (4) (e) of this chapter.

(2) **Implied licences.** An implied licence is one in which the permission is not expressed but is implied from the surrounding circumstances. If an act be done in the presence or with the knowledge of the patentee and without any protest or objection on his part, the Court may imply that permission was given by him. If a patented article is bought either at home or abroad, and either directly or indirectly from the patentee or one of his licensees, there is an implied licence to use the article in any way and to re-sell it^(o). The patentee is at liberty to sell, subject to restrictions on the subsequent use or dealing with the article, provided those restrictions do not offend against the provisions of Sect. 38 ; but no purchaser is bound by those restrictions unless he has notice of

(1) Case 324.

(m) Case 293.

(n) Case 285.

(o) Cases 42, 452, 340.

them or they are actually known to him at the time he buys^(p). Similarly, a purchaser of a patented article without notice of a prior exclusive licence, or equitable assignment, granted by the patentee to a third party, is not affected by such licence or assignment, even if notice thereof is entered on the Register^(q).

It has been suggested that a purchaser from a restricted licensee takes subject to the restrictions even if he has no knowledge of them^(r), and this is so if the licence restricts the licensee to making or using ; but a purchaser from a licensee, who is empowered to sell, is not affected by restrictions of which he had no notice at the time of purchase^(s).

The remedy of a patentee against a purchaser, who, having bought with knowledge of restrictions, violates them, is an action for infringement. It is therefore obvious that restrictions imposed by a licensee of the patentee have no force whatever apart from contract. If a licensee sells subject to restrictions, he may be enabled to enforce those restrictions against his immediate purchaser if they form terms of the contract of sale, but any subsequent holder of the patented article is not liable to any action *by the licensee* for breach of these restrictions, even if he has notice of them. Although the patentee may, in some cases, have an action for infringement against him, the licensee can have no such action.

(3) Statutory licences. These include : (a) "Compulsory licences" ; (b) "Licences under patents indorsed with the words 'Licences of right.'"

(a) COMPULSORY LICENCES. These are licences granted on application to the Comptroller, irrespective of the wishes of the patentee. They constitute a liability on the patentee and are considered in Chapter VII (*post* p. 149).

An order for the grant of a licence operates as a duly executed deed of licence without prejudice to any other means of enforcement^(ss).

(b) LICENCES UNDER PATENTS INDORSED WITH THE WORDS "LICENCES OF RIGHT." These are licences to which a person

(p) Cases 247, 248. (q) Case 219 (a). (r) Case 32. (s) Case 340. (ss) Sect. 27 A.

is entitled as of right under a patent so indorsed. The indorsement may arise in two ways. It may be ordered by the Comptroller as the result of the abuse of the monopoly rights by a patentee(t), or the patentee may himself apply to have the patent so indorsed(u). In either case the indorsement imposes a liability on the patentee, which is further discussed in Chapter VII. It remains here to consider the right of a patentee to have his patent indorsed(v). The request (Patents Form 20) must be accompanied by a statutory declaration and such other evidence as the Comptroller may deem necessary to show that the patentee is not precluded from making the request. A patentee is not deemed to be precluded from a right to have the patent indorsed by reason of having granted a licence under a patent when the licence does not limit his right to grant other licences. The request is advertised in the *Illustrated Official Journal (Patents)*, and any person alleging that the request has been contrary to some contract in which he is interested may apply to the Comptroller within one month of the advertisement for the refusal of the request. The application for refusal (Patents Form 21) must be accompanied by an unstamped copy, and must include the nature of the opponent's interest and the facts on which he bases his case. The parties are heard and the procedure is the same as in opposition proceedings (*ante* pp. 41 and *seq.*).

Renewal fees, payable on a patent indorsed "licences of right," are from the date of the indorsement, half only of the fees which would otherwise be payable(w).

Section F.—THE AMENDMENT OF SPECIFICATIONS.

After an application for a patent has been filed and during its passage through the Patent Office amendments will be called for by the Examiner if the requirements are not complied with, and amendments may also be made as a result of the investigation prescribed by Sects. 7 and 8 of the Acts. Such amendments are considered in Chapter II.

Apart from such amendments an applicant for a patent

(t) Sect. 27 (3) (a).

(u) Sect. 24 (1).

(v) Rules 69–75, *post* p. 235.

(w) Sect. 24 (1) (f).

may desire to make other amendments before the patent is granted, or the patentee may desire to amend the specification after the patent has been sealed.

If before the official examination and investigation have been completed an applicant desires to amend the specification or drawings, and the amendments are of small extent or by way of giving a fuller or more satisfactory description, and are such as the Examiner might reasonably have asked for, the Comptroller has discretionary power under Rule 110 to allow the amendments without the payment of a fee, and it is usually possible to effect such amendments during the course of the official examination. If the amendments are of a substantial nature and involve a re-examination or a further investigation, under Sects. 7 and 8, this discretionary power will only be exercised on formal application, and payment of the same fee, as is prescribed in the case of an application to the Comptroller to amend a specification under the provisions of Sect. 21, which is considered below.

In respect of clerical errors the Comptroller may, at any time, on request in writing (Form 35), accompanied by the prescribed fee (10s. before sealing and £1 after sealing), correct any clerical error in, or in connection with, an application or in any patent or specification^(x); evidence may be required to show that the amendments sought are merely clerical errors.

For amendments other than merely clerical errors, certain conditions are laid down by the Acts with regard both to the nature and extent of amendments which are allowable, and to the procedure.

In ordinary cases an application is made to the Comptroller^(y) under the provisions of Sect. 21, but if there is proceeding any action for infringement of the patent, or a petition before the Court to revoke the patent, then the application must be made to the Court^(z). An action for infringement is pending from the time the writ is issued to the date of the final judgment of the Court of first instance^(a) or the date when the action is discontinued^(b). A petition for revocation is pending from

(x) Sect. 70 (a) and Rule 96.

(y) Sect. 21.

(z) Sect. 22.

(a) Case 111.

(b) Case 80.

the date it is presented and filed until disposed of by a final judgment or order of the Court of first instance(c). An appeal, under Sect. 26, from a decision of the Comptroller would, apparently, not be considered a proceeding before the Court for revocation of the patent.

The nature and extent of the amendments which may be allowed are the same whether the application is made to the Comptroller or to the Court. It will be convenient to consider the subject under the following heads—

(1) What amendments are allowable.

(2) Applications to the Comptroller.

(3) Applications to the Court.

(1) What amendments are allowable. The amendment must be by way of “disclaimer, correction or explanation(d).” Disclaimer means removing, or cutting out, from the original specification something which was originally claimed(e). Correction means putting right some statement which does not accurately convey the meaning which the patentee originally intended to convey(f). Explanation means an addition or alteration which makes clear the original meaning intended to be conveyed by the patentee, or more fully or clearly defines the invention claimed(g). Although the only amendments which are allowed are those defined above, yet it does not follow that every amendment falling within those limits will be allowed.

No amendment is allowed which would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment(h). It is therefore not possible to excise words of limitation from the body of the specification or from the claims, nor is it allowable to remove from a claim, claiming several elements in combination, one or more of these elements. A claim for the combination of A and B is substantially larger than one for the combination A, B, and C(i). Conversely an amendment

(c) Case 503.

(d) Sects. 21 (1) and 22.

(e) Case 393.

(f) Case 39.

(g) Case 23.

(h) Sects. 21 (6) and 22.

(i) Case 101.

by way of claiming in combination, features, one or more of which were claimed separately, will usually be allowed, but it must be clear from the specification as it stands before amendment that the features were intended to be used in combination and that such combination was intended to form part of the invention(j). Such amendments are allowed on the ground that the amendment is by way of limitation and does not make the specification claim a different invention. Although, however, a suggested new claim may not enlarge the invention, it may be a claim for a substantially different invention, and if so the amendment will not be allowed. For instance, an amendment was not allowed by way of introducing features into a claim so as to make it a claim for a combination where the combination was not suggested in the specification as it stood before amendment, even though the features introduced had been in the original specification and deleted as a result of a previous amendment(k). Nor was it permitted to introduce the word "adjustable" into the description of a part of a machine and into the claim(l); nor to strike out a claim and substitute a claim for a subordinate integer described in the specification, but not claimed(m).

Generally speaking, if an amendment would have the effect of clothing the invention claimed with an inventive ingenuity it did not previously possess, it will not be allowed(mm).

Ambiguity may be removed and the meaning of the specification may be made clearer(n); but subsequent knowledge may not be incorporated(o), nor will extensive amendments, which amount to a re-writing of the specification, be allowed(p). The Court or the Comptroller will not allow a disclaimer to be used solely for the purpose of turning an insufficient description into a sufficient one(q), or a barren and unprofitable generality into a specific, definite, and practical description(r). The patentee cannot cut out of the body of the specification statements the truth of which he doubts(s), but he may cut out claims and portions of the description exclusively relating

(j) Cases 190, 213.

(k) Case 213.

(l) Case 480.

(m) Case 419.

(mm) Case 65.

(n) Cases 23, 405.

(o) Cases 39, 258.

(p) Case 339.

(q) Case 258.

(r) Case 393.

(s) Case 15 (b).

to those claims. The drawings may be cut out, altered or added to, within the limits pointed out above(t).

An applicant to amend is claiming an indulgence and must therefore clearly bring himself within the above rules(u). Amendments will not be allowed unless they are free from ambiguity and difficulty, nor if their effect is not quite clear(u). Account may be taken of the patentee's conduct with relation to his patent rights, and if it appears that he has abused those rights (e.g. by publishing unjustified threats) then leave to amend may be refused(v).

If the patent has been held invalid by the House of Lords, amendments will not be allowed, unless they clearly remedy the defects in the specification(w) and no amendment will be allowed if the whole invention has been found incapable of forming the subject-matter of a valid patent(w). If it is clear that the original claims are so wide as to be invalid, the applicant must show that the proposed amendments will make the claims valid(x). There is no rule limiting the number of times a specification may be amended, but in practice it is very difficult to obtain leave to amend more than once(y).

(2) **Applications to the comptroller(z).** The application is made in the terms of Patents Form 18, and the fee is 30s. before sealing and £3 after sealing. The application must include a statement of the reasons for making the amendment, e.g. that there are statements which require correction or explanation, or that the true meaning is not sufficiently clear, or that the patentee is advised that by reason of some claim the patent might be or has been held invalid. The application must be accompanied by a certified copy of the specification showing the proposed amendments in red ink. The request to amend and the amendments are advertised in the *Illustrated Official Journal (Patents)* and in such other manner (if any) as the Comptroller may direct. Any one or more persons may oppose and for this purpose must enter notice of opposition (Patents Form 19) within one month of the first appearance

(t) Case 281.

(u) Cases 363, 224.

(v) Case 65.

(w) Case 224.

(x) Cases 20, 269.

(y) Cases 95, 196.

(z) Rules 64-68.

of the advertisement by leaving the said notice, together with an unstamped copy thereof, at the Patent Office. The procedure as to filing evidence, the hearing, the Comptroller's decision, costs and appeal are substantially identical with the proceedings in opposition to the grant of a patent described in Chapter III. After leave to amend has been given the applicant must, if so required, and within the time required, leave at the Patent Office a new specification and drawings as amended. All the amendments allowed are advertised in the *Illustrated Official Journal (Patents)* and in any other manner (if any) required by the Comptroller.

The discretion of the Comptroller and the Law Officers in allowing or refusing amendments is absolute and cannot be interfered with or reviewed by the Courts^(a). Leave to amend duly granted upon application to the Comptroller is, apart from fraud, conclusive, and amendments so allowed cannot subsequently be challenged in any proceedings^(b).

It is within the power of the Comptroller or the Law Officers to impose conditions on the patentee seeking leave to amend, but where leave is obtained it is unusual to impose conditions. An opponent seeking protection in this way must clearly make out his case^(c). The patentee will not be forced to give an undertaking not to sue any particular person or persons for infringement unless he has by his conduct encouraged them to build up a large business on the assumption that his patent was invalid^(d).

(3) Applications to the Court. The provisions of Sect. 22 and Order 53A, Rule 23, of the Rules of the Supreme Court apply. The leave of the Court must be obtained before application to amend can be made.

Application for leave to apply to amend is made to the Court by motion in the pending proceedings or, if there are two or more pending proceedings, in one of them. Notice of motion must be given to all the parties to the proceedings, and must be accompanied by a King's printer's copy of the specification, showing the proposed amendments in red ink.

(a) Cases 472, 424.

(b) Sect. 21 (7) and Case 335.

(c) Case 10.

(d) Case 14.

On hearing the motion the Court decides whether and on what terms the application shall proceed and gives directions as to how the evidence (if any) shall be given. The applicant must then serve the Comptroller with the notice of motion, together with the specification showing the proposed amendments as aforesaid, a copy of the order made on the motion, and the name and address of the applicant's solicitor. The proposed amendment, with the name and address of the applicant's solicitor, is advertised in the *Illustrated Official Journal (Patents)*. Any person desiring to oppose must give notice to the applicant's solicitor within fourteen days of the appearance of the advertisement, and if an address of service be given within the United Kingdom, then the applicant must serve (by prepaid registered post, if desired) such person with similar papers to those served on the Comptroller. The application is to the Court and is set down for hearing in the witness list, if it is to be heard on oral evidence, or in the non-witness list if it is to be heard on affidavit evidence. It is heard or decided by the Court or Judge before whom the proceedings are pending. The Comptroller has the right to appear and be heard at the hearing, and must do so if so directed by the Court. If the Court allows the specification to be amended the applicant must lodge with the Comptroller an office copy of the order, and the Comptroller must advertise the amendment in the *Illustrated Official Journal (Patents)*, and the applicant must, if required by the Court or by the Comptroller, lodge at the Patent Office a specification showing the amendments.

Terms are almost invariably imposed by the Court, as a condition of leave to amend. Such terms are in the absolute discretion of the Court(e). Formerly, these terms have usually been that the patentee should pay the costs of all pending proceedings up to date, and of all parties properly appearing on the application to amend(f); that the patentee should not seek any relief in respect of infringing articles in the hands of the public before amendment; and, unless the patentee proves that the original specification was framed in good faith and with

(e) Cases 11,1282, 345.

(f) Case 292.

reasonable skill and knowledge, that no action should be brought in respect of the use or, sale of, any article made or imported prior to amendment(g). The terms must be such as to give the other party litigant full protection(h). Unless the circumstances are special, the condition that the patentee shall not sue in respect of infringements prior to the amendment, and shall not give the amended specification in evidence in pending proceedings, will not be imposed(i). In view of the provisions in Sect. 32A, introduced by the Act of 1919, it is presumed that the terms imposed will, in some cases at all events, be less onerous on the patentee than formerly.

When judgment is given on a petition revoking the patent it will usually be suspended if the patentee wishes to apply to amend. Such application is then made to the Comptroller under Sect. 21, and leave of the Court is unnecessary(j).

When application to amend has been made before the commencement of proceedings the amended specification is the proper document to put in evidence at the trial, even if leave to amend has only been granted subsequent to the commencement of those proceedings(k).

Section G.—EXTENSION OF THE NORMAL TERM OF A PATENT.

The normal term of a patent is limited to sixteen years from the date of the patent(l), except in cases of patents of addition of which the normal term expires with the parent application(m). It is, however, possible in certain circumstances and conditions to obtain an extension of the term for a period of five years, or, in exceptional circumstances, ten years(n). Prior to the Act of 1919 the only ground on which an extension could be obtained was that the patentee had not been adequately remunerated and the procedure was by petition to the Court. The Act of 1919 introduced an additional ground, namely, that the patentee, as such, has suffered loss or damage as the result of war, and the procedure on this ground may be by originating summons(o).

(g) Case 184.

(j) Case 53.

(m) Sect. 19.

(h) Case 53.

(k) Case 439.

(n) Sect. 18.

(i) Cases 120, 59 (b).

(l) Sect. 17 (1).

(o) Sect. 18 (6).

(1) Petitions on the ground of inadequacy of remuneration.

It will be convenient to consider these under the following heads—

(a) The Petition.

(b) What the petitioner has to prove.

(c) Opposition to the petition.

(d) Procedure.

(e) Principles and conditions on which the Court grants extensions.

(a) **THE PETITION.** The petition must be presented by the patentee(p), i.e. the person for the time being entered on the Register as the grantee or the proprietor of the patent(q), and all persons having an interest should be joined(r), including the personal representative of a deceased patentee, who still retained some interest at his death(s). It must contain a full, concise, clear and explicit statement of all material facts connected with the invention, and the attempts which have been made to bring it into use(t). The utmost good faith must be shown in setting out the facts, as any attempt at concealment will be fatal. The whole history of everything bearing on the matter should be stated on the face of the petition(u), including the foreign patents which have been applied for and obtained(t). All dealings with and agreements relating to the patent rights must be fully disclosed(v). It must be made clear what persons are to derive benefit from the proposed extension and what is the interest of each(w). The petition must also show what profits (if any) have been made by licensees(x). Two or more patents may be included in the same petition(y). The petitioner, if not the original patentee, must show clearly how he derives his title(z), and also what remuneration the real inventor himself has made, even where he is a foreigner and the invention has been imported(a). There must also be shown the profits made by the inventor in selling shares of a foreign company(b).

(p) Sect. 18 (1).

(q) Sect. 93.

(r) Case 421.

(s) Case 498.

(t) Cases 259, 6.

(u) Case 436.

(v) Case 163.

(w) Case 240.

(x) Case 457.

(y) Case 96.

(z) Case 246.

(a) Case 368.

(b) Case 384.

The petition must be accompanied by accounts of receipts and expenditure, which must clearly set out and summarize the total receipts and expenditure in respect of the invention(c); the accounts must leave no doubt as to the amount of remuneration(d). It is the patentee's duty to keep accurate books from which these accounts may be taken(e); but where the books have been lost other evidence of profit and loss may be allowed(f). The patentee is entitled in the accounts to charge a reasonable sum for the time he has given and expenses he has been put to in bringing the invention before the public(g), and also to deduct the reasonable costs of experiment and manufacture(h); but where the petitioner has manufactured the invention as part of his ordinary business the accounts must clearly distinguish the general business from the patent business(i). The accounts must include the profit and loss in respect not merely of the British patent but also of all foreign and colonial patents for the same invention(j), and also any money received as director or by sale of shares of a company to which the patent has been assigned(k). Satisfactory accounts are a condition precedent to obtaining an extension, even if inadequacy of remuneration be clearly shown(l), but if there are no profits at all, but only heavy losses, extreme accuracy of accounts is not required(m). The accounts should include the profits of a company to which the patent has been assigned(n), and the statement of remuneration must be unreserved and clear(o).

(b) WHAT THE PETITIONER HAS TO PROVE. The petitioner must establish three things, even if the petition is not opposed(p)—

(i) That the invention is one of merit.

(ii) That he has done everything possible to introduce the invention and make a profit.

(iii) That there has been an inadequacy of remuneration due to circumstances not under his control.

(c) Case 223.

(d) Case 507.

(e) Case 274.

(f) Case 246.

(g) Case 88.

(h) Cases 119, 413.

(i) Case 138.

(j) Case 259.

(k) Cases 36, 308.

(l) Cases 275, 6.

(m) Case 117.

(n) Case 122.

(o) Case 230.

(p) Cases 303, 305, 352.

(i) *That the invention is one of merit.* The petitioner must show merit of ingenuity as well as merit of utility, and of the two, the latter is by far the more important(^q). It is only in cases where the public will obtain advantages from the invention that an extension will be granted(^r). Apart from utility, only a *prima facie* case of validity need be made out(^r) ; if this be done, the Court will not inquire further into validity, but it will not extend the term of an obviously invalid patent(^s). A decision of the Courts, that the patent is invalid, which decision is subject to an appeal, is not necessarily a bar to an extension(^t). The fact that an invention has not come into general use will raise a presumption against its utility(^u), which it is difficult, though not impossible, to rebut(^v). For instance, the illness(^w) or financial embarrassment(^x) of the patentee may be sufficient excuse ; or it may be sufficient that the nature of the invention is such that it necessarily requires a long time for its establishment(^y). Simplicity of the invention will not detract from, but rather add to, its merit(^z).

(ii) *That he has done everything possible to introduce his invention and make a profit.* Delay or slackness in pushing the invention will be fatal unless reasonably explained(^a) ; for instance, where, by reason of quarrels of the patentee, the invention had not been worked, an extension was refused(^b). The petitioner must show that he has done everything possible to launch the invention(^c).

(iii) *That there has been an inadequacy of remuneration due to circumstances not under his control.* Where there has been some profit its inadequacy will be measured by the measure of utility of the invention, so far as the public are concerned(^d). An extension will only be granted where the value to the public largely exceeds the benefit which has been derived by the patentee(^e). If the invention has conferred great advantages on the public, e.g. by lowering the price of some article in

(q) Case 43.

(r) Case 259.

(s) Case 486.

(t) Case 280.

(u) Case 226.

(v) Cases 243, 432.

(w) Case 401.

(x) Case 506.

(y) Case 418.

(z) Case 337.

(a) Case 384.

(b) Case 367.

(c) Case 259.

(d) Case 277.

(e) Case 259.

constant and large use, the patentee may justly expect a considerable profit ; whereas, in other cases, a small profit may be considered ample remuneration. The absence or inadequacy of remuneration must not be caused through the fault or neglect of the patentee(f). If money has been wasted in reckless litigation, or personal quarrels(g), it will not be allowed in the accounts, but a petitioner is allowed to take into account the expenses of necessary or unavoidable litigation(h), and of experiments and of introducing the invention to the trade or the public, and loss due to incendiaries(i). The Court will take into consideration the profit likely to accrue before the patent expires(j).

(c) OPPOSITION TO THE PETITION. It is open to anyone to oppose the petition, provided only the necessary formalities are complied with(k). The Comptroller is entitled to appear and be heard and may be directed by the Court so to do(l). The Attorney-General usually appears on his behalf and calls the attention of the Court to any circumstances he may deem material to be considered ; but he does not necessarily oppose the extension unless, in his judgment, it should not be granted. The Comptroller is not bound to give particulars of the objections on which he intends to rely(m), but all other opponents must file particulars of their objections, and are limited at the hearing to such particulars(n). Opponents may challenge or attempt to disprove any part of the petitioner's case, and may rely on any other facts or circumstances material to the question, whether the term of the patent should be extended at all, or the length of the extension, or the conditions on which such extension should be granted. Where the petitioner is the importer of the invention, opponents may call attention to foreign publications(o). If the Comptroller opposes on the ground that traders in this country will be prejudicially affected

(f) Case 397.

(g) Case 367.

(h) Case 221.

(i) Case 399.

(j) Case 259.

(k) Case 298 and R.S.C., O. LIIIA,
r. 3 (j).

(l) Sect. 18 (3).

(m) R.S.C., O. LIIIA, r. 3 (t).

(n) Case 259 and R.S.C., O. LIIIA,
r. 3 (l) (m) and (n).

(o) Case 430.

or subjected to unfair competition, proper evidence and statistics must be laid before the Court(p).

Opponents (except the Comptroller and the Board of Trade)(q) may be awarded, or condemned in, costs(r). An unsuccessful or abandoned petition will usually result in the petitioner being ordered to pay one set of costs to the opponents(s), which, if there are two or more opponents, will be divided between them. On the other hand, an unsuccessful and unwarranted opposition may result in the opponents being ordered to pay the costs thereby occasioned(t).

(d) PROCEDURE. The procedure is governed and regulated by Order 53A, Rule 3, of the Rules of the Supreme Court, and briefly it is as follows. The petitioner must first advertise his intention to petition three times in the *London Gazette* and once in a London daily newspaper(u); also once in a local newspaper circulating in the district where his principal place of business or manufacture is situated (if more than fifteen miles from Charing Cross)(v), or if he has no business or manufactory, where he resides (if more than fifty miles from Charing Cross). The advertisement must: (1) state the object of the petition; (2) state the day on which application is to be made to the Court to fix a day before which the petition shall not be heard (called "the appointed day"); (3) give an address of service; and (4) intimate that notices of objection must be lodged by opponents as stated in the rules(w). A copy of the advertisement must be sent to the Solicitor to the Board of Trade, by whom it is inserted in the three succeeding issues of the *Illustrated Official Journal (Patents)*(w).

The petition must be presented to the Court at least six months before the expiration of the patent(x) and within one week of the last advertisement appearing in the *London Gazette*. If the petition is presented in time it does not appear to matter if the patent has expired before an extension is allowed(y). The time for presenting the petition may be

(p) Case 259.

(q) R.S.C., O. LIIIA, r. 3 (w).

(r) R.S.C., O. LIIIA, r. 3 (u).

(s) R.S.C., O. LIIIA, r. 3 (v) and Case 223.

(t) Case 131.

(u) R.S.C., O. LIIIA, r. 3 (a).

(v) R.S.C., O. LIIIA, r. 3 (b).

(w) R.S.C., O. LIIIA, r. 3 (c).

(x) Sect. 18 (1).

(y) Case 384, and *post* pp. 132, 133.

extended by the Court(z). The petition must be returnable on the day mentioned in the advertisements(a). It must be accompanied by affidavit evidence that it has been duly advertised(b). A copy of the petition must be furnished to the Solicitor of the Board of Trade(c), and a further copy, together with two printed copies of the specification of the patent, must be lodged in Court(d). The petitioner must apply to the Court on the day mentioned to fix the appointed day and, when fixed, public notice thereof must be given in the *London Gazette*(e). Not less than three weeks before the appointed day the petitioner must lodge in Court two copies of the balance sheet of expenditure and receipts, and must at the same time furnish a copy thereof and three copies of the specification of the patent to the Solicitor of the Board of Trade, and must allow the latter to inspect the books and documents from which the accounts and figures are taken(f).

Any person desirous of opposing the petition must (before the day advertised for applying to the Court to fix the appointed day) lodge a notice of opposition (giving an address of service in the United Kingdom) and serve a copy of such notice on the petitioner, whereupon the latter must serve a copy of the petition on such opponent(g). Each opponent must state his particulars of objection(h) (to which he will be confined at the hearing), and within three weeks of the service on him of the petition, lodge two copies of the same in Court and serve one copy on the petitioner and three copies on the Solicitor of the Board of Trade(i).

After the time limited for lodging and serving particulars of objection, the petition may, on affidavit evidence that all opponents have been duly served with copies of the petition, be entered for trial(j). Opponents are entitled at their own expense to obtain copies of the balance sheet of expenditure and receipts(k).

(z) Sect. 18 (1).

(a) R.S.C., O. LIIIA, r. 3 (d).

(b) R.S.C., O. LIIIA, r. 3 (e).

(c) R.S.C., O. LIIIA, r. 3 (d).

(d) R.S.C., O. LIIIA, r. 3 (h).

(e) R.S.C., O. LIIIA, r. 3 (f) and (g)

(f) R.S.C., O. LIIIA, r. 3 (i).

(g) R.S.C., O. LIIIA, r. 3 (j) and (k).

(h) Case 259.

(i) R.S.C., O. LIIIA, r. 3 (l) (m) (n).

(j) R.S.C., O. LIIIA, r. 3 (p).

(k) R.S.C., O. LIIIA, r. 3 (q).

The Court may waive compliance with any of the rules as it shall consider to be just and expedient^(l), but unless this is done the failure to comply with any of the formalities will be fatal. The Court cannot excuse compliance with the requirements of the Acts^(m). The petition comes for hearing before the Judge appointed by the Lord Chancellor, under Sect. 92 (2) of the Acts, whose decision is final⁽ⁿ⁾.

(e) PRINCIPLES AND CONDITIONS ON WHICH THE EXTENSION IS GRANTED. The granting of an extension is a favour, not a right^(o). It is an equitable reward for unrequited merit^(p), and it does not therefore necessarily follow that, even if a petitioner establishes a *prima facie* case and, moreover, has done nothing to disentitle him to succeed, the Court will grant an extension. An extension is a matter of discretion for the Court.

The Court has regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case^(q).

An actual inventor will be more favourably looked upon as petitioner, than a mere importer or assignee^(r). An assignee will not be granted an extension unless he has assisted the original patentee^(s), nor where he has bought the patent as a mere speculation with a view to getting an extension^(t), nor where the inventor himself has been adequately remunerated^(u). It may be made a condition of the extension that some interest be secured to the inventor^(v), unless the latter has made a profit^(w).

An extension may be restricted to a particular portion of the invention^(x), e.g. that which has been put into actual use^(y). The Court may refuse an extension where an exclusive licensee has made considerable profits^(z); also where the patentee has covenanted to hold the extension, if obtained,

(l) R.S.C., O. LIIIA, r. 3 (s).

(m) Case 8.

(n) Sect. 92 (2) and Case 283.

(o) Case 6.

(p) Case 230.

(q) Sect. 18 (4).

(r) Cases 430, 119.

(s) Case 384.

(t) Case 223.

(u) Case 239.

(v) Cases 397, 304.

(w) Case 49.

(x) Case 296.

(y) Case 49.

(z) Case 86.

for the benefit of others(z); also where the existence of an exclusive licence operates to the public detriment(a). Where certain licences were in existence, the Court granted an extension subject to those licences being continued(b). A patent for an improvement on a former patented invention may be extended(c), but the fact that an improvement has been patented does not prevent(d), but may lead the Court to refuse, the extension of the original patent(dd).

Where the patent has been mortgaged the extension may be made subject to the mortgage(e). Conditions may also be imposed as to granting licences; e.g. at a certain fixed royalty(ee), or on terms to be fixed by the Board of Trade(f), or that the public services should have free use(g).

Extension has been granted where loss was due to illness of the patentee(h), or heavy litigation, or the acts of incendiaries; but it will be refused unless the invention is likely to be taken up(i), or where the public will suffer hardship thereby(j).

Where there has been some remuneration its adequacy, and the term of the extension granted (if any), will depend on the merits of the invention(k). Ten years is the longest possible extension, but the circumstances have to be very exceptional to obtain one longer than five years.

In deciding the length of extension the Court will grant such a term as will give the petitioner a chance to obtain adequate remuneration, and will therefore take into consideration such a circumstance as that the invention is only capable of limited and occasional employment(l). The Court will be loath to grant an extension where the foreign patents have been allowed to lapse(m). There is no jurisdiction to grant more than one extension of the same patent(n).

(2) Applications on the ground of loss or damage arising from war. As already pointed out, this is an additional ground, introduced by the Act of 1919(o), and more fully

(z) Case 86.

(a) Case 117.

(b) Case 351.

(c) Case 52.

(d) Case 174.

(dd) Case 356.

(e) Cases 96, 52.

(ee) Case 301.

(f) Case 296.

(g) Case 243.

(h) Case 401.

(i) Case 417.

(j) Case 259.

(k) Case 48.

(l) Case 441.

(m) Case 223.

(n) Case 453.

(o) Sect. 18 (6).

stated, is that the patentee, as such, has, by reason of hostilities between His Majesty and any foreign state, suffered loss or damage, including loss of opportunity of dealing in or developing his invention, owing to his having been engaged in work of national importance connected with such hostilities. Applications on this ground cannot be made if the patentee is a subject of the ex-enemy foreign state, or is a company, the business whereof is managed or controlled by such subjects, or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's Dominions. The application may be made at the option of the patentee, either by originating summons or by petition, or an extension may be sought both on this ground and the first ground in the same petition(p).

The Court in considering its decision may have regard solely to the loss or damage, as defined above, which the patentee has sustained.

The "loss or damage by reason of hostilities" is not necessarily confined to that suffered during the period of hostilities; the consequence of hostilities may extend to a time subsequent to their suspension and even after the signing of peace.

The object of giving the patentee the right of proceeding by originating summons is to save expense and to expedite matters; it is not necessary to file such comprehensive accounts of loss and profit as are required in a case of petition under the other ground, but sufficient evidence must be adduced to show the extent of this loss or damage, and this involves, in many cases, a comparison between profits earned before hostilities started and those earned subsequently.

Application to obtain an extension should not be made until a short time before the normal expiration of the patent, unless there are special circumstances, e.g. where the exploitation of the invention requires a capital expenditure which would not be warranted unless there was a certainty of an extension being granted(q).

Proceedings should be started six months before the term of the patent expires; the Court has power to extend the time

(p) R.S.C., O. LIIIA, r. 3A (n).

(q) Case 320.

and may do so even after the patent has expired(**r**) ; but if the patent has been dead for a long time (e.g. three years) the Court will not extend the time except in very exceptional circumstances(**s**). The loss or damage warranting an extension must have been suffered by the patentee as such, i.e. in his capacity as patentee ; it is not sufficient to show that he, as shareholder in a company working the patent, has not received dividends owing to the war(**s**). Whether the application is made by petition or by originating summons it is referred to the judge, appointed under Sect. 92 (2) by the Act, and his decision is final(**t**). The extension of an expired patent is made subject to the provisions of Rule 62 (*see* p. 133).

The procedure is set out in Rule 3A or Order LIIIA of the Rules of the Supreme Court.

Section H.—RESTORATION OF LAPSED PATENTS.

Sect. 20 provides a means whereby a patentee may obtain the restoration of a patent which has become void owing to the failure to pay any prescribed fee in the prescribed time. This section does not apply until the patent is sealed, and therefore the only fees to which it applies are the renewal fees, payable before the expiration of the fourth and each subsequent year from the date of the patent. If the omission to pay a renewal fee be discovered within three months of the due date, the time may be enlarged on application (Patents Form No. 15), and this is allowed as a matter of course(**u**). After three months the patentee must have recourse to Sect. 20. Prior to the Act of 1907 the only remedy was to promote a private Act of Parliament, but it is presumed that this course would now have a very remote chance of success.

The application(**v**) is made to the Comptroller on Patents Form No. 16 (stamp £20), which must be signed by the patentee or patentees, and must set out in detail the circumstances leading to the omission to pay the fee ; it must be accompanied by evidence by way of statutory declaration verifying the facts stated. It is only in cases where the statement

(**r**) Case 83 (*a*), and p. 133.

(**s**) Case 83 (*b*).

(**t**) Case 118.

(**u**) Rules 55–57.

(**v**) Rules 58–63.

accompanying the application shows that the omission was unintentional, and that there has been no undue delay in making the application, that the Comptroller is entitled to proceed.

An omission is not unintentional if it is present to the mind of the person who has to pay the fee that the fee is payable and he deliberately elects not to pay it, whatever may have caused such election(**w**).

In deciding whether there has been undue delay in applying for restoration of the patent, the Comptroller will have regard to the time when the patentee discovered the fact that payment of the fee had been omitted, or the time when, by exercising ordinary reasonable care, he might have discovered it(**x**).

If the application is in form and fulfils the above requirements, the Comptroller advertises it in the *Illustrated Official Journal (Patents)*, and in such other manner as he thinks desirable.

Anyone may enter opposition within two months of the first advertisement by giving notice to the Comptroller (Patents Form No. 17), which must state the reasons of the opposition and must be signed by the opponent or opponents. A copy of the notice is sent by the Comptroller to the applicant. Evidence by way of Statutory declaration in support of the opposition must be filed within fourteen days, and copies of the declarations must be delivered to the applicant. The procedure is then identical with that on opposition to the grant of a patent, except that the decision of the Comptroller is subject to an appeal to the Court instead of to the Law Officer(**y**).

Provisions are inserted in an order restoring a lapsed patent(**z**) or extending an expired patent(**zz**) to protect the interests of all who have availed themselves of the subject-matter of the patent since the date of lapsing or expiration. The nature and extent of this protection is set out in Rule 62 (*post* p. 233) and broadly it will extend to—

(**w**) Case 279.

(**x**) Case 404 (*j*).

(**y**) Sect. 20 (6).

(**z**) Sect. 20 (5).

(**zz**) Case 41 (*b*).

(1) any infringement which has taken place during the period when the patent was void :

(2) the use or sale at any time of a patented article made during the said period, or the use at any time of a patented process used during the said period :

(3) the use or sale at any time, by any person protected under (2), of any improvement in, or addition to, the patented article (being machinery or mechanism), or the patented process, which such person is entitled to use or sell as afore-said ; or of any article made by any mechanism or process in respect of the use of which that person is protected.

Such provisions are incorporated in the order restoring or extending the patent ; and the former also provides that any person who has *bona fide* expended money, time or labour on the subject-matter of the patent, between the said dates, may apply to the Board of Trade, and the latter may award compensation and direct the person by whom, and the day on which, such compensation shall be paid, and in default of payment the patent shall become void ; if the patent so becomes void the sum awarded shall not be recoverable as a debt or damages^(a).

Section I.—SURRENDER OF PATENTS.

As long as a patent remains in force, the patentee is liable to proceedings at the suit of any person who may wish to have the patent revoked, and, even if the patentee submits at the earliest possible moment, he may find himself liable to pay certain costs.

Sect. 26 (3) provides a method by which a patentee may get rid of his patent by surrendering it. The offer to surrender is made on Patents Form No. 26, which must include a statement as to whether or not any action for infringement, or proceedings for the revocation, are pending, and also the reasons for wishing to surrender. The Comptroller advertises the offer to surrender in the *Illustrated Official Journal (Patents)*, and in such other manner (if any) as he deems desirable^(b). Any person may oppose the surrender and will

(a) Rule 63.

(b) Rule 73.

be heard by the Comptroller, who may thereupon, if he thinks fit, make an order for the revocation of the patent, subject to an appeal to the Court. If licences are in existence, or if the patentee be shown to be holding the patent wholly or in part in trust for some other person, then presumably the Comptroller will not make an order for revocation without the consent of the persons interested.

Terms may presumably be imposed on the patentee as to the payment of the costs of any proceedings or applications pending before the Comptroller with regard to the patent.

Section J.—THE RIGHTS OF CO-PATENTEES “INTER SE.”

Where two or more persons are the owners of a patent they may hold, either as joint tenants or as tenants in common, or they may be owners of different parts of the patent. By holding as joint tenants is meant that each owner holds the whole of the patent, not by himself, but jointly with all the others. By holding as tenants in common is meant that each owner holds a part of the patent for himself alone, although that part is not separated from the rest and is not ascertained.

A patent may be divided into parts, e.g. into halves or other fractional shares, or territorially, say, by dividing the rights in England, Scotland, Ireland, Wales, and the Isle of Man, or as to time, say, by dividing the whole period of sixteen years into smaller periods; and each part may be conveyed to a different person, so that each owner holds a certain part of the patent quite independently of the owner of any other part or parts.

Owners who hold as joint tenants are jointly considered as one legal *persona*; they can only assign jointly and on the death of one the ownership normally passes to the survivor or survivors. There is, however, some authority for the proposition that one joint owner can maintain an action for infringement without joining other owners holding jointly with him(bb).

Joint owners may at any time sever their interests and thus

(bb) Case 419(a), and *ante* p. 78.

become owners holding as tenants in common or owners of different parts of the patent.

Where two or more persons apply for a patent it is granted to them jointly, but in the case of patents granted on or after 1st July, 1908, if one of the original grantees dies, his beneficial interest in the patent does not pass to the survivor or survivors, but devolves on his personal representative as part of his personal estate(c).

Owners who hold as tenants in common can assign their interests at will, each independently of the other or others, and on the death of one his interests pass to his personal representative, but it has been held that the right of tenants in common to recover damages for infringement is a joint right and therefore passes on the death of one tenant to the survivor or survivors(d).

The owner of a patent does not get the right to use and exercise the invention from the patent; that right is his by common law. By the patent he gets the right to stop all others (who are not owners with him) from making, using, or selling the invention. An owner may therefore exercise the invention for his own profit without accounting to any other owner or owners(dd).

An owner, whose rights are limited to a particular period or a particular area, will be liable if he exercises the invention outside these limits, at the suit of any other owner whose right he has thereby infringed.

The question of the effect and validity of licences, granted by one of several owners of a patent, is one which has not yet been settled by judicial decision, but it is submitted that the true position may be arrived at by the following considerations. A licence does not transfer property in the patent but, apart from any special agreement, amounts to a promise by the licensor that he will not put in suit his patent rights against the licensee in respect of acts of the latter falling within the ambit of the licence. From this it follows that a licence granted by one of several owners of a patent does not bind the others, unless they have given their consent; the licence

(c) Sect. 37.

(d) Case 428 (a).

(dd) Case 438.

would not be invalid but would not effectively protect the licensee, i.e. it would still leave him at the risk of being sued for infringement of the patent by any owner thereof other than his licensor.

Sect. 37 provides that one of two or more joint grantees of a patent granted on or after the 1st January, 1908, shall not be entitled to grant a licence without the consent of the other or others; such a licence if granted would apparently not entitle the licensor to recover royalties.

Two or more persons may hold a patent as joint tenants by being the original grantees; or by assignment from the prior owner or owners by a deed which conveys the patent to all of them without words importing a distinctness of interest, or by devolution on the death of an owner who has two or more executors.

Two or more persons may hold a patent as tenants in common by an assignment which conveys the patent to them all, using words importing a distinctness of interest; or by the severance of the interests of persons holding as joint tenants.

A person may hold a part of a patent by having that part conveyed to him by the prior owner or owners.

Section K.—RIGHTS OF A PATENTEE IN RELATION TO THE CROWN.

A patent has the same effect against the Crown as against a subject; but any Government Department may use the invention for the services of the Crown, and the terms of payment may be agreed upon or, in default of agreement, must be settled in the manner laid down in the Sect. 29.

In such a case, a patentee's rights to payment or compensation extend to any use by a Government Department, subsequent to the date of application for the patent, and are therefore more extensive than his rights to recover damages against ordinary infringers, which extend only to the date of publication of the complete specification.

A substantial alteration in the law was effected by Sect. 8 of the Patents and Designs Act, 1919, which amended Sect. 29 of the Act of 1907. It has been held that the provisions

of the amended section only apply to the use of inventions by the Crown after the date on which the amendments came into operation, i.e. 23rd April, 1920(e). With regard to use before that date the old law applies. It is therefore necessary to consider the law both before and after the 23rd April, 1920.

(1) **Before 23rd April, 1920.** In this case, Sect. 29 of the Patents and Designs Act, 1907 (as it stood before amendment), applies ; and there are two matters requiring consideration, viz.—

(a) The right of Government Departments to use patented inventions.

(b) The settlement of the terms.

(a) The right of Government Departments arises immediately on the application for a patent ; it is limited to the use of the invention for the services of the Crown, and such use may be by the Department itself, its agents, contractors or others ; the words “ or others ” must read as *ejusdem generis* as agents and contractors. Although the only right given by the section is to “ use ” the invention, it probably extends to manufacturing(f) and certainly includes the right to sell the patented article, when no longer required for the services of the Crown(g).

(b) Terms may be settled by agreement between the patentee and the Government Department, subject to the approval of the Treasury, or, in default of agreement by the Treasury, after hearing all parties interested. Where, however, there is a substantial dispute as to the validity of the patent, or as to whether what has been done amounts to a “ use ” of the invention, then the Treasury will not arbitrate.

The Act of 1907 is silent as to what steps the patentee can then take to enforce his rights ; he cannot bring a Petition of Right against the Crown, as such a petition can only be based on contract. In these circumstances, it is usual for the Government Department concerned to nominate one of its officers as a defendant whom the patentee can sue, and in this way an action is brought before the Courts, in which the questions in issue can be decided.

(e) Case 198.

(f) Case 198.

(g) Sect. 29 (3).

(2) **Since the 23rd April, 1920.** The amendments introduced into Sect. 29 by the Patents and Designs Act, 1919, fall under two headings—

(a) Provisions affecting the rights of the parties.

(b) Procedure.

(a) Any Government Department may “by themselves or by such of their agents, contractors or others as may be authorized by them in writing” make use or exercise the invention for the services of the Crown. The authority for the agents, contractors or others must be in writing, whereas formerly it might have been oral or merely implied. In form, this appears to alter the rights of the patentee and the Crown *inter se*, but in effect the only result is that an agent, contractor or other person making or using the invention for the services of the Crown is not protected from infringement proceedings by the patentee unless the authority is in writing.

The existence of any agreement between the patentee and any other party (e.g. an exclusive licence) does not affect the rights of a Government Department to make, use or exercise the invention.

If, before the date of the patent, a Government Department has, from information or research not emanating directly or indirectly from the patentee, recorded the invention in a document or tried the invention, then the patentee cannot claim any payment or royalty on account of the subsequent manufacture or use of the invention by any Government Department(h).

(b) If the patentee and the Government Department cannot agree as to whether the invention has been manufactured or used, or as to the terms on which payment should be made, the matter is referred to the Court and the proper method of doing this is by petition. The Court may refer the whole matter, or any question or issue of fact arising thereon, to a special or official referee or to an arbitrator. The validity of the patent may, with the consent of the parties, be decided in such proceedings. A petition so presented to the Court is not

(h) Sect. 29 (1), 2nd proviso.

subject to the provisions of Sect. 92 (2) of the Act and therefore the decision may be *appealed*.

Section L.—RIGHTS AS AFFECTED BY WAR LEGISLATION.

During the late European War a number of Statutes were passed and rules and regulations made thereunder, with the object not only of safeguarding national interests, but also of obtaining all the benefit possible from enemy inventions. This emergency legislation and the subsequent Treaties of Peace, and Acts, Orders, and Rules thereunder, have directly and indirectly affected patentees and applicants for patents. The effects on the rights of patentees are conveniently considered under the following heads—

- (1) Patents granted with an abnormal priority of date.
- (2) Patents restored under the Treaties of Peace.
- (3) Infringements of certain patents during the war.

(1) **Patents granted with abnormal priority of date.** Very wide discretionary powers were given to the Comptroller during the war to extend the prescribed times for doing acts and filing documents in respect of applications for patents(i). Similar provisions were made in the Treaty of Peace with Germany—and have been made in subsequent Treaties—in favour of nationals of the High Contracting Parties(j), and these were extended to the nationals of certain other countries by the Berne Agreement in June, 1920(jj), subsequent to the re-establishment of the International Convention arrangements. The above provisions had the effect of enabling an inventor, who had filed an application for a patent abroad, to take advantage of the provisions of the International Convention and file a corresponding application in the United Kingdom, claiming the date of the foreign application, although the twelve months normally allowed for such application had expired. The provisions also enabled applications to be completed long after they would normally have become void. For example, a patent may have been granted after the conclusion of peace bearing the date 1st August, 1913, in

(i) S.R. & O., 1914, No. 1255, r. 3A.

(j) Articles 307 and 308, *post* pp. 229, 230.

(jj) Treaty Series, 1920, No. 18;
and see p. 142 *post*.

respect of an application which should ordinarily have been filed under the International Convention not later than 1st August, 1914.

As these provisions have expired, or will shortly expire, it is not necessary to discuss them in detail, but only to note that the form of patent granted, as a result of recourse being had to them, is somewhat different to the usual form(k). Clauses are added to such patents to protect anyone who might otherwise be injuriously affected.

Patents may have been granted with abnormal priority of date—

(a) Under the general discretionary power vested in the Comptroller during the war.

(b) By virtue of a Treaty of Peace Act and rules made thereunder.

(a) In these cases a clause(l) is inserted in the grant, having the effect of protecting anyone who was *bona fide* in possession of the invention before the date of application in this country ; and any such person is immune from being sued at any time, or in any circumstances, for infringement of the patent ; such immunity would appear to be personal and not transferable. It is doubtful what precisely is meant by the expression “in possession of the invention,” and whether it includes having knowledge of the invention, or possessing an article or articles made according to the invention, or carrying on a manufactory or business in which the invention is being used, or the patented article sold.

If the person is in possession of a patent for the invention, the immunity would apparently protect him and any existing co-owner or licensee, but it is doubtful whether it would protect any subsequent owner or licensee, and the patent itself would appear to be invalid on the ground that the invention is protected in a patent of prior date(m). It is also doubtful whether the immunity would extend to servants, agents or contractors of the person immune, unless they were actually in possession of the invention at the material date.

(b) Where the provisions of a Treaty of Peace Act are

(k) Appendix V, p. 305.

(l) *Ibid*, p. 305.

(m) *Ante* p. 58.

invoked to obtain priority of date for a patent there is a clause inserted in the grant, saving the rights of persons who are excepted by the provisions of the Treaty⁽ⁿ⁾. In the case of Germany, these provisions are contained in Article 308 of the Treaty of Peace with that country, and similar provisions are to be found in the other treaties of peace.

By the terms of the provisions persons who before the coming into force of the treaty are *bona fide* in possession of any rights of industrial property, e.g. patent rights conflicting with those granted by the patent awarded priority are still at liberty to exercise their rights by themselves, and such of their agents or licensees as were appointed or licensed before the treaty came into force; and such persons are immune from any action or other process in respect of infringements; the immunity also probably extends to persons in possession of an unpatented invention.

The date the Peace Treaty came into force is the 10th January, 1920. The Berne Agreement, dated 30th June, 1920^(o), purports to extend the date for the purpose of the above protection to 30th September, 1920.

The provisions of the Peace Treaty would also appear to prevent the validity of a patent applied for before the Treaty came into force being affected by a patent granted priority under the Treaty provisions.

(2) Patents restored under the Treaties of Peace. During the war a general vesting order was made under which the property and interests of enemy subjects in patents, and in application for patents, were vested in the Public Trustee as custodian.

The Treaties of Peace with Germany, Austria, and other enemy countries provide for the restoration of these patents temporarily vested in the custodian, and restoration orders in respect of patents of German, Austrian, and Bulgarian nationals have been made^(p). Rules in respect of dealings

(n) Appendix V, p. 305.

(p) S.R. & O., 1920, Nos. 1336 and 2118, Appendices VI and IX.

(o) Treaty Series, 1920, No. 18.

This agreement was signed on behalf of the British Government with certain reservations, but has not received statutory sanction.

in, and licences under restored patents, have also been framed(pp).

The rights of patentees under patents so restored are still affected in several ways. Compulsory licences may still be granted under such patents, and the provisions for these are dealt with in Chapter VII, Sect. B (iv). The rights of such patentees also remain subject to existing licences, whether granted previously to the vesting of the patent in the custodian, or by the custodian, and to certain other liabilities and disabilities discussed in Chapter VII, Sect. D.

(3) Infringements of certain patents during the war.

During the war an action for infringement could not be sustained by an enemy subject(q), but the rights under enemy patents were, as above explained, controlled under the provisions of War Legislation. The Treaty of Peace with Germany makes certain provisions limiting the rights of ex-enemy subjects to sue after the war in respect of infringements during the war, and the sale of infringing articles made during the war is similarly protected for one year after the Treaty of Peace came into force. The material provisions are contained in Articles 300, 306, and 309, and Sect. 1 (xvii) of the Treaty of Peace Order (*see* pp. 309, 321, 328, 331, *post*).

(pp) S.R. & O., 1920, No. 1371, Appendix VIII.

(q) Case 383.

CHAPTER VII

LIABILITIES OF A PATENTEE

AMBIT OF THE CHAPTER.

ALTHOUGH the possession of a patent confers on the patentee considerable rights and privileges, it conveys with it also certain liabilities and responsibilities. Being in the nature of a monopoly it is essential that the interests of the public should not be unduly prejudiced. Provisions are therefore made whereby under certain circumstances the patent may be revoked, or compulsory licences granted if the monopoly has been abused. The patentee also must not indulge in unjustifiable threats of proceedings for infringement of the patent.

In the event of having to meet any proceedings, such as a petition to revoke the patent, a patentee may, even if he submits at the earliest possible moment, still be liable for considerable costs. To avoid any hardship on this account, however, provision is made, already described on page 134, whereby a patentee may at any time offer to surrender his patent, and in the absence of good reasons to the contrary, the Comptroller will accept the offer.

The Statutory liabilities of a patentee are conveniently dealt with under the following heads—

- A. Revocation of patents.
- B. Compulsory licences.
- C. Actions to restrain threats.
- D. Patents restored under the Treaties of Peace.

Section A.—THE REVOCATION OF PATENTS.

The revocation of a patent may be obtained : (1) by petition to the High Court ; or (2) by application to the Comptroller, according to the grounds on which revocation is sought. Revocation of a patent may also be obtained by way of counterclaim in an action for infringement^(a).

(a) Sect. 32.

(1) **Petitions to the High Court.** These will be considered under the following heads—

- (a) The grounds on which a petition may be presented.
- (b) Persons entitled to petition.
- (c) Procedure.
- (d) The judgment and its effect.

(a) **THE GROUNDS ON WHICH A PETITION MAY BE PRESENTED.** A petition for revocation may be presented on any ground on which the patent might have been repealed by *scire facias* before the 1st January, 1884(b). A patent might have been repealed by *scire facias* before 1st January, 1884, on any ground on which it might have been held invalid. The ground of the petition is primarily therefore that the patent is invalid for one or other of the reasons discussed in Chapter IV.

(b) **THE PERSONS ENTITLED TO PETITION.** The Attorney-General may petition to revoke any patent(c) but this power is very seldom exercised. Any other person wishing to present a petition must show that he has a certain *locus standi*, or he must obtain the authority or fiat of the Attorney-General(c). For *locus standi* the petitioner must establish one of the following propositions—

(i) That the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims(d).

(ii) That he, or any person, under or through whom he claims, was the true inventor of any invention claimed in the patent(e).

(iii) That he, or any person, under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within the Realm, before the date of the patent, anything claimed by the patentee as his invention(f).

If the petitioner succeeds in showing that he has a *locus*

(b) Sect. 25.

(c) Sect. 25 (3) (a).

(d) Sect. 25 (3) (b) (i).

(e) Sect. 25 (3) (b) (ii).

(f) Sect. 25 (3) (b) (iii).

standi he may rely on any ground of invalidity(g), but the question of *locus standi* will, if challenged, be tried first, and if decided against the petitioner, the petition will be dismissed or allowed to stand over until the Attorney-General's fiat has been obtained(h). It is therefore better in all cases of doubt to obtain the fiat of the Attorney-General before presenting the petition. The fact that certain issues have been raised and decided in prior proceedings (e.g. in any infringement action(i), or in opposition proceedings or an application to the Comptroller to revoke the patent(j)) does not estop or preclude either party from raising the same issues on a petition to the High Court for revocation, even if the parties are the same. This is so because the petitioner in such revocation proceedings represents the public(k).

A petition to revoke may be presented even after the patent has expired, but there is no action for a declaration that a patent is invalid(l).

The fiat of the Attorney-General may be obtained, *nunc pro tunc* even after a petition has been filed, and where there is a doubt as to the petitioner's *locus standi* the Court will usually adjourn the petition for this purpose. No petition can be presented for the revocation of a secret patent(m).

(c) THE PROCEDURE. If it is desired to obtain the fiat of the Attorney-General before presenting the petition (which is advisable in most cases), a memorial must be presented to the Attorney-General setting out the grounds of the application and the history and all the circumstances of the case(n). The memorial must be left at the Law Officer's Dept., Royal Courts of Justice, Strand, together with the following documents: (1) a statutory declaration by the petitioner verifying the facts; (2) two copies of the proposed petition and the particulars of objection and copies of all documents referred to; (3) a barrister's certificate that the petition is a proper one for the fiat to issue; (4) a solicitor's certificate that the petitioner is a proper person to petition and is competent to

(g) Case 329.

(h) Cases 329, 124, 336.

(i) Cases 289, 254.

(j) Case 212.

(k) Case 420 (b).

(l) Case 354

(m) Sect. 30 (9).

(n) R.S.C., O. LIIIA.

answer for the costs ; (5) A declaration that there are no proceedings pending in which the issues could be determined.

Where the defendant in an infringement action counter-claims for revocation, the same obligation as to obtaining the fiat of the Attorney-General lies on him as if he were proposing to present a petition, but the last declaration referred to above, cannot, of course, be given in such a case.

The granting of the fiat is in the uncontrolled discretion of the Attorney-General, but it is not usually withheld except for good cause. The Attorney-General may require the attendance of the petitioner and of the patentee and hear arguments, but this does not often happen.

The petition must be accompanied by particulars of objection, setting out the grounds on which the validity of the patent is attacked, and must be served on the patentee or patentees ; i.e. every person for the time being entered on the Register as the grantee or proprietor of the patent. The rules and practice regulating the particulars of objection are exactly the same in revocation proceedings as in infringement actions (Chap. VI, A(3)).

Where the patentee is out of the jurisdiction, notice of the petition will usually be allowed to be served on him by registered post, and where the Court is satisfied that the patentee has notice of the petition, it may proceed in his absence^(o).

The petition appears in due course in the list and the parties appearing by counsel or in person, the judge will give directions as to any preliminary matters, such as discovery, and as to how the petition shall be heard. If the patentee does not wish to dispute the matter the patent may be revoked forthwith ; or if the patentee is not represented the patent may be revoked on affidavit evidence^(p) ; otherwise the petition is usually ordered to be put into the witness list to be tried on oral evidence. On the hearing of the petition the patentee has the right to open the case^(r) and this is nearly always done except in cases where fraud is alleged. If the patentee desires to amend his patent, pending revocation proceedings, application must be made to the Court ; the procedure

(o) Cases 188, 92.

(p) Case 469.

(r) R.S.C., O. LIIIA, r. 12.

and rules governing such an application are discussed in Chapter VI.

Before the amendments introduced by the Patents and Designs Act, 1919, all persons beneficially interested in the patent had to be made parties, and where licensees were served with notice of the petition and attended by counsel at the trial and on appeal, the unsuccessful petitioner was ordered to pay their costs(s).

(d) THE JUDGMENT AND ITS EFFECT. If the Court comes to the conclusion that the patent is valid, the petition will be dismissed; otherwise, the prayer of the petition will be allowed, and, in this case, the judgment operates as a revocation of the patent and will be registered by the Comptroller. The judgment is a judgment *in rem*, and not *in personam*, as its effect is to void the patent, but it does not affect the relationship of the parties. Costs are in the discretion of the judge, but are usually awarded to the successful and against the unsuccessful party and, except that it is not necessary in revocation proceedings for a successful petitioner to obtain a certificate that the particulars of objection are reasonable and proper, the principles on which costs are awarded are the same as in infringement actions(t). A successful petitioner's costs will include those of obtaining the fiat of the Attorney-General. Even if the patentee consents to the revocation as soon as the petition is served on him, the petitioner is entitled to his costs although he may not have given notice to the patentee of his intention to present the petition(u).

When the judge has decided against the patentee, but is of opinion that the patent may be rendered valid by amendment, he may, on the application of the patentee, order the revocation of the patent after a certain lapse of time, and then only if the patentee has failed in that time to obtain leave to amend(v). This will not be done where the patentee has been guilty of fraud(w), nor where the invention is entirely anticipated(x).

(s) Case 29.
(t) *ante* p. 98.
(u) Case 317.

(v) Cases 123, 261, 197,
(w) Case 392.
(x) Case 20.

(2) **Applications to the Comptroller.** Application may be made to the Comptroller to revoke a patent. These applications may be called belated oppositions, for they are in all respects similar to opposition proceedings. The grounds on which an application can be founded are the same as the grounds on which the grant of a patent can be opposed and the procedure and considerations arising thereon are the same ; these are dealt with in Chapter III. They may be taken by any person who would have been entitled to oppose the grant of the patent or the successor in interest(y) of such a person, and must be taken within two years from the date of the patent. Leave of the High Court must be obtained if revocation or infringement proceedings are pending in that Court(z). The only particular in which the proceedings differ from opposition proceedings is that the Comptroller's decision is subject to an appeal to the appointed Judge of the High Court(z), whose decision is final except in the case where an order is made revoking the patent(zz). In such case, the appeal may apparently be taken to the House of Lords.

Section B.—COMPULSORY LICENCES.

The question whether and how far, in the grant of a patent, there is an implied undertaking that the invention is to be worked in the United Kingdom, or whether the patentee is to be free from obligations in this respect, is of historic interest. Prior to the Act of 1907, notwithstanding statutory provisions in the previous Acts of 1883 and 1902, there was no effective method of enforcing on a patentee an obligation to work his patent or, alternatively, to allow others to do so ; consequently, if a powerful company obtained possession of the governing patents in any particular industry, it was in a position to control that industry without any reference to the interests either of those engaged in it or of the general public. Provisions were introduced in the Act of 1907 with a view to removing evils which had grown up owing to the abuse by patentees of their monopoly rights. Sect. 27 of that Act provided that, in certain circumstances, a patentee who did

(y) Sect. 26 (1) ; Case 178.

(z) Sect. 26 (4).

(zz) Sect. 92 (2).

not work his invention in the United Kingdom was liable to have his patent revoked, and Sect. 24 provided that in other circumstances compulsory licences might be granted or, in the alternative, the patent revoked. These sections have now been repealed by the Act of 1919, which gives the Comptroller jurisdiction, where abuse of monopoly rights is established, to grant compulsory licences or, in the alternative, to revoke the patent, subject to an appeal to the Court, and further lays down the following guiding principle: "For the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay^(a)."

From a consideration of decisions under the 1907 Act, the new provisions do not appear to be directed against the patentee with a view to forcing him to work the invention himself, nor to penalize him for want of success if he has done his best, and made reasonable efforts and provisions to work the invention or grant licences^(b). On the other hand, the object appears to be, by the provision of special sanctions, to prevent the patentee exercising his monopoly rights to the detriment of trade or the public interest generally.

Compulsory licences can now be obtained

(1) Under the provisions of Sect. 27 as a relief from the abuse of monopoly rights.

(2) Under the provisions of Sect. 24 in respect of patents indorsed "Licences of right."

(3) Under the provisions of Sect 38A in respect of patents relating to the preparation or production of food and medicine.

(4) Under the provisions of the Treaties of Peace in respect of patents which have been restored to former alien enemies.

These will now be considered in order.

(a) Sect. 27 (2), proviso.

(b) Case 60 (a).

(1) **Compulsory licences as a relief from the abuse of monopoly rights.** The following considerations arise: (a) who is entitled to apply; (b) what the applicant has to prove; (c) how the patentee may meet the case; (d) the procedure; (e) what relief can be obtained.

(a) **WHO IS ENTITLED TO APPLY.** Sect. 27 (1) provides that any persons interested may apply; the nature and extent of the interest necessary to give a *locus standi* is not specifically stated but from a consideration of the provisions of Sub-sect. (2) it is presumed that the applicant will have sufficient *locus standi* if he proves he has a *bona fide* intention of working the invention in this country, or is interested or engaged in (or has a *bona fide* intention of engaging in) an industry in this country to the existence or establishment of which the use of the patented invention is reasonably necessary.

(b) **WHAT THE APPLICANT HAS TO PROVE.** Having established a *locus standi*, the applicant in order to obtain relief, must prove that there has been an abuse of the monopoly rights under the patent. Monopoly rights under a patent are deemed to have been abused in any of the following circumstances—

(1) If at any time after the expiration of four years from the date of the patent, the patented article or process (being one capable of being made or worked in the United Kingdom) is not being manufactured or carried on within the United Kingdom, in or by means of a definite and substantial establishment or organization, and on a scale which is adequate and reasonable in all the circumstances^(c).

(2) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement^(d).

(3) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms^(e).

(c) Sects. 27 (2) (a) and 93. (d) Sect. 27 (2) (b). (e) Sect. 27 (2) (c).

(4) If by reason of the refusal of the patentee to grant a licence or licences on reasonable terms, the trade or industry of the United Kingdom, or the trade of any persons or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom is prejudiced and it is in the public interest that a licence or licences should be granted(f).

(5) If any trade or industry in the United Kingdom, or any person or class of persons engaged therein is unfairly prejudiced by the conditions attached by the patentee, whether before or after the passing of the Act, to the purchase, hire, licence or use of the patented article, or to the using or working of the patented process(g).

The abuse must be in respect of the "patented invention," "the patented article" or the "patented process." Precisely what these are must be determined from a proper construction of the specification. It is submitted that the provisions would not apply to the manufacture of mechanism or the carrying out of any subsidiary process unless such is claimed as a specific part of the invention(h).

(c) HOW THE PATENTEE MAY MEET THE CASE.—On this subject, cases which were decided under the provisions of the repealed sections of the Act of 1907 may be of interest. The patentee may, for example, be able to show—

(1) That there is a manufacture which satisfies, or is reasonable in view of, the existing demand, and that he is prepared to meet a larger demand(i).

(2) That there is a complete absence of demand in spite of the patentee's efforts to create one, and that the invention at the time is of no practical utility(j).

(3) That the patented invention is actually being worked by others, even though they are infringing the patent(k).

(4) That every reasonable effort has been made to work the invention(l).

(f) Sect. 27 (2) (d).

(g) Sect. 27 (2) (e).

(h) Cases 275, 231.

(i) Cases 268, 490.

(j) Cases 359, 51.

(k) Case 314.

(l) Case 60 (b).

(5) That the terms for licences offered are not unreasonable, even though royalties enhance the price to an extent which necessitates a selling price greater than obtains in the foreign market^(m).

It would probably, however, not be sufficient, in the absence of any effort on the part of the patentee, to allege that there are great and serious difficulties to contend with, such as difficulties of obtaining parts of a patented machine or specially skilled labour⁽ⁿ⁾; nor to allege that the invention could not be worked in the United Kingdom as profitably as it could be abroad, or any reason which would not account for the inadequacy of the extent of working by causes operating irrespective of any abuse of the monopoly rights granted by the patent^(o).

(d) THE PROCEDURE. The applicant must make his application to the Comptroller^(p) (Patents Form No. 27), setting out fully the facts upon which he bases his claim to be heard (i.e. his *locus standi*) and also those which he alleges entitle him to relief. The facts stated in the application must be verified by statutory declaration. The application and statutory declaration will be considered by the Comptroller, and, if he is satisfied that the applicant has a *locus standi* and has made out a *prima facie* case, he will order copies of the application and declaration to be served on the patentee and any other persons appearing from the Register to be interested in the patent. The Comptroller will also cause the application to be advertised in the *Illustrated Official Journal (Patents)*.

Opposition may be entered by the patentee or any person desirous of opposing. The section does not state that the opponent must have an interest in the patent or establish any *locus standi*. An opponent must within fourteen days (which may be extended by the Comptroller) deliver to the Comptroller a counter-statement, setting out fully the grounds of opposition. The counter-statement must be verified by statutory declaration. The counter-statement may challenge the facts set up by the applicant and raise any other points material to

(m) Case 400.

(n) Case 260.

(o) Case 211.

(p) Rules 79-84.

the application ; for instance, where the application is made on the ground that the patented invention is not being worked in the United Kingdom on a commercial scale, the counter-statement may give satisfactory reasons for such non-working.

Either party may, within fourteen days of the delivery of the counter-statement, demand a hearing (Patents Form No. 28), or the Comptroller may, without demand, appoint one, giving ten days' notice.

Any party, except the person applying for a hearing, who is desirous to be heard, must give notice (Patents Form No. 11). At the hearing any party may appear and argue his case by himself, or his agent, or counsel. The Comptroller may require any of the declarants to appear to be examined or cross-examined, and may also require the production of any relevant books or documents subject to due precautions against disclosure of information to rivals in trade^(q).

When the case has been considered, and after a hearing, if one has been demanded or appointed, the Comptroller may dismiss the application, may adjourn it, or may grant any of the relief set out below. Where the application is based on the non-working of the invention in the United Kingdom, and the circumstances are such that, in the opinion of the Comptroller, sufficient time has not elapsed to enable the invention to be worked in the United Kingdom on a commercial scale, the Comptroller may adjourn the application for such period for that purpose^(r). The Comptroller has power to award such costs as he may consider reasonable to be paid by anyone to any other party to the application^(s). The Comptroller may refer to an arbitrator the whole proceedings or any question or issue of fact arising thereunder^(t). This is done either by consent of the parties or without their consent if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot, in the opinion of the Comptroller, conveniently be made before him. If the parties cannot agree upon an arbitrator, then the Comptroller will appoint one.

(q) Sect. 27 (10).

(s) Sect. 73 A (1).

(r) Sect. 27 (2) (a), proviso, and Cases 504, 490, 51.

(t) Sect. 27 (12).

When a question or issue of fact is referred to an arbitrator the latter reports his finding to the Comptroller, who will base his decision upon it, but where the whole proceedings are referred, the decision of the arbitrator is equivalent to that of the Comptroller. The parties may agree to treat the arbitrator's decision as final, otherwise it is subject to appeal.

An appeal lies from a decision of the Comptroller (or an arbitrator) to the Court^(u), i.e. to such Judge of the High Court as the Lord Chancellor may have selected for hearing appeals under the Acts, whose decision is final, except in the case where the Comptroller has ordered revocation of the patent. Any party appealing to the Court may be ordered to give security for costs of the appeal, if that party does not reside or carry on business in the United Kingdom or the Isle of Man; in default of giving the security ordered, the appeal will be treated as abandoned.

(e) WHAT RELIEF CAN BE OBTAINED. If the Comptroller considers that the applicant has made out his case he may—

(i) Order the patent to be indorsed with the words “licences of right”^(v); or

(ii) Order the grant to the applicant of a licence^(w); or

(iii) Order the patent to be revoked^(x).

(i) The effect of an order that the patent shall be indorsed “Licences of right” is the same as if the patent had been so indorsed at the request of the patentee, under the provisions of Sect. 24^(y). Existing licencees may then apply (Patents Form No. 22) to the Comptroller to surrender their licences in exchange for one settled by the Comptroller in like manner as if the patent had been so indorsed at the request of the patentee^(z). The above powers may be exercised by the Comptroller in spite of the existence of an agreement which would preclude an indorsement at the request of the patentee.

(ii) Where the Comptroller decides to grant a licence to the applicant, it becomes of the utmost importance to consider the terms of the licence so granted; these terms will naturally

(u) Sect. 27 (11).

(v) Sect. 27 (3) (a).

(w) Sect. 27 (3) (b) and (c).

(x) Sect. 27 (3) (d).

(y) See sub-paragraph (2) of this section; *post* p. 157

(z) Rule 84.

vary with the circumstances of the case, but the determining considerations are to be those referred to subsequently in discussing compulsory licences under patents indorsed "Licences of right(a)." In settling the terms of the licence the Comptroller may include a term precluding the licensee from importing patented articles into the United Kingdom, and such a term will operate as an undertaking by the patentee and all other licensees not to import(b). The licensee, under a licence so granted, may call upon the patentee to take action against infringers, and if the patentee refuses or fails to do so he may himself take proceedings against infringers, joining the patentee as defendant in the action, but in that case the patentee will not be liable for costs unless he takes part in the proceedings.

In cases where the invention is not being worked on a commercial scale in the United Kingdom, and is such that it cannot be so worked without the expenditure of capital, for the raising of which it will be necessary to rely on the patent monopoly, and the patentee will not undertake to find such capital, the Comptroller may grant an exclusive licence to the applicant, or any other person, or to any two or more jointly, if they are able and willing to find the capital(c). Such an exclusive licence will (unless otherwise provided) operate to prevent the patentee from working or using the invention and also to revoke any existing licences, but the Comptroller may order compensation to be paid to the patentee or any existing licensee for any money or labour expended in developing or exploiting the invention(d).

Where application is made for an exclusive licence by two or more applicants, one of whom is already registered as a licensee, the existing licensee is to be preferred unless good reason is shown to the contrary(e). In framing a compulsory licence the Comptroller is to protect the patentee's interest by securing for him the payment of the maximum possible royalties compatible with the invention being worked in the United Kingdom at a reasonable profit(f), and also where

(a) See *post* p. 157.

(b) Sect. 27 (3) (b).

(c) Sect. 27 (3) (c).

(d) Sect. 27 (6).

(e) Sect. 27 (5).

(f) Sect. 27 (4) (a).

circumstances permit, a guarantee that the royalties shall each year amount at least to a certain stated sum(g).

If the person to whom an exclusive licence is granted fails to expend the sum of money specified, the licence is liable to be revoked at the discretion of the Comptroller(h).

(iii) There may be cases where the granting of compulsory licences may not be adequate for the prevention of the abuses or attainment of the objects above referred to ; in such cases, the Comptroller may order the revocation of the patent, either forthwith or after a specified time, in which to enable the patentee to comply with any conditions which the Comptroller is empowered to insert in the order with a view to the prevention of such abuses or the attainment of such objects(i).

(2) Compulsory licences in respect of patents indorsed "licences of right." Sect. 24 provides for the indorsement of a patent at the request of the patentee with the words "licences of right"; this right of the patentee to have his patent so indorsed is discussed in Chapter VI. Also, as pointed out above, the Comptroller may on an application for a compulsory licence, under the provisions of Sect. 27, order the patent to be indorsed "licences of right," even without the consent and against the wishes of the patentee. The effect of a patent being indorsed "licences of right" is that any one may at any time apply for a licence. For this purpose the applicant must prove that he has some interest or reason for making the application ; in other words, he must establish a *locus standi*(j).

The application should, in the first instance, be made to the patentee. If an agreement is reached as to the terms of the licence, in default of any specific statement to the contrary, the two following terms are to be deemed to be included(k)—

(a) That the licensee is precluded from importing goods which would be an infringement of the patent into the United Kingdom, and in such a case the patentee and all licensees under the patent are deemed to have mutually covenanted against such importation(l).

(g) Sect. 27 (4) (b).

(i) Sect. 27 (3) (d).

(k) Sect. 24 (1) (a), proviso.

(h) Sect. 27 (4).

(j) Rule 72.

(l) Sect. 24 (1) (c.)

(b) That the licensee shall have the right to call upon the patentee to take action against infringers, and if he refuses or neglects to do so within two months after notice, the licensee may bring an action himself, joining the patentee as defendant(m).

These terms may, however, be specifically excluded from the licence. If the patentee and would-be licensee cannot agree as to the terms of the licence, either may apply to the Comptroller(n) (Patents Form No. 22), who will then settle the terms. The application must be accompanied by a statement in duplicate setting out fully the nature of the applicant's interest, the facts on which he bases his case, and the terms of the licence he is prepared to grant or accept. The procedure is the same as in opposing the grant of a patent. The terms of the licence may include the first of the terms above mentioned and must include the second.

In settling the terms the Comptroller will be guided by the following considerations(o)—

(1) He will endeavour to secure the widest possible user of the invention in the United Kingdom, consistent with the patentee securing a reasonable advantage from his patent rights.

(2) He will secure the maximum possible royalty to the patentee, consistent with a reasonable profit being made by the licensee working the invention in the United Kingdom.

(3) He will endeavour to secure equality of advantage to all licensees whilst taking into consideration any work done or outlay incurred by any licensee in testing the commercial value of the invention or securing its working on a commercial scale in the United Kingdom.

In connection with this last consideration the Comptroller may reduce the royalties or other payments accruing to the patentee under licences previously granted.

The Comptroller probably has power to make any order as to costs on an application for a licence under the provisions of Sect. 24(p), and there is apparently no appeal from his

(m) Sect. 24 (1) (d).

(n) Rule 72.

(o) Sect. 24 (1) (b).

(p) Sect. 73 A (1).

decision as to the terms of any licence settled by him under the provisions of that section.

(3) Compulsory licences in respect of patents for food and medicine. Under Sub-sect. (2) of Sect. 38A any person may apply (Patents Form 29) to the Comptroller(^(q)) for a licence under any patent applied for after the 23rd December, 1919, for an invention intended for, or capable of being used for, the preparation or production of food or medicine and, unless good reason is shown to the contrary, the Comptroller is under obligation to grant to the applicant such a licence, limited to the use of the invention for the purposes of the preparation or production of food or medicine, but not otherwise.

In settling the terms of such licence, and the royalties or other consideration payable, the Comptroller is to have regard to the desirability of making the food or medicine available to the public at the lowest possible price, consistent with giving the inventor due reward for the research leading to the invention.

The decision of the Comptroller, under this section, is subject to an appeal to the Court. The procedure is the same as for applications under Sect. 27, considered above.

(4) Compulsory licences under the provisions of the Treaties of Peace. Under the emergency legislation passed during the late war, all patents held by or on behalf of or for the benefit of alien enemies, and all pending applications for patents made by or on behalf of alien enemies, were vested in a custodian. By the Treaty of Peace these vested patents and applications had to be restored; this restoration was effected by Statutory Rules and Orders(^(r)), which reserved to the Board of Trade the right (*inter alia*) to grant compulsory licences to any person who applies, and to revise or amend any licences so granted or previously granted under any war emergency legislation. The rules regulating the grant of such compulsory licences are, so far as Germany is concerned, contained in Statutory Rules and Orders, 1920, No. 1336(^(s)). The procedure is governed by Statutory Rules and Orders, 1920, No. 1371(^(ss)).

(q) Rule 85.

(s) Appendix VII, p. 332.

(r) S.R. & O., 1920, Nos. 1336, 1371, and 2118. (ss) Appendix VIII, p. 336.

Similar rules and orders govern Austrian and Bulgarian restored patents and applications^(t). An applicant has to show either: (a) that it is in the public interest that a licence should be granted to him; or (b) that the patentee has refused to grant him a licence on reasonable terms.

The application is made to the Comptroller (Patents Form No. 42) with an unstamped duplicate and accompanied by a statement in duplicate stating the reasons for making the application, the facts on which it is based, and the terms of the licence suggested. The Comptroller forwards a copy of the application and statement to the patentee and to any prior licensee. The patentee or prior licensee, if desirous of opposing, must within one month (or such further time as the Comptroller may allow) send the Comptroller a counter-statement setting out the grounds of opposition and must serve a copy of such a counter-statement on the applicant. The Comptroller then appoints a hearing when the parties may appear and witnesses may be called to give evidence and be cross-examined. After the hearing the Comptroller determines the application and settles the terms of the licence. Royalties and other payments due, under a compulsory licence, in respect of a restored patent must be paid by the licensee to the Comptroller of the Clearing House, established by virtue of the Treaty of Peace Acts^(ss).

The above provisions do not apply to the case of a patent or patent application restored to a patentee who has, by virtue of the Treaty of Peace, ceased to be a national of an ex-enemy country.

Section C.—ACTIONS TO RESTRAIN THREATS.

Where any person claiming to have an interest in a patent by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him and may obtain an injunction against the continuance of such threats and may recover such damage (if any) as he has sustained thereby, if

(ss) See p. 166, *post*

(t) Appendix IX.

the alleged infringement, to which the threats related, was not in fact an infringement of the patent(tt). The foregoing does not, however, apply if an action for infringement of the patent is commenced and prosecuted with due diligence(tt).

These provisions are intended to protect traders against the damage to which their business might be subjected by the fear of infringement actions being hung over their own and their customers' heads by persons claiming to hold patent rights. The subject divides itself into the following heads: (1) Who may bring the action. (2) Against whom an action may be brought. (3) In respect of what acts an action may be brought. (4) What defences are open. (5) What remedies may be obtained. (6) Procedure.

(1) **Who may bring the action.** Any person aggrieved by the threats may bring the action. This gives a right of action not merely to a person who is personally or directly threatened but also to a person who is "aggrieved" by threats addressed to another person. Hence, a manufacturer or merchant may have a cause of action if his customers have been threatened in respect of goods supplied by him(u). If the person making the threat complains that the particular use to which the purchaser puts the article supplied by the manufacturer or merchant is an infringement of his rights, then it is questionable whether the manufacturer or merchant would have a cause of action(v). The plaintiff must, however, either have actually suffered, or be likely to suffer, damage by the threats.

(2) **Against whom an action may be brought.** The defendant must be a person who, claiming to have an interest in a patent has, personally or by his servant or agent, made the threats whereby the plaintiff is aggrieved. The only person liable is one who claims to have an interest in a patent, and whether the defendant satisfies this description must be determined from a consideration of the language of the threat itself and the surrounding circumstances. The mere fact that the defendant does not mention the word "patent" is not conclusive that he is not claiming to be interested in a patent,

(tt) Sect. 36 and proviso.

(v) Case 84.

(u) Case 267.

as his threats may be intended and understood to refer to a patent without specifically mentioning it(w).

(3) **In respect of what acts an action may be brought.** To be actionable the threat must be by "circular, advertisement or otherwise"; it probably need not be in writing. The words "or otherwise" do not import something *ejusdem generis* as a circular or advertisement, but include a letter written in answer to an inquiry(x), and also one written by a solicitor(y). A single unjustified threat is sufficient, and it is no protection that the letter was written "without prejudice(z)." The threat must be something more than a mere general warning or announcement that the patentee intends to enforce his rights(a). It must be a specific intimation as to a particular object or thing, or it must identify some act which the person threatening alleges to be an infringement of his patent. But it is competent for the plaintiff to show by surrounding circumstances that a threat, general in form, was intended to be understood and was, in fact, understood in a specific sense(b). The motive in making a threat is immaterial(c), and it is therefore unnecessary for a plaintiff to prove malice, but he must make a *prima facie* case that the patent has not been, or would not be, infringed by the act in respect of which the threat is made(d).

(4) **What defences are open.** (a) Justification. (b) Due diligence in taking action for infringement.

(a) **JUSTIFICATION.** It is a complete defence to the action for the defendant to show that the act complained of in the threat was, or would be, an infringement of the patent; in other words, it is open to the defendant to justify his threat. To establish this defence the defendant must show that his patent has been, or would be, infringed by the act in respect of which he made the threat. Under Sect. 36 of the Act of 1907 it was held not to be sufficient for the defendant merely to produce his patent(e); he had to establish its validity if challenged. The amendments introduced by the Act of 1919

(w) Case 129.

(x) Case 428.

(y) Cases 104, 155.

(z) Case 272.

(a) Case 462 (a).

(b) Case 93.

(c) Case 428.

(d) Case 93.

(e) Case 272.

appear, however, to have altered the law in this respect, and it is doubtful if the plaintiff in a threats action is now at liberty to challenge the validity of the plaintiff's patent, unless it can be said that there can be no infringement of an invalid patent. There is no authority, however, for such a proposition.

(b) DUE DILIGENCE IN TAKING ACTION FOR INFRINGEMENT. It is also a good defence that an action for infringement of the patent is commenced and prosecuted with due diligence. Such an action must be a *bona fide* one(f), but provided it is *bona fide* and is commenced and prosecuted with due diligence(g), it does not matter if it is unsuccessful or even discontinued(h). The action must be for infringement of all the patents under which the threats have been made(i) and the infringement complained of be similar to that threatened(j). The infringement action need not be brought against the plaintiff in the threats action(k) nor by the defendant in that action, and it may be either previous or subsequent to the threats complained of(l). The question whether the infringement action has been commenced with due diligence depends on the facts of each case, and the time must be reckoned from the time the threats are made, not from the time when the alleged infringements took place(m). It has been held that where the defendant in the threats action waited till he could counterclaim in that action for infringement, he had commenced his infringement action with diligence(n), though in similar circumstances in another case a jury found that the defendant had not shown due diligence(o). Where the defendant waited until he had inspected the plaintiff's machines which he alleged to be infringements of the patent, and meantime the plaintiff had launched a motion for an interlocutory injunction, it was held that the defendant had shown due diligence(p). The infringement action need not be one in which the validity of the patent can be called in question(q).

It also appears to be an answer to a threats action if the defendant applies to amend the specification of his patent and

(f) Case 103.

(g) Case 227.

(h) Cases 103, 156.

(i) Case 132.

(j) Case 104.

(k) Case 93.

(l) Case 41.

(m) Cases 93, 208.

(n) Case 103.

(o) Case 19.

(p) Case 149.

(q) Case 121.

then brings an action on his amended specification, provided, of course, he brings the action with due diligence(r).

(5) What remedies may be obtained. The remedies obtainable are : (a) An injunction. (b) Damages. (c) Costs.

(a) AN INJUNCTION. If the plaintiff succeeds in the action he is entitled to an injunction, even if the defendant has only issued one threat, unless that threat has been withdrawn and the defendant has shown his intention of not repeating it ; for a threat until withdrawn is considered a continuing one and the defendant will be presumed to have the intention of repeating it(s). If the plaintiff wishes to obtain an interlocutory injunction pending the trial of the action, he should proceed by motion, either in the ordinary way or by obtaining leave to serve short notice of it with the writ. An *ex parte* injunction has rarely been granted. In deciding whether to grant an interlocutory injunction, the judge will be influenced by a consideration of the balance of convenience of the parties and will not grant it where the defendant would suffer more damage thereby than the plaintiff would by not getting it. If the defendant has with due diligence commenced and is diligently prosecuting an infringement action, the Court will not grant an injunction, and the defendant is at liberty to continue his threats ; but a patentee cannot by starting an infringement action justify public discussion on the merits of pending litigation under the plea that he is merely continuing his threats ; such conduct may amount to contempt of Court(t). To obtain an interlocutory injunction the plaintiff should show a probable case of non-infringement, though he need not necessarily prove it strictly. As a rule, if the defendant is willing to undertake to commence infringement proceedings forthwith, and to prosecute them with due diligence, the Court will not grant an interlocutory injunction, though it may impose the further condition that the defendant discontinues the threats in the meantime.

(b) DAMAGES. Where the damages are nominal or only small, they are usually assessed by the judge immediately after the trial. Otherwise an inquiry is ordered, at which the

(r) Case 199.

(s) Case 133.

(t) Case 162.

procedure is similar to that in an infringement action. The plaintiff is entitled to recover the damages he has suffered, which flow naturally from the defendant's threats; e.g. if the plaintiff has lost a contract in consequence of the threats, the loss of profit will be included in his damages^(u), but not the loss of any further business to which that contract may have led. The loss suffered by the plaintiff must be attributable to the threats of the defendant, but the defendant is not liable for injury to the plaintiff's trade caused by rumours of litigation, nor through any statement, even made or published by the defendant, unless the statement is an actionable threat^(v).

(c) **Costs.** As in other litigation, costs are usually awarded to the successful party; the principle of dealing with the costs is the same as in infringement actions, except that there is no necessity to obtain a certificate as to the particulars being reasonable and proper. Where the defendant succeeds in a threats action by reason of having commenced an infringement action, but has been unsuccessful in the latter or has discontinued it, the Court may dismiss the threats action, leaving each side to pay its own costs^(w).

(6) **Procedure.** The procedure in a threats action is similar to that in any other action.

Where the defendant is bringing an infringement action it is not usual for both actions to be allowed to continue at the same time if they raise the same issues, and to prevent a waste of costs the actions may be consolidated and tried together, or the threats actions may be stayed until after the trial of the infringement action.

Section D.—PATENTS RESTORED UNDER THE TREATIES OF PEACE.

In addition to the liability for compulsory licences (*see* Sect. B (iv) of this chapter) patents and patent applications, which have been restored under the provisions of the Treaty of Peace to persons who were formerly alien enemies, and whose nationality has not been changed by the Treaty of

(u) Case 428.

(v) Case 462 (b).

(w) Cases 104, 448.

Peace, remain subject to certain disabilities. These disabilities are—

(1) Assignments and licences can only be made or granted after notice to and with the consent of the Board of Trade.

(2) No other devolution of title is operative unless and until assented to by the Board of Trade.

(3) Licences granted before restoration continue in force and the licensees are given the rights, privileges, and powers set out in Sect. 27.

(4) The terms of any compulsory licence, whether granted before or after restoration, may be revised or amended, and provisions may be inserted prohibiting the patentee from importing the patented article and/or from working or using the patented invention in the United Kingdom.

(5) On the application of any person interested (or without such application) the Board of Trade, if satisfied that it is necessary for national defence, or in the public interest, or for securing due fulfilment of obligations under the Treaty of Peace, may take over or sell any restored patent or restored application on terms to be settled by a specially appointed tribunal.

(6) Royalties or money payable to a former alien enemy, in respect of the assignment or licence of a restored patent or application, entered into voluntarily between the parties, must be paid as follows: As to 75 per cent thereof, to the Controller of the Clearing House established under the Treaty of Peace; as to 25 per cent thereof, to the person to whom it is due.

The above provisions do not apply to a patent or patent application restored to a person who, by virtue of the Treaty of Peace, has ceased to be a national of a former enemy country, with the exception of those provisions dealing with licences granted before restoration. The above provisions are to be found in *Statutory Rules and Orders*, 1920, No. 1336; the methods of procedure, together with the necessary forms, are set out in *Statutory Rules and Orders*, 1920, No. 1371.

APPENDICES

- (I) Statute of Monopolies
- (II) Patents and Designs Acts, 1907-1919, being the Patents and Designs Act, 1907, as amended by the Patents and Designs Acts, 1914, and the Patents and Designs Act, 1919
- (III) Patents and Designs Act, 1919
- (IV) Patents Rules, 1920
- (V) Forms of Restricted Grant
- (VI) Treaty of Peace Order, 1919
- (VII) Order regarding patents of German nationals vested in Custodian
- (VIII) Patents (Treaty of Peace) Rules, 1920
- (IX) Order regarding patents of Austrian and Bulgarian nationals vested in Custodian
- (X) Table of Cases cited

APPENDIX I

STATUTE OF MONOPOLIES (1623)

(21 JAC. I, c. 3.)

AN Act concerning Monopolies and Dispensations with Penal Laws and the forfeiture thereof.

[Sects. 1 to 4 declare (*inter alia*) that all monopolies of trade are void.]

Sect. 6.—Provided also, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents or grant of such privilege hereafter to be made, but that the same be of such force as they should be if this Act had never been made, and of none other.

APPENDIX II

PATENTS AND DESIGNS ACTS, 1907, 1914 AND 1919 BEING PATENTS AND DESIGNS ACT, 1907, AS AMENDED BY THE PATENTS AND DESIGNS ACT, 1914, AND THE PATENTS AND DESIGNS ACT, 1919

[Note.—The amendments introduced by the Acts of 1914 and 1919 are shown in italics, the repealed or altered portions of the 1907 Act are shown between Heavy Brackets and underscore. The amendment introduced by the 1914 Act affects only Sect. 91 (1) of the 1907 Act, and for convenience the corresponding sections of the 1919 Act only are set out in the arrangement of sections of the 1907 Act below.]

ARRANGEMENT OF SECTIONS.

PART I.

PATENTS.

APPLICATION FOR AND GRANT OF PATENT.

1907 Act Section	1919 Act Section	
1.		Application.
2.		Specifications.
3.		Proceedings upon application.
4.		Provisional protection.
5.		Time for leaving complete specification.
6.	20.	Comparison of provisional and complete specification.
7.	20.	Investigation of previous specifications in United Kingdom on applications for patents.
8.	20.	Investigation of specifications published subsequently to application.
9.		Advertisement on acceptance of complete specification.
10.		Effect of acceptance of complete specification.
11.	4.	Opposition to grant of patent.
12.	5 and 20.	Grant and sealing of patent.
13.	20.	Date of patent.
14.		Effect, extent, and form of patent.
15.	20.	Fraudulent applications for patents.
16.	20.	Single patent for cognate inventions.

TERM OF PATENT.

17.	6.	Term of patent.
18.	7.	Extension of term of patent.
19.	20.	Patents of addition.

RESTORATION OF LAPSED PATENT.

20	20.	Restoration of lapsed patents.
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AMENDMENT OF SPECIFICATION.

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| 21. | 20. | Amendment of specification by Comptroller. |
| 22. | 20. | Amendment of specification by the Court. |
| 23. | 20. | Restriction on recovery of damages. |

COMPULSORY LICENCES AND REVOCATION.

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|------|-----|---|
| [24. | | Compulsory licences and revocation.] |
| 24. | 2. | <i>Provisions as to patents indorsed "licences of right."</i> |
| 25. | 20. | Revocation of patent. |
| 26. | 20. | Power of Comptroller to revoke patents on certain grounds. |
| [27. | | Revocation of patents worked outside the United Kingdom.] |
| 27. | 1. | <i>Provisions for the prevention of abuse of monopoly rights.</i> |
| 27a. | 3. | <i>Enforcement of order for grant of licence.</i> |

REGISTER OF PATENTS.

- | | | |
|------|----|---|
| 28. | | Register of patents. |
| [29. | | Patent to bind Crown.] |
| 29. | 8. | <i>Right of Crown to use patented inventions.</i> |
| 30. | | Assignment to Secretary for War or the Admiralty of certain inventions. |

LEGAL PROCEEDINGS.

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|------|-----|--|
| 31. | 20. | Hearing with assessor. |
| 32. | | Power to counterclaim for revocation in an action for infringement. |
| 32a. | 9. | <i>Power of Court to grant relief in respect of particular claims.</i> |
| 33. | 10. | Exemption of innocent infringer from liability for damages. |
| 34. | 20. | Order for inspection, etc., in action. |
| 35. | 20. | Certificate of validity questioned and costs thereon. |
| 36. | 20. | Remedy in case of groundless threats of legal proceedings. |

MISCELLANEOUS.

- | | | |
|------|-----|--|
| 37. | | Grant of patents to two or more persons. |
| 38. | 20. | Avoidance of certain conditions attached to the sale, etc. of patented articles. |
| 38a. | 11. | <i>Chemical products and substances intended for food and medicine.</i> |
| [39. | 12. | Costs and security for costs.] <i>See Sect. 73a below.</i> |
| 40. | | Procedure on appeal to Law Officer. |
| 41. | 13. | Provision as to anticipation. |
| 42. | | Disconformity. |
| 43. | | Patent on application of representative of deceased inventor. |
| 44. | | Loss or destruction of patent. |
| 45. | 20. | Provisions as to exhibitions. |
| 46. | | Publication of illustrated journal, indexes, etc. |
| 47. | | Patent Museum. |
| 48. | | Foreign vessels in British waters. |

PART II.

DESIGNS.

REGISTRATION OF DESIGNS.

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|-----|-----|--|
| 49. | 20. | Application for registration of designs. |
| 50. | 20. | Registration of designs in new classes. |
| 51. | | Certificate of registration. |
| 52. | | Register of designs. |

COPYRIGHT IN REGISTERED DESIGNS.

- 53. Copyright on registration.
- 54. Requirements before delivery on sale.
- 55. Effect of disclosure on copyright.
- 56. Inspection of registered designs.
- 57. Information as to existence of copyright.
- 58. 14. Cancellation of registration of designs used wholly or mainly abroad.
- 58. 14. *Cancellation of registration of designs.*
- 58A. 15. *Registration of designs to bind the Crown.*

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

- 59. Provisions as to exhibitions.

LEGAL PROCEEDINGS.

- 60. Piracy of registered design.
- 61. Application of certain provisions of the Act as to patents to designs.

PART III.

GENERAL.

PATENT OFFICE, AND PROCEEDINGS THEREAT.

- 62. Patent Office.
- 63. Officers and clerks.
- 64. Seal of Patent Office.

FEES.

- 65. Fees.

PROVISIONS AS TO REGISTERS AND OTHER DOCUMENTS
IN PATENT OFFICE.

- 66. Trust not to be entered in registers.
- 67. Inspection of and extracts from registers.
- 68. 20. Privilege of reports of examiners.
- 69. Prohibition of publication of specification, drawings, etc., where application abandoned, etc.
- 70. Power for Comptroller to correct clerical errors.
- [71. Entry of assignments and transmissions in registers.]
- 71. 16. *Registration of assignments, etc.*
- 72. Rectification of registers by Court.

POWERS AND DUTIES OF COMPTROLLER.

- 73. Exercise of discretionary power by Comptroller.
- 73A. 12. *Costs and security for costs.*
- 74. Power of Comptroller to take directions of law officers.
- 75. Refusal to grant patent, etc., in certain cases.
- 76. Annual reports of Comptroller.

EVIDENCE.

- 77. 20. Evidence before Comptroller.
- 78. Certificate of Comptroller to be evidence.
- 79. Evidence of documents in Patent Office.
- 80. Transmission of certified printed copies of specifications, etc.
- 81. Applications and notices by post.
- 82. Excluded days.
- 83. Declaration by infant, lunatic, etc.

REGISTER OF PATENT AGENTS.

[84. Register of patent agents.]

84. 18. *Registration of patent agents.*

85. Agents for patents.

POWERS, ETC., OF BOARD OF TRADE.

86. Power for Board of Trade to make general rules.

87. Proceedings of the Board of Trade.

88. Provision as to Order in Council.

OFFENCES.

89. Offences.

90. Unauthorized assumption of Royal Arms.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

91. 20. International and Colonial arrangements (as amended also by the Patents and Designs Act, 1914.)

DEFINITIONS.

92. 19 and 20. Provisions as to "the Court."

93. Definitions.

APPLICATION TO SCOTLAND, IRELAND, AND THE ISLE OF MAN

94. 20. Application to Scotland.

95. Application to Ireland.

96. Isle of Man.

REPEAL, SAVINGS, AND SHORT TITLE.

97. Saving for prerogative.

98. Repeal and savings.

99. Short title and commencement.

SCHEDULES.

CHAPTER XXIX.

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks. [28th August, 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows—

PART I.

PATENTS.

APPLICATION FOR AND GRANT OF PATENT.

Application

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

Specifica-
tions.

2.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the Comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.

Proceedings
upon applica-
tion.

3.—(1) The Comptroller General of Patents, Designs, and Trade Marks (herein-after referred to as the Comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

(3) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the Law Officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

Provisional
protection.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within [six] *nine* months from the date of the application—

Provided that where an application is made for an extension of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

6.—(1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may—

(a) refuse to accept the complete specification until it has been amended to his satisfaction; or

(b) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and [treat the claim] *allow an application for the additional invention included in the complete specification to be made and treated as an application for that invention made on the date at which the complete specification was left.*

(4) *An appeal shall lie from the decision of the Comptroller under this section* [A refusal of the Comptroller to accept a complete specification shall be subject to appeal] to the Law Officer, who shall, if required, hear the applicant and the Comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within [twelve] *fifteen* months from the date of the application, the application shall (except where an appeal has been lodged) become void:

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part

Time for leaving complete specification, *as amended by Sect. 20 of the P. and D. Act, 1919.*

Comparison of provisional and complete specification, *as amended by Sect. 20 of the P. and D. Act, 1919.*

Investigation of previous specifications in United Kingdom on applications for patents, *as amended by Sect. 20 of the P. and D. Act, 1919.*

claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the Comptroller is not so satisfied, he shall, [after hearing the applicant, and] unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public:

Provided that the Comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) An appeal shall lie from the decision of the Comptroller under this section to the Law Officer.

[(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.]

Investigation of specifications published subsequently to applications, as amended by Sect. 20 of the P. and D. Act, 1919.

8.—[(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior application; and that section shall, subject to rules under this Act, have effect accordingly.]

(1) In addition to the investigation under the last preceding section, the examiner shall make an investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed in any specification published on or after the date of the application and deposited pursuant to a prior application.

(2) Where, on such [an extended] further investigation, it appears that the invention claimed [in the specification deposited pursuant to an application is] *has been wholly or in part claimed in any [published] such specification deposited pursuant to a prior application, the applicant shall, whether or not his specification*

has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

[(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.]

(4) An appeal shall lie from the decision of the Comptroller under this section to the Law Officer.

(5) The investigations and reports required by this and the last preceding section shall not be held in any way to guarantee the validity of any patent and no liability shall be incurred by the Board of Trade or any officer thereof by reason of or in connection with any such investigation or report or any proceedings consequent thereon.

9. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.

Advertise-
ment on
acceptance of
complete
specification.

10. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

Effect of
acceptance
of complete
specification.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds—

Opposition
to grant of
patent, as
amended by
Sect. 4 of the
P. and D. Act
1919.

(a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or

[(b) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or]

(b) that the invention has been published in any complete specification, or in any provisional specification followed by a complete specification, deposited pursuant to any application made in the United Kingdom within fifty years next before the date of the application for the patent the grant of which is being opposed, or has been made available to the public by publication in any document (other than a British specification) published in the United Kingdom prior to the application; or

(bb) that the invention has been claimed in any complete specification for a British patent which though not published at the date of the application for a patent the grant of which is opposed was deposited pursuant to an application for a patent which is or will be of prior date to such patent ; or

(c) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification ; or

(d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification ; or

(e) that in the case of an application under section ninety-one of this Act the specification describes or claims an invention other than that for which protection has been applied for in a foreign state or British possession and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the application in the foreign state or British possession and the leaving of the application in the United Kingdom.

but on no other ground.

(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the Comptroller shall be subject to appeal to the Law Officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case ; and the Law Officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the Law Officer with the consent of the Treasury may determine.

Grant and sealing of patent, as amended by Secs. 5 and 20 of the P. and D. Act, 1919.

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the Comptroller shall cause the patent to be sealed with the seal of the Patent Office.

Provided that where—

(a) an applicant has agreed in writing to assign a patent when granted to another party or a joint applicant and refuses to proceed with the application ; or

(b) disputes arise between joint applicants as to proceeding with an application ;

the Comptroller on proof of such agreement to his satisfaction, or if satisfied that one or more of such joint applicants ought to be allowed to proceed alone, may allow such other party or joint applicant to proceed with the application, and may grant a patent to him, so however that all parties interested shall be entitled to be heard before the Comptroller, and an appeal shall lie from the decision of the Comptroller under this proviso to the Law Officer.

(2) A patent shall be sealed as soon as may be, and not after the expiration of [fifteen] *eighteen* months from the date of application, provided that :

(a) Where the Comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said [fifteen] *eighteen* months shall be allowed for the sealing of the patent :

(b) Where the sealing is delayed by an appeal to the Law Officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the Law Officer or the Comptroller as the case may be may direct :

(c) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death :

(d) Where [in consequence of the neglect or failure of the applicant to pay any fee] *for any reason* a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application : Provided that no proceedings shall be taken in respect of an infringement committed before the [publication] *acceptance* of the complete specification.

Date of patent, as amended by Sect. 20 of the P. and D. Act, 1919.

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man—

Effect, extent, and form of patent.

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim ; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Fraudulent applications for patents, as amended by Sect. 20 of the P. and D. Act, 1919.

(2) Where a patent has been revoked [on the ground of fraud,] *by the Court on the ground that it has been obtained in fraud of the true and first inventor or where the grant has been refused by the Comptroller under the provisions of paragraph (a) of subsection (1)*

of section eleven of this Act or revoked on the same ground under the provisions of section twenty-six of this Act, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention in lieu of and bearing the same date as the patent so revoked, or as would have been borne by the patent if the grant thereof had not been refused—

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

Single patent for cognate inventions, as amended by Sect. 20 of the P. and D. Act, 1919.

16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and [for the purpose of the provisions of this Act with respect to oppositions to the grant of patents,] *in determining other questions under this Act, the Court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.*

TERM OF PATENT.

Terms of patent, as amended by Sect. 6 of the P. and D. Act, 1919.

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be [fourteen] *sixteen* years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the Comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

Note.—The Patents and Designs Act, 1919, Sect. 6 (2) and (3) also provides that—

Patents and Designs Act, 1919. Sect. 6 (2) and (3).

(2) *Any patent the original term of which had not expired at the date of the commencement of this Act (a) shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, subject to the following conditions—*

(a) any licence existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires;

(b) if the patent would, apart from this section, have expired

(a) Is the amending Act, 1919.

on or before the first day of January nineteen hundred and twenty, the patent shall, during the period of extension, be subject to all the provisions by this Act (a) substituted for section twenty-four of the principal Act (b) (except subsection (5) thereof) as if the patent had been indorsed "licences of right."

(3) Where any party to a contract with the patentee or any other person, entered into before the nineteenth day of November nineteen hundred and seventeen, is subjected to loss or liability by reason of the extension of the term of any patent under the provisions of this section, the Court shall have power to determine in what manner and by which parties such loss or liability shall be borne.

18.—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent :

Extension of term of patent, as amended by Sect. 7 of the P. and D. Act, 1919.

Provided that the Court may in its discretion extend such period within which such a petition may be presented.

(2) Any person may give notice to the Court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(4) The Court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding [seven] five, or, in exceptional cases, [fourteen] ten years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.

(6) Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the Court in considering its decision may have regard solely to the loss or damage so suffered by the patentee :

Provided that this subsection shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's Dominions.

19.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement

(a) Is the amending Act, 1919.

(b) Is the principal Act, 1907.

Patents of addition, as amended by Sect. 20 of the P. and D. Act, 1919.

in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

(2) Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal—

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the Court or Comptroller so orders, become an independent patent, and the fees payable, and the dates when they become payable shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

RESTORATION OF LAPSED PATENTS.

Restoration of lapsed patents, as amended by Sect. 20 of the P. and D. Act, 1919.

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Comptroller shall hear the case and, [subject to an appeal to the Court,] issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

(6) *An appeal shall lie from the decision of the Comptroller under this section to the Court.*

Amendment of specification by Comptroller, as amended by Sect. 20 of the P. and D. Act, 1919.

AMENDMENT OF SPECIFICATION.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the Comptroller in either case shall be subject to an appeal to the Law Officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the Law Officer, entitled to be heard in opposition to the request, and, where there is no opposition, the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the specification: *Provided that the Court shall be entitled in construing a specification as amended to refer to the specification as accepted and published.*

(8) This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending.

22. In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer, *correction, or explanation* in such manner, and subject to such terms as to costs advertisements or otherwise, as the Court may think fit—

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court.

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the [disclaimer, correction, or explanation] *date of decision allowing the amendment*, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Amendment of specification by the Court as amended by Sect. 20 of the P. and D. Act, 1919.

Restriction on recovery of damages as amended by Sect. 20 of the P. and D. Act, 1919.

COMPULSORY LICENCES AND REVOCATION.

Compulsory
licences and
revocation.
*Replaced by
Sect. 2 of the
P. and D. Act,
1919.*

24. — [(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the Court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the Court, and it is proved to the satisfaction of the Court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or, if the Court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the Court:

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the Law Officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or

(b) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method

of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.]

24.(*)—(1) *At any time after the sealing of a patent the Comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words "licences of right," and a corresponding entry to be made in the register, and thereupon—*

Patents and Designs Act, 1919, Sect 2. Provision as to patents indorsed "licences of right."

(a) *any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in default of agreement, may be settled by the Comptroller on the application of either the patentee or the applicant :*

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this subsection as if they had been imposed by the Comptroller thereunder in like manner as if the terms had been settled by the Comptroller :

(b) *in settling the terms of any such licence the Comptroller shall be guided by the following considerations—*

(i) *he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights ;*

(ii) *he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom ;*

(iii) *he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted :*

Provided that, in considering the question of equality of advantage, the Comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom :

(c) *any such licence the terms of which are settled by the Comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation :*

(d) *every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register :*

(*) Sect. 24 was brought into operation on 1st April, 1920, by S.R. & O. 1920, No. 413.

(e) if in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a licence upon terms to be settled by the Comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement:

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods:

(f) the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The Comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the "Illustrated Official Journal (Patents)," and shall satisfy himself that the patentee is not precluded by contract from making such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary:

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences.

(3) Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the Comptroller within the prescribed time and in the prescribed manner, and the Comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement, if already made, to be cancelled.

Any order under this subsection shall be subject to appeal to the Court.

(4) All indorsements of patents under this section shall be entered on the register of patents and shall be published in the "Illustrated Official Journal (Patents)," and in such other manner as to the Comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.

(5) If at any time it appears that in the case of a patent so indorsed there is no existing licence the Comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, after due notice cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made.

Revocation of patent, as amended by Sect. 20 of the P. and D. Act, 1919.

25.—(1) Revocation of a patent may be obtained on petition to the Court.

(2) Every ground on which—

(a) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by *scire facias*; or

[(b) a patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence;]

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

(a) by the Attorney-General or any person authorized by him; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, [in the prescribed manner] apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any Court, an application under this section shall not be made except with the leave of the Court.

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the Comptroller offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court.

27.—[(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The Comptroller shall consider the application, and, if after inquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article

Power of Comptroller to revoke patents on certain grounds, as amended by Sect. 20 of the P. and D. Act, 1919.

Revocation of patents worked outside the United Kingdom. Replaced by Sect. 1 of the P. and D. Act, 1919.

or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either—

(a) forthwith ; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent—

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the Law Officer or such other counsel as he may appoint shall be entitled to appear and be heard.]

*Patents and
Designs Act,
1919, Sect. 1 ;
Provisions
for the preven-
tion of abuse
of monopoly
rights.*

27.(*)—(1) *Any person interested may at any time apply to the Comptroller alleging in the case of any patent that there has been an abuse of the monopoly rights thereunder and asking for relief under this section.*

(2) *The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances :*

(a) *If at any time after the expiration of four years from the date of the patent, the patented invention (being one capable of being worked in the United Kingdom) is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working :*

Provided that, if an application is presented to the Comptroller on this ground, and the Comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the Comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose :

(b) *If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement :*

(c) *If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms :*

(*) Sect. 27 was brought into operation on 1st April, 1920, by S.R. & O., 1920, No. 413.

(d) *If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted :*

(e) *If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee, whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process :*

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay.

(3) *On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the Comptroller may exercise any of the following powers as he may deem expedient in the circumstances—*

(a) *He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the Comptroller of this power shall entitle every existing licensee to apply to the Comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the Comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the Comptroller may make such order ; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee :*

(b) *He may order the grant to the applicant of a licence on such terms as the Comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register :*

In settling the terms of a licence under this paragraph the Comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

(c) If the Comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the Comptroller may think just, but subject as hereinafter provided :

(d) If the Comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the Comptroller may, on reasonable cause shown in any case, by subsequent order extend the interval so specified :

Provided that the Comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession :

(e) If the Comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just.

(4) In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding subsection, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but, subject thereto, the licence shall be so framed as—

(a) to secure to the patentee the maximum royalty compatible with the licensee working the invention within the United Kingdom on a commercial scale and at a reasonable profit ;

(b) to guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the Comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order.

(5) In deciding to whom such an exclusive licence is to be granted the Comptroller shall, unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent.

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the Comptroller may, if he thinks it

fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the Comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention.

(7) Every application presented to the Comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The application must be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

(8) The Comptroller shall consider the matters alleged in the application and declarations, and, if satisfied that the applicant has a bona fide interest and that a prima facie case for relief has been made out, he shall direct the applicant to serve copies of the applications and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent, and shall advertise the application in the "Illustrated Official Journal (Patents)."

(9) If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall, within such time as may be prescribed or within such extended time as the Comptroller may on application further allow, deliver to the Comptroller a counter statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.

(10) The Comptroller shall consider the counter statement and declarations in support thereof and may thereupon dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the Comptroller himself appoints a hearing. In any case the Comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.

(11) All orders of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the Law Officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(12) In any case where the Comptroller does not dismiss an application as hereinbefore provided and

(a) if the parties interested consent, or

(b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Comptroller conveniently be made before him. the Comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the Comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the Comptroller under this section, and, where a question or issue of fact is so referred, the arbitrator shall report his findings to the Comptroller.

(13) For the purposes of this section, the expression "patented article" includes articles made by a patented process.

Patents and Designs Act, 1919, Sect. 3; Enforcement of order for grant of licence.

27A.—Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties.

Register of patents.

REGISTER OF PATENTS.

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be prima facie evidence of any matters by this Act directed or authorized to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

CROWN.

Patent to bind Crown. Replaced by Sect. 8 of the P. and D. Act 1919.

29.—[A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.]

Patents and Designs Act, 1919, Sect. 8. Right of Crown to use patented inventions.

29.(*).—(1) A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves or by such of their agents, contractors, or others as may be authorized in writing by them at any time after the application, make, use or exercise the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled in the manner herein-after provided. And the terms of any agreement or licence concluded between the inventor or patentee and any person other than a Government department, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown :

Provided further that, where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, any Government department (such invention not having been communicated directly

(*) Sect. 29 (1), (2) and (4) was brought into operation on 23rd April, 1920, by S.R. & O., 1920, No. 658; Sect. 29 (3) was brought into operation on 21st January, 1920, by S.R. & O., 1920, No. 59.

or indirectly by the applicant for the patent or the patentee), any Government department, or such of their agents, contractors, or others, as may be authorized in writing by them, may make, use and exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the patentee, notwithstanding the existence of the patent. If in the opinion of the department the disclosure to the applicant or the patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(2) In the case of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the Court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The Court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant and such Government department. The Court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent.

(3) The right to use an invention for the services of the Crown under the provisions of this section or any provisions for which this section is substituted shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown.

(4) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under the laws relating to the customs or excise.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment.

Assignment to Secretary for War or the Admiralty of certain inventions.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interest of the public service, the particulars of the

invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the Law Officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by the Secretary of State or the Admiralty to receive it, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorized by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

LEGAL PROCEEDINGS.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of [either] all of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court otherwise directs.

Hearing with assessor, as amended by P. and D. Act, 1919, Sect. 20.

(2) The Court of Appeal may if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

Power to counterclaim for revocation in an action for infringement.

32A. *Notwithstanding anything to the contrary appearing in section twenty-three of this Act, if the Court in any action for infringement of a patent finds that any one or more of the claims in the specification, in respect of which infringement is alleged, are valid, it shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion, the Court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.*

Patents and Designs Act, 1919, Sect. 9. Power of Court to grant relief in respect of particular claims.

33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Exemption of innocent infringer from liability for damages.

Provided that nothing in this section shall affect any proceedings for an injunction.

34. In an action for infringement of a patent, the plaintiff shall be entitled to relief by way of injunction and damages but not to an account of profits, but subject as aforesaid the Court may on the application of either party make such order for an injunction or inspection [or account,] and impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit.

Order for inspection, etc., in action, as amended by P. and D. Act 1919, Sects. 10 and 20.

35. In an action for infringement of a patent, the Court may certify that the validity of any claim in the specification of the

Certificate of validity questioned and costs thereon, as amended by *P. and D. Act, 1919, Sect. 20.*

Remedy in case of groundless threats of legal proceedings, as amended by *P. and D. Act, 1919, Sect. 20.*

Grant of patents to two or more persons.

Avoidance of certain conditions attached to the sale, etc., of patented articles, as amended by *P. and D. Act, 1919, Sect. 20.*

patent came in question; and, if the Court so certifies, then in any subsequent action for infringement of *such claim* the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client, *so far as that claim is concerned.*

36. Where any person claiming to [be the patentee of an invention,] *have an interest in a patent,* by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of [any legal rights of the person making such threats] *the patent :*

Provided that this section shall not apply if [the person making such threats with due diligence commences and prosecutes] *an action for infringement of [his] the patent is commenced and prosecuted with due diligence.*

MISCELLANEOUS.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent; and any such condition shall be null and void, as being in restraint of trade and contrary to public policy :

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition

on giving the other party three months notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under subsection (1) (i).

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(b) be construed as validating any contract which would, apart from this section, be invalid; or

(c) affect any right of determining a contract or condition in a contract exercisable independently of this section; or

(d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

38.4(a).—(1) *In the case of inventions relating to substances*

(a) The Patents and Designs Act, 1919, Sect. 11 (2), provides that this section shall apply only to patents applied for after the passing of the 1919 Act, i.e. after 23rd December, 1919.

**PART I.
PATENTS.**

*Patents and
Designs Act,
1919, Sect. 11
(1). Chemical
products and
substances
intended for
food or
medicine.*

prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents : Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.

(2) *In the case of any patent for an invention intended for or capable of being used for the preparation or production of food or medicine, the Comptroller shall, unless he sees good reason to the contrary, grant to any person applying for the same, a licence limited to the use of the invention for the purposes of the preparation or production of food or medicine but not otherwise ; and, in settling the terms of such licence and fixing the amount of royalty or other consideration payable, the Comptroller shall have regard to the desirability of making the food or medicine available to the public at the lowest possible price consistent with giving to the inventor due reward for the research leading to the invention.*

Any decision of the Comptroller under this subsection shall be subject to appeal to the Court.

*Costs and
security for
costs.
Repealed by
Patents and
Designs Act,
1919, Sect. 12.
See also Sect.
73a post.*

39.—[(1) The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.]

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the Law Officer, the Law Officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.]

*Procedure on
appeal to
Law Officer.*

40. *The Law Officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the Law Officer and the practice and procedure before him under this Part of this Act ; and in any proceeding before the Law Officer under this Part of this Act, the Law Officer may order costs to be paid by either party, and any such order may be made a rule of the Court.*

*Provisions as
to anticipa-
tion, as
amended by
P. and D. Act,
Sect. 13.*

41.—*(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.*

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

Provided that the protection afforded by this subsection shall not extend to a patentee who has commercially worked his invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the application for the patent(a).

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

Discon-
formity.

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

Patent on
application
of represen-
tative of
deceased
inventor.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may at any time seal a duplicate thereof.

Loss or
destruction
of patent.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privy or consent of the inventor, *or the reading of a paper by an inventor before a learned society or the publication of the paper in the society's transactions*, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

Provisions
as to exhi-
bitions, *as
amended by
P. and D. Act,
1919, Sect. 20.*

(a) the exhibitor, before exhibiting the invention, *or the person reading such paper or permitting such publication*, gives the Comptroller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months from the date of the opening of the exhibition, *or the reading or publication of such paper.*

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such

(a) Under the Patents and Designs Act, 1919, Sect. 13 (2), this proviso does not apply in the case of patents granted before the passing of the amending Act, 1919, viz., 23rd December, 1919.

by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Publication
of illustrated
journal,
indexes, etc.

46.—(1) The Comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

(3) The Comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

Patent
Museum.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

Foreign
vessels in
British
waters.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

PART II.

DESIGNS.

REGISTRATION OF DESIGNS.

Application
for registra-
tion of
designs, as
amended by
P. and D. Act.
1919, *Sect. 20,*

49.—(1) The Comptroller may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this Part of this Act.

(2) The same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question.

(3) The Comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may, *except where refusal is given on a ground mentioned in section seventy-five of this Act*, appeal to the [Board of Trade.] Court, and the [Board.] Court shall, after

hearing the applicant and the Comptroller, if so required, make an order determining whether, and subject to what conditions if any, registration is to be permitted.

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(5) A design when registered shall be registered as of the date of the application for registration.

50. Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

Registration of designs in new classes. as amended by P. and D. Act, 1919.

(a) on the ground of the design not being a new and or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration.

51.—(1) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered.

Certificate of registration.

(2) The Comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

52.—(1) There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed.

Register of designs.

(2) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3) The register of designs shall be prima facie evidence of any matters by this Act directed or authorized to be entered therein.

COPYRIGHT IN REGISTERED DESIGNS.

53.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

Copyright on registration.

(2) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the Comptroller in the prescribed manner, the Comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the Comptroller in the prescribed manner, the Comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of



copyright for a third period of five years from the expiration of the second period of five years.

Require-
ments before
delivery on
sale.

54.—(1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(a) (if exact representations or specimens were not furnished on the application for registration), furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so the Comptroller may erase his name from the register, and thereupon the copyright in the design shall cease; and

(b) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit.

Effect of
disclosure on
copyright.

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

Inspection of
registered
designs.

56.—(1) During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorized in writing by him, or a person authorized by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the Comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection,

and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of goods.

57. On the request of any person furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee, the Comptroller shall inform such person whether the registration still exists in respect of the design, and if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

Information as to existence of copyright.

58.—[(1) At any time after the registration of a design any person may apply to the Comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the Comptroller.]

Cancellation of registration of designs used wholly or mainly abroad, replaced by *Patents and Designs Act, 1919, Sect. 14.*

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

58.—(1) At any time after the registration of a design any person interested may apply to the Comptroller for the cancellation of the registration of the design, on either of the following grounds—

Patents and Designs Act, 1919, Sect. 14. Cancellation of registration of designs.

(a) That the design has been published in the United Kingdom prior to the date of registration ;

(b) That the design is applied by manufacture to any article in a foreign country, and is not so applied by manufacture in the United Kingdom to such an extent as is reasonable in the circumstances of the case :

Provided that, if the application be on the last-mentioned ground, and the Comptroller is satisfied that the time which has elapsed from the date of registration has been insufficient for such application by manufacture in the United Kingdom, the Comptroller may adjourn the application for such time as he may deem sufficient for that purpose ; and that in lieu of cancellation the Comptroller may order the grant of a compulsory licence on such terms as he may consider just.

(2) An appeal shall lie from any order of the Comptroller under this section to the Court, and the Comptroller may at any time refer any such application to the Court for trial.

58A. The registration of a design shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that the provisions of section twenty-nine of this Act shall apply to registered designs as though those provisions were herein re-enacted and in terms made applicable to registered designs.

Patents and Designs Act, 1919, Sect. 15. Registration of designs to bind the Crown.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

59.—(1) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the

Provisions as to exhibitions.

exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

(a) The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the Comptroller the prescribed notice of his intention to do so; and

(b) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

LEGAL PROCEEDINGS.

Piracy of
registered
design.

60.—(1) During the existence of copyright in any design it shall not be lawful for any person—

(a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

Application
of certain
provisions of
the Act as to
patents to
designs.

61. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

PART III.

GENERAL.

PATENT OFFICE AND PROCEEDINGS THEREAT.

62.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

Patent
Office.
5 Edw. 7.
c. 15.

(2) The Patent Office shall be under the immediate control of the Comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the Comptroller may be done by or to any officer authorized by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

63.—(1) There shall continue to be a Comptroller-General of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the Comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

Officers and
clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Seal of
Patent Office.

FEES.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Fees.

PROVISIONS AS TO REGISTERS AND OTHER DOCUMENTS
IN PATENT OFFICE.

66. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed implied or constructive.

Trust not to
be entered in
registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection of
and extracts
from
registers.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall

Privilege of reports of examiners, as amended by P. and D. Act, 1919, Sect. 20.

not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed: *Provided that, on application being made by any person in the prescribed form, the Comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent.*

Prohibition of publication of specifications, drawings, etc., where application abandoned, etc.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Comptroller.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connection with the application shall not at any time be open to public inspection or be published by the Comptroller.

Power for Comptroller to correct clerical errors.

70. The Comptroller may, on request in writing accompanied by the prescribed fee—

(a) Correct any clerical error in or in connection with an application for a patent or in any patent or any specification ;

(b) Cancel the registration of a design either wholly or in respect of any particular goods in connection with which the design is registered ;

(c) Correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

Entry of assignments and transmissions in registers. Replaced by Patents and Designs Act, 1919, Sect. 16.

71.—[(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the Comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.]

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the Comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.]

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent or to the copyright

in a registered design, he shall make application to the Comptroller to register his title, and the Comptroller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title.

Patents and Designs Act, 1919, Sect. 16. Registration of assignments etc.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, he shall make application to the Comptroller to register his title, and the Comptroller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of the Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to or otherwise deal with the patent or design, and to give effectual receipts for any consideration for any such assignment, licence or dealing :

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

(4) Except in applications made under section seventy-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsections (1) and (2) aforesaid, shall not be admitted in evidence in any Court in proof of the title to a patent or copyright in a design or to any interest therein unless the Court otherwise directs.

72.—(1) The Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

Rectification of registers by Court.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the Comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

POWERS AND DUTIES OF COMPTROLLER.

73. Where any discretionary power is by or under this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

Exercise of discretionary power by Comptroller.

Patents and Designs Act, 1919, Sect. 12. Costs and security for costs.

73A.—(1) *The Comptroller shall, in any proceedings before him under this Act, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of Court.*

(2) *If any party giving notice of any opposition under this Act, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or in case of appeal to the Law Officer or the Court, the Law Officer or the Court may require such party to give security for the costs of the proceedings or appeal, and in default of such security being given may proceed to treat the proceedings or appeal as abandoned.*

Power of Comptroller to take directions of Law Officers.

74. *The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a Law Officer for directions in the matter.*

Refusal to grant patent, etc., in certain cases, as amended by P. and D. Act, 1919, Sect. 17.

75. *The Comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality. An appeal shall lie from the decision of the Comptroller under this section to the Law Officer.*

Annual reports of Comptroller.

76. *The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.*

Evidence before Comptroller, as amended by P. and D. Act, 1919, Sect. 20.

77.—(1) *Subject to rules under this Act in any proceeding under this Act before the Comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.*

(2) *In case any part of the evidence is taken vivâ voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath and discovery and production of documents, be in the same position in all respects as an official referee of the Supreme Court.*

Certificate of Comptroller to be evidence.

78. *A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be prima facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.*

Evidence of documents in Patent Office.

79. *Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts*

in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

Transmission of certified printed copies of specifications, etc.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

81. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by post.

Applications and notices by post.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

Excluded days.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

Declaration by infant, lunatic, etc.

(2) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

REGISTER OF PATENT AGENTS.

84.—[(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

Register of patent agents. Replaced by Patents and Designs Act, 1919, Sect. 18.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on

conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.]

*Patents and
Designs Act,
1919, Sect. 18.
Registration
of patent
agents.*

84.—(1) No person shall practise, describe himself, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—

(a) in the case of an individual, he is registered as a patent agent in the register of patent agents;

(b) in the case of a firm, every partner of the firm is so registered;

(c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November nineteen hundred and seventeen, every director and the manager (if any) of the company is so registered;

(d) in the case of a company which commenced to carry on business as a patent agent before that date, a manager or a director of the company is so registered:

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) Every individual not registered as a patent agent before the fifteenth day of July nineteen hundred and nineteen who proves to the satisfaction of the Board of Trade that prior to the first day of August nineteen hundred and seventeen he was bona fide practising as a patent agent, whether individually or as member of a firm, or as a manager or director of an incorporated company, shall be entitled to be registered as a patent agent if he makes an application for the purpose within such time as may be fixed by the Board of Trade, unless after giving an applicant an opportunity of being heard the Board of Trade are satisfied that he has whilst so practising been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom.

(3) If any person contravenes the provisions of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds, and in the case of a company every director, manager, secretary, or other officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.

(4) For the purposes of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.

(5) Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.

(6) No person not registered before the fifteenth day of July nineteen hundred and nineteen shall be registered as a patent agent unless he be a British subject.

85.—(1) Rules under this Act may authorize the Comptroller to refuse to recognize as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being

*Agents for
patents.*

heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorize the Comptroller to refuse to recognize as agent in respect of any business under this Act any company which, if it had been an individual, the Comptroller could refuse to recognize as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorize the Comptroller to refuse to recognize the company or firm as agent if any person whom the Comptroller could refuse to recognize as an agent acts as director or manager of the company or is a partner in the firm.

(3) The Comptroller shall refuse to recognize as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

POWERS, ETC., OF BOARD OF TRADE.

86.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

Power for Board of Trade to make general rules.

(a) For regulating the practice of registration under this Act :

(b) For classifying goods for the purposes of designs :

(c) For making or requiring duplicates of specifications, drawings, and other documents :

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents ;

(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :

(g) For regulating the keeping of the register of patent agents under this Act :

(h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the Comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings
of the Board
of Trade.

87.—(1) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as
to Order in
Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

OFFENCES.

Offences.

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Unauthorized
assumption
of Royal
Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorize the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be

calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorized to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds :

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state, *or his legal representative or assignee*, shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the foreign state.

International
and Colonial
arrange-
ments.
*Amendment
by P. and D.
Act, 1914,
Sect. 1.*

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state ; and

(b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention ; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,
in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905 :
Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period ; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only

in the case of each state as the Order in Council continues in force with respect to that state.

*Amendment
by P. and D.
Act, 1919,
Sect. 20.*

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, [and] or trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

DEFINITIONS.

*Provisions
as to "the
Court," as
amended by
P. and D. Act,
1919, Sect. 20.*

92.—(1) In this Act, unless the context otherwise requires, "the Court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall *except in the case of a petition for the revocation of a patent under section twenty-five of this Act* and subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, [and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.] *An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent.*

*Definitions,
as amended by
P. and D. Act,
1919, Sects.
19 and 20.*

93. In this Act, unless the context otherwise requires—

"Law Officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being [entitled to the benefit of a patent] entered on the register as the grantee or proprietor of the patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

["Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or

more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :]

"Design" means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye ; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical device.

*Patents and
Designs Act,
1919, Sect. 19.*

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural :

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered :

"Proprietor of a new [and] or original design"—

(a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed ; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and

(c) In any other case, means the author of the design ; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person :

"Working on a commercial scale" means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organization, and on a scale which is adequate and reasonable under all the circumstances.

*Patents and
Designs Act,
1919, Sect. 19.*

APPLICATION TO SCOTLAND, IRELAND, AND THE ISLE OF MAN.

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts ; and for the purposes of the provisions so applied "Court of Appeal" shall mean any Court to which such action is appealed :

*Application
to Scotland,
as amended by
P. and D. Act,
1919, Sect. 20.*

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the Sheriff Court :

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence which concurrence may be given on just cause shown only, and service of all writs and summonses in that

action shall be made according to the forms and practice existing at the commencement of this Act :

(4) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland in any proceedings relating to patents or to designs ; and with reference to any such proceedings, the term " the Court " shall mean any Lord Ordinary of the Court of Session, and the term " Court of Appeal " shall mean either Division of that Court :

(5) Notwithstanding anything in this Act, the expression " the Court " shall, [as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court, in Scotland, mean any Lord Ordinary of the Court of Session, and shall] in reference to proceedings in Scotland for the extension of the term of a patent mean [such] any Lord Ordinary of the Court of Session :

(6) The expression " Rules of the Supreme Court " shall except in section ninety-two of this Act, mean act of sederunt :

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly :

(8) The expression " injunction " means " interdict."

Application
to Ireland.

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only :

(2) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term " the Court " means the High Court in Ireland :

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts :

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court :

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction, may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

REPEAL, SAVINGS, AND SHORT TITLE.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. Saving for prerogative.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule— Repeal and savings.

(a) As respects the enactments mentioned in Part I of that schedule, as from the commencement of this Act ;

(b) As respects the enactments mentioned in Part II of that schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation ;

(c) As respects the enactments mentioned in Part III of that schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

and the enactments mentioned in Part II and Part III of that schedule shall, until so repealed, have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight^(a). Short title and commencement.

(a) But see now Patents and Designs Act, 1919, Sect. 22, *post* p.

SCHEDULES

FIRST SCHEDULE. Section 65.

FEES(a) ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
<i>or</i>						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation				1	0	0
(b) <i>Further before end of four years from date of patent.</i>						
On certificate of renewal				50	0	0
(c) <i>Further before end of eight years from date of patent.</i>						
On certificate of renewal				100	0	0

Or in lieu of the fees of £50 and £100 the following annual fees :

Before the expiration of the fourth year from the date of the patent	10	0	0
" " " fifth " " " " " "	10	0	0
" " " sixth " " " " " "	10	0	0
" " " seventh " " " " " "	10	0	0
" " " eighth " " " " " "	15	0	0
" " " ninth " " " " " "	15	0	0
" " " tenth " " " " " "	20	0	0
" " " eleventh " " " " " "	20	0	0
" " " twelfth " " " " " "	20	0	0
" " " thirteenth " " " " " "	20	0	0

(a) These are maximum fees ; for the existing schedule of fees, see p. 243 *post*.

SECOND SCHEDULE

ENACTMENTS REPEALED. Section 98.

PART I

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901	The whole Act.
7 Edw. 7. c. 34.	The Patents Act, 1902	The whole Act.
7 Edw. 7. c. 28.	The Patents & Designs (Amendment) Act, 1907.	The whole Act.

PART II

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (5), (6), and (7), of section twenty-six, and section twenty-nine.

PART III

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (2) and (3) of section forty-seven and section forty-eight.

APPENDIX III

PATENTS AND DESIGNS ACT, 1919

ARRANGEMENT OF SECTIONS

Section.

1. Provisions for the prevention of abuse of monopoly rights.
2. Provisions as to patents indorsed "licences of right."
3. Enforcement of order for grant of licence.
4. Amendment of Sect. 11 of principal Act as to opposition to grant of patent.
5. Amendment of Sect. 12 of principal Act as to grant and sealing of patents.
6. Term of patent.
7. Amendment of Sect. 18 of principal Act as to extension of term of patent.
8. Right of Crown to use patented inventions.
9. Power of Court to grant relief in respect of particular claims.
10. Amendment of Sect. 34 of principal Act as to actions for infringement.
11. Chemical products and substances intended for food or medicine.
12. Costs and security for costs.
13. Amendment of Sect. 41 (2) of principal Act as to anticipation.
14. Cancellation of registration of designs.
15. Registration of designs to bind the Crown.
16. Registration of assignments, etc.
17. Amendment of Sect. 75 of principal Act as to refusal to grant patents, etc.
18. Registration of patent agents.
19. Definitions.
20. Minor amendments of principal Act.
21. Construction, printing, and repeal.
22. Short title and commencement.

SCHEDULE.

Sections 1 to 20 are embodied in the Patents and Designs Act, 1907, above.

Construction,
printing, and
repeal.

21.—(1) This Act shall, except where otherwise expressly provided, apply to patents granted and applications for and specifications relating to patents made and deposited, and designs registered, before as well as after the passing of this Act.

(2) Where by this Act any enactments or words are directed to be added to or omitted from the principal Act, or to be substituted for any other enactments or words in the principal Act, copies of the principal Act printed under the authority of His Majesty's Stationery Office after such direction takes effect may be printed with the enactments or words added or omitted, or substituted for other enactments or words as such direction

requires, and with the sections, subsections, and paragraphs thereof numbered in accordance with such directions; and the principal Act shall be construed as if it had at the time at which such direction takes effect been made with such addition, omission, or substitution.

(3) A reference in any Act of Parliament or other instrument to the principal Act shall, unless the context otherwise requires, be construed to refer to the principal Act as amended by this Act.

(4) The Patents and Designs Act, 1908, is hereby repealed.

22.—(1) This Act may be cited as the Patents and Designs Act, 1919, and the principal Act and this Act may be cited together as the Patents and Designs Acts, 1907 and 1919.

Short title
and com-
mencement.

(2) The provisions by sections one and two of this Act substituted for sections twenty-seven and twenty-four of the principal Act shall not come into operation until such time, not being later than one year after the passing of this Act, as may be fixed by order of the Board of Trade, except so far as the provisions so substituted for the said section twenty-four are by subsection (2) of section six of this Act applied to the patents therein mentioned; and the provisions of this Act relating to the terms on which an invention or registered design can be made, used or exercised by or on behalf of a Government department shall not come into operation until such time as may be fixed by order of the Board of Trade; save as aforesaid this Act shall come into operation on the passing thereof.

[The schedule contains minor amendments of the principal Act and are embodied in the Patents and Designs Act, 1907, as amended by the Act of 1919 above.]

APPENDIX IV

(4) STATUTORY RULES AND ORDERS, 1920, No. 338

PATENTS FOR INVENTIONS

THE PATENTS RULES, 1920, DATED FEBRUARY 25TH, 1920

By virtue of the provisions of the Patents and Designs Acts, 1907 and 1919 (7 Edw. 7, c. 29 and 9 & 10 Geo. 5, c. 80), hereinafter referred to as the "Acts," the Board of Trade, hereinafter referred to as the "Board," do hereby make the following Rules—

SHORT TITLE.

Short title.

1. These Rules may be cited as the Patents Rules, 1920.

COMMENCEMENT.

Commence-
ment.

2. These Rules shall come into operation from and immediately after the 31st March, 1920, with the exception of such of them as relate to procedure under Sections 24 and 27 of the Acts, which shall come into operation at such date as the Board may by Order direct. Provided that those relating to the procedure under Section 24 shall come into operation immediately as regards patents which but for the passing of the Patents and Designs Act, 1919, would have expired between the date of the passing of that Act and the 1st January, 1920; and those relating to the payment of renewal fees before the expiration of the fourteenth year from the date of a patent and in respect of the fifteenth year, and those relating to the disclosure of result of search under Sections 7 or 8 of the Acts, shall have effect as from the passing of the Patents and Designs Act, 1919, but the fees which have become due in respect thereof may be paid at any time before the 1st May, 1920.

INTERPRETATION.

Interpre-
tation.

3. In the construction of these Rules—

"United Kingdom" includes the Isle of Man;

"Foreign Application" means an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order in Council for the time being in force the provisions of Section 91 of the Acts are applicable;

"Convention Application" means an application in the United Kingdom under Section 91 of the Acts;

"Office" means the Patent Office;

"Journal" means the *Illustrated Official Journal (Patents)*.

FEES.

4. The fees to be paid under the Acts, so far as the Acts relate to Patents, shall be those specified in the First Schedule to these Rules.

First
Schedule.

FORMS.

5. The forms herein referred to are those contained in the Second and Third Schedules to these Rules and such forms shall be used in all cases to which they are applicable, and may be modified as directed by the Comptroller to meet other cases.

Second
and Third
Schedules.

DOCUMENTS.

6. All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board shall be written, typewritten, lithographed or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong wide-ruled white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Size, etc., of
documents.

At the top of the first page of a specification a space of about two inches should be left blank.

7. Any application, notice, or other document authorized or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Acts or these Rules, may be sent by a prepaid or official paid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Leaving and
serving
documents.

A letter addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Acts or these Rules, at the address appearing on the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

8. Every applicant or opponent in any proceedings under the Acts or these Rules, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent or patentee.

Address for
service.

If any patentee desires to have two addresses for service entered in the register a request therefor shall be made on Patents Form No. 31 in respect of each patent.

The Comptroller may require any patentee, who does not reside in the United Kingdom, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

AGENCY.

Agency.

9. With the exception of the signing of the following documents, namely, applications for patents, for the revocation of patents, for the grant of a licence under a patent, for the indorsement of a patent "licences of right," for the refusal of a request for the indorsement of a patent "licences of right," for the cancellation of such indorsement, for the restoration of lapsed patents, requests for leave to amend applications or specifications, authorizations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all communications to the Comptroller under the Acts and these Rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorized to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

The Comptroller shall not be bound to recognize as such agent, or to receive further communications in respect of any business under the Acts from, any person whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent, has been erased from the register of patent agents kept under the provisions of the Acts and not since restored.

APPLICATIONS FOR THE GRANT OF PATENTS.

Form of application.

10. An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patents Forms, Nos. 1, 1A, 1B or 1B* as the case may be. An application for a Patent of Addition shall be made on Patents Forms No. 1C, 1C*, 1C**, 1C*† or 1C***, and an application for a Secret Patent on Patents Form No. 1D.

Application by representative of deceased inventor.

11. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of the will, or the letters of administration granted of the estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title to be regarded as legal representative and be supported by such further evidence as the Comptroller may require.

Order of recording applications.

12. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same are delivered in the ordinary course of post.

Applications left at the Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

One invention.

13.—(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

Applications for separate patents by way of amendment.

Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to

apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Acts and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings or any of them to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

14. The statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification. Claims.

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

15. Every Convention application shall contain a declaration that a foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the Foreign States or British Possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person by whom such first foreign application was made or by his legal representative or assignee. Convention applications

16. In addition to the specification left with every Convention application a copy or copies of the specification or specifications and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such Foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller, must be left at the Office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto. Foreign specification, etc., to accompany application.

and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, translations, drawings or documents shall be made on Patents Form No. 5.

Public inspection.

17. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall nevertheless be open to public inspection at the expiration of that period.

Proceedings.

18. Save as aforesaid and as provided by Rule 87 all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by the Acts or these Rules for ordinary applications.

DRAWINGS. (*)

General.

19. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 26. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed may appear in the specification itself.

Requirements as to paper, etc.

20. Drawings must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness, without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings may not be used.

Size of drawings and arrangement of figures.

21. Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to $8\frac{1}{4}$ inches or from 16 inches to $16\frac{1}{2}$ inches wide, the narrower sheets being preferable. A clear margin must be left half an inch from the edges of the sheet.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets. They should be separated by a sufficient space to keep them distinct.

Drawings to be suitable for reproduction.

22. Drawings must be prepared in accordance with the following requirements—

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.
- (d) Shading lines must not contrast too much in thickness with the general lines of the drawing.
- (e) Sections and shading should not be represented by solid black or washes.

(*) NOTE.—Copies of Instructions as to the Preparation of Drawings may be had on application to the Patent Office.

(f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, etc., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words. No dimensions should be marked on the drawings.

(g) The figures should be drawn in an upright position in regard to the top and bottom of the sheet.

(h) Reference letters and numerals, and index letters and numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters or numerals should be used in different views of the same parts. Where the reference letters or numerals are shown outside the figure, they must be connected with the parts referred to by fine lines.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after one or more provisional specifications, the numbers and years of the applications) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter shall appear on the drawings.

Drawings to bear name of applicant, etc., but no descriptive matter.

24. A facsimile or "true copy" of the original drawings shall be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that the reference letters or numerals and leading lines thereto should be in black-lead pencil. In the case of a hand-made drawing this copy may be on tracing cloth. Where drawings are filed in connection with a Convention application a second "true copy" of the original drawings must be filed.

Copies of drawings.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Marking of originals and true copies.

25. Drawings must be delivered at the Office free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Condition of drawings on delivery.

26. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he shall refer to them in the complete specification as those left with the provisional specification.

Provisional drawings used for complete specification.

EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.

27. An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

Extension of time for leaving complete specification.

PROCEDURE UNDER SECTION 7 OF THE ACTS.

28. If after the leaving of any complete specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by Subsection 1, and the Comptroller requires amendment of the specification and drawings, or any of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied

Power of Comptroller to post-date.

with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Provisional
report in case
of complete
anticipation.

29. When the Examiner in prosecution of the investigation prescribed by Subsection 1, finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications within the meaning of the subsection, he shall, without any further prosecution of the investigation, make a provisional report to that effect.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by Subsection 4. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made, and the specification shall be dealt with as provided in Subsection 3 or Subsection 4, as the case may require.

Time for
leaving
amended
specification.

30. The time within which an applicant may leave his amended specification under Subsection 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of Subsection 1.

Applications for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

Hearing by the
Comptroller
under sub-
section 4.

31. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of Subsection 1, and the time allowed for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that subsection, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what prior specification or specifications by way of notice to the public, and in the event of the invention claimed being wholly and specifically claimed in any specification to which the investigation has extended, whether he should refuse to grant a patent, and shall inform the applicant accordingly. As an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant

must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30.

32. When under Subsection 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims—

Reference
to prior
specification.

Reference has been directed in pursuance of Section 7, Subsection 4, of the Patents and Designs Acts, 1907 and 1919, to specification No. of 1 .

Where the reference is inserted as the result of a provisional report under Rule 29, a statement to that effect shall be added to the reference.

PROCEDURE UNDER SECTION 8 OF THE ACTS.

33. Where on the extended investigation provided for by Section 8 of the Acts it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

Procedure
under
Section 8.

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts and Rules for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

34. If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and if so, what prior specification or specifications by way of notice to the public and shall inform the applicant accordingly. As

Hearing by
Comptroller.

an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 30.

Reference to
prior speci-
fication.

35. When, under Subsection 2, the Comptroller determines that reference to a prior specification ought to be made, by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims—

“Reference has been directed, in pursuance of Section 8, Subsection 2, of the Patents and Designs Acts, 1907 and 1919, to specification No. of 1 .”

Advertisement of
amendments.

36. When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the Journal.

DISCLOSURE OF RESULT OF SEARCH.

Disclosure of
result of search.

37. Application for disclosure of the result of a search made under Sections 7 or 8 of the Acts may be made, on Patents Form No. 9, at any time after the acceptance of the specification.

CHEMICAL INVENTIONS.—TYPICAL SAMPLES AND SPECIMENS.

Chemical
inventions—
Typical
samples and
specimens.

38. Where under Section 2, Subsection (5), of the Acts, before the acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the complete specification and in connection with the advertisement of acceptance of same in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding three inches, and of an external diameter of $1\frac{1}{2}$ inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches

long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

ACCEPTANCE OF SPECIFICATIONS.

39. An application for extension of time for accepting a complete specification shall be made on Patents Form No. 8.

Extension of time for accepting complete specification.

40. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the Journal.

Notice and advertisement of acceptance.

41. After such acceptance in the case of a complete specification the application and specification or specifications with the drawings (if any) may be inspected at the Office upon payment of the prescribed fee.

Inspection of specification.

OPPOSITION TO GRANT OF PATENT.

42. A notice of opposition to the grant of a patent shall be given on Patents Form No. 10, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Notice of opposition.

Copy for applicant.

43. If the applicant is desirous of contesting the opposition, he shall within 14 days of the receipt of such copies, or such further time as the Comptroller may allow, leave at the Office a counter-statement fully setting out the grounds upon which the opposition is contested and on so leaving shall deliver to the opponent a copy thereof.

Counter-statement.

44. The opponent may within 14 days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence by way of statutory declarations in support of his case and, on so leaving, shall deliver to the applicant a copy thereof.

Opponent's evidence.

45. Within 14 days from the delivery of such copy, or if the opponent does not leave any evidence, within 14 days from the expiration of the time within which the opponent's evidence might have been filed, or within such further time as the Comptroller may in either case allow, the applicant may leave at the Office statutory declarations in answer and, on so leaving, shall deliver to the opponent a copy thereof; and within 14 days from such delivery or within such further

Applicant's evidence.

Evidence
in reply.

time as the Comptroller may allow, the opponent may leave at the Office statutory declarations in reply and, on so leaving, shall deliver to the applicant a copy thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Closing of
evidence

46. No further evidence shall be left on either side except by leave, or on requisition, of the Comptroller.

Translations
of documents in
foreign
languages.

47. Where a document in a foreign language is referred to in any statement or declaration filed in connection with an opposition, an attested translation in duplicate shall be furnished.

Hearing.

48. On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard he shall forthwith notify the Comptroller to that effect. If either party desires to be heard he must leave Patents Form No. 11 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 11 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification or publication already mentioned in the proceedings, he should give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Comptroller shall decide the case and notify his decision to the parties.

Costs in
uncontested
cases.

49. In the event of an opposition being uncontested by the applicant, the Comptroller in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the opposition was filed.

SEALING OF PATENT AND PAYMENT OF FEE.

Sealing of
patent and
payment of fee;

50. If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by Section 12 of the Acts pay the sealing fee by leaving at the Office Patents Form No. 12.

Extension of
time for
sealing

51. Where for any reason a patent cannot be sealed within the period allowed by Section 12, the applicant may apply to the Comptroller on Patents Form No. 13 for an extension of such period not exceeding three months.

FORM OF PATENT.

Form of
patent.

52. A patent, except in the cases provided for in Rules 53 and 54, may be in the Form A, in the Third Schedule to these Rules.

Form of
patent of
addition.

53. A patent of addition may be in the Form B, in the Third Schedule to these Rules.

Form of
patent to legal
representatives
of deceased
inventor and
others.

54. Where a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be

modified so as to show clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

RENEWAL FEES.

55. If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by leaving at the Office Patents Form No. 14. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 15.

Renewal fees.

56. On due compliance with the terms of Rule 55, the Comptroller shall issue a Certificate that the prescribed payment has been duly made.

Certificate of payment of fee.

57. At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

Notice as to renewal fees.

RESTORATION OF LAPSED PATENTS.

58. Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time the patentee may apply to the Comptroller on Patents Form No. 16 for an order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable.

Restoration of lapsed patents.

59. At any time within two months from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 17. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Opposition.

60. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Further procedure.

61. If no opposition to the application is entered the Comptroller shall at the expiration of the opposition period appoint a time for hearing the applicant and, if satisfied with the evidence adduced, issue an Order restoring the patent.

Hearing.

62. In every Order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the

Order.

patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was *bona fide* manufactured or made, or such mechanism, machine, machinery, process or operation was *bona fide* made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process, or operation of any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

Compensation.

63. The Order shall further provide that if any person within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the *bona fide* belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

AMENDMENT OF SPECIFICATION UNDER SECTION 21 OF THE ACTS.

Request for leave to amend.

64. A request to the Comptroller for leave to amend a specification, except when such request is made under Rules 33 or 34, shall be made on Patents Form No. 18. The request

must be accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication in the Request and the nature of the proposed amendment in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

65. A notice of opposition to the amendment shall be on Patents Form No. 19. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Notice of
opposition.
Copy for the
applicant.

66. Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 43 to 49 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Further
proceedings.

67. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Office a new specification and drawings as amended, to be prepared in accordance with Rules 6 and 19 to 25.

Requirements on
amendment.

68. Particulars of all amendments of specifications allowed and made under Section 21 shall be advertised forthwith by the Comptroller in the Journal, and in such other manner (if any) as the Comptroller may direct.

Advertisement of
amendment.

LICENCES OF RIGHT.

69. A request to the Comptroller to indorse a patent with the words "licences of right" shall be made upon Patents Form No. 20. Such request shall be accompanied by a statutory declaration and such other evidence as the Comptroller may deem necessary to show that the patentee is not precluded by contract from making such request.

Request for
indorsement
"licences of
right."

70. Upon receipt of such request it shall be advertised in the Journal and any person alleging that such request has been made contrary to some contract, in which he is interested, may apply to the Comptroller upon Patents Form No. 21, within one month from the date of the advertisement, for the refusal of the request. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee.

Application
for refusal of
request.

71. Upon such application being made and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Further
procedure.

72. An application to the Comptroller for settlement of the terms of a licence under a patent which has been indorsed "licences of right" shall be made upon Patents Form No. 22. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the

Application to
settle terms of
licence.

nature of the applicant's interest, the facts upon which he bases his case and the terms of the licence which he is prepared to grant or accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee or the applicant for the licence, as the case may be. Upon such application being made and copy thereof transmitted to the patentee or applicant for the licence, as the case may be, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Application for
cancellation of
indorsement.

73. An application by a patentee for the cancellation of an indorsement under Section 24 of the Acts shall be made upon Patents Form No. 23 and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable. Such application should be accompanied by Patents Form No. 14 in respect of the unpaid moiety of all renewal fees which have become due since the indorsement.

Opposition.

74. At any time within one month from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 24. Such notice shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

Further
procedure.

75. Upon such notice of opposition being given and a copy thereof transmitted to the patentee, the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereto.

PROCEDURE UNDER SECTION 26 OF THE ACTS.

Application
under Sect. 26 of
the Acts.

76. An application for the revocation of a patent under Section 26 of the Acts shall be made on Patents Form No. 25. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

Copy for
patentee.

Procedure.

77. Upon such application being made and copy thereof transmitted to the patentee the provisions of Rules 43 to 49 shall apply *mutatis mutandis* to the further proceedings thereon.

Surrender of
patent.

78. A notice of an offer by a patentee to surrender his patent under Section 26 of the Acts shall be given on Patents Form No. 26, and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable.

PROCEDURE UNDER SECTION 27 OF THE ACTS.

Application for
compulsory
licence or
revocation of a
patent.

79. An application to the Comptroller for an Order under Section 27 of the Acts shall be made on Patents Form No. 27 and shall show clearly the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. The application shall be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

80. If the Comptroller upon consideration of the application decides that it may proceed, it shall be advertised in the Journal and the applicant shall upon receipt of directions from the Comptroller serve a copy of the application and of the declarations upon the patentee and upon any other persons appearing from the Register to be interested in the patent.

Advertisement of application.

Service of documents.

81. The patentee or any person desirous of opposing the application shall within 14 days from the advertisement of the application in the Journal, or such further time as the Comptroller may allow, deliver to the Comptroller a counter-statement verified by a statutory declaration fully setting out the grounds on which the application is opposed. A copy of the counter-statement and of the declaration shall at the same time be delivered to the applicant by the opponent.

Counter statement.

82. A demand for hearing by any of the parties shall be made upon Patents Form No. 28 which must be left at the Office within 14 days from the date of the delivery of the counter-statement and declaration.

Application for hearing.

83. Upon receipt of such demand, the Comptroller shall appoint a time for hearing the case and shall give all the parties ten days' notice at the least of such appointment. Any party who does not desire to be heard shall forthwith notify the Comptroller to that effect. Every person who desires to be heard, except the person applying for the hearing, must leave Patents Form No. 11 at the Office and the Comptroller may refuse to hear any person who has not left Patents Form No. 11 prior to the date of the hearing. If no application for a hearing has been received from any party and the Comptroller is of opinion that a hearing is necessary, he shall appoint a time for hearing the case and the procedure shall be the same as that set out above. After hearing the party or parties or without a hearing if no hearing is necessary, the Comptroller shall decide the case and notify his decision to the parties.

Hearing.

84. An application by an existing licensee, under a patent which has been indorsed "licences of right" under the provisions of Section 27, Subsection 3 (a) of the Acts, for an Order of the Comptroller entitling the licensee to surrender his licence in exchange for a licence to be settled by the Comptroller, shall be made upon Patents Form No. 22 as provided in Rule 72 and the further proceedings thereon shall be regulated in accordance with the provisions contained in Rule 72 as if it were herein repeated.

Application by licensee to surrender a licence under Sect. 27 (3) (a).

PATENTS FOR FOOD OR MEDICINE.

85. An application to the Comptroller under Section 38A (2) of the Acts for a licence to use an invention for the purposes of the preparation or production of food or medicine shall be made on Patents Form No. 29. The procedure to be followed shall be the same as that prescribed in Rules 79 to 83 for an application under Section 27 of the Acts.

Patents for food or medicine.

REGISTER OF PATENTS.

86. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name,

Entry of grant.

address, and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

Entry in respect
of Convention
application.

87. The patent granted on any Convention application shall be entered in the register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application. The date of the application in this country shall also be entered in the register.

Alteration of
address.

88. If a patentee send to the Comptroller on Patents Form No. 30 notice in respect of a patent of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Application for
entry of
subsequent
proprietorship.

89. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee or licensee, application for the entry in the register of his name as proprietor or part proprietor of the patent, or of a notice of such interest, as the case may be, shall be made on Patents Form No. 32 or Patents Form No. 33, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor or part proprietor, or by his agent, and in the case of a body corporate by its agent.

Form and
signature of
request.

Production of
documents of
title and other
proof.

90. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such application, except such documents as are matters of record in the United Kingdom, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the application, and he may call for such other proof of title or written consent as he may require for his satisfaction.

As to a document which is a matter of record in the United Kingdom, an official or certified copy thereof shall in like manner be produced to the Comptroller.

Copies for
office.

91. The application shall be accompanied by an attested copy of the assignment or other document or copy above required to be produced.

Entry of notice
interest.

92. The notice of interest in the patent of any person other than the proprietor or part proprietor entered in the register in pursuance of the application shall be such as may appear applicable to the circumstances of the particular case.

Entry of
notification
of document.

93. Application for entry in the Register of notification of any document (not already provided for) purporting to affect the proprietorship of a patent shall be made on Patents Form No. 34. Such application shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Entry of date of
payment of fees
on issue of
certificate.

94. Upon the issue of a certificate of payment under Rule 56, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

95. The register of patents shall be open to the inspection of the public on every day on which the Office is open to the public during the time it is so open except at such times when the register is required for any purpose of official use.

Hours of
inspection of
register.

CORRECTION OF CLERICAL ERRORS.

96. A request for the correction of a clerical error in or in connection with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 35.

Correction of
clerical errors.

CERTIFICATES.

97. A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorized by the Acts or any of these Rules to make or do, shall be made on Patents Form No. 36.

Certificates and
certified copies
of documents.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

SECRET PATENTS.

98. When it has been decided by the Admiralty, Secretary of State for War or the President of the Air Council that it is advisable to take out a secret patent for any invention assigned under Section 30 of the Acts, and an application for such patent has been made on Patents Form No. 1b, accompanied by a certificate of the Admiralty, Secretary of State or the President of the Air Council under Section 30 (3) of the Acts, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Acts to be made in the case of other applications for patents.

Secret
patents.

Unless and until such invention is re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council—

(1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.

(2) The application for the patent, and the acceptance of any specification relating to the invention shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under Section 11 of the Acts; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.

(3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Acts for ordinary patents. Nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.

(4) No fees shall be payable in respect of any secret

patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of 16 years from its date.

Certificate of
secrecy after
application.

99. When an application has been made otherwise than as provided by the last preceding rule for a patent for an invention, and such application is still pending, and a certificate under Section 30 (3) of the Acts is furnished to the Comptroller by the Admiralty, Secretary of State or the President of the Air Council, the provisions of such rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Re-assignment.

100. In the event of any secret patent being re-assigned to the inventor by the Admiralty, Secretary of State or the President of the Air Council, it shall be removed from the Confidential Register of secret patents; all fees that would have been thereafter payable if the same had not been a secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payments of fees and otherwise as if it had not been a secret patent.

LOST PATENT.

Lost patent.

101. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 37, and in accordance with the directions thereon.

INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

Industrial or
international
exhibitions.

102. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 38 of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

PUBLICATION OF INVENTIONS BEFORE LEARNED SOCIETIES.

Publication of
inventions before
learned societies.

103. Any person desirous of publishing an invention by reading a paper before a learned Society or of permitting publication of the paper in such Society's transactions may give the Comptroller notice on Patents Form No. 38 of his intention to publish the invention as provided in Rule 102.

EXERCISE OF DISCRETIONARY POWERS BY THE COMPTROLLER.

Exercise of
discretionary
powers by
Comptroller.
Notice of
hearing.

104. Before exercising any discretionary power given to the Comptroller by the Acts or these Rules adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

105. Within five days from the date on which such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

Notice by applicant.

106. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Comptroller may require statement, etc.

107. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.

Decision to be notified to parties.

STATUTORY DECLARATIONS AND AFFIDAVITS.

108. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written, typed, lithographed or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Form, etc., of statutory declaration and affidavit.

109. The statutory declarations and affidavits required by the Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows—

Manner in which, and persons before whom, declaration or affidavit is to be taken.

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a judge or magistrate.

GENERAL.

110. Any document for the amending of which no special provision is made by the Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms and in such manner as the Comptroller may think fit.

Power of amendment, etc.

111. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times prescribed by Rules 16 and 55, may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

General power to enlarge time.

Days and hours
of business.

112. The Office shall be open to the public every weekday except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

Excluded days.

113. Whenever the last day fixed by the Acts, or by these Rules, for doing any thing shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Acts and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Power to
dispense with
evidence,
signature, etc.

114. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

APPLICATIONS TO AND ORDERS OF COURT.

Applications
to Court.

115. Four clear days' notice of every application to the Court under Section 72 of the Acts for rectification of the register of patents shall be given to the Comptroller.

Orders of
Court.

Where any Order has been made by the Court under the Acts revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent or any rights thereunder, the person in whose favour such order has been made shall forthwith leave at the Office an office copy of such order together with Patents Form No. 39. The specification shall thereupon be amended or the register rectified or the purport of such Order shall otherwise be duly entered in the register as the case may be.

REPEAL.

Repeal.

116. All general rules relative to Patents heretofore made by the Board of Trade under the Patents and Designs Act, 1907, and in force on the 31st day of March, 1920, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application or other matter then pending.

Dated the 25th day of February, 1920.

A. C. Geddes,

President of the Board of Trade.

THE FIRST SCHEDULE.

LIST OF FEES PAYABLE IN RESPECT OF THE GRANT OF PATENTS AND OF OTHER MATTERS WITH RELATION THERETO.

	—	Corresponding Form.
	£ s. d.	
1. On application accompanied by provisional specification	1 0 0	Patents Form No. 1 or 1A, etc.
2. On filing complete specification thereafter	3 0 0	Patents Form No. 3.
3. On application accompanied by complete specification	4 0 0	Patents Forms Nos. 1 or 1A, etc., and 3.
4. On appeal from Comptroller to Law Officer. By appellant	3 0 0	Patents Form No. 4.
5. For extension of time under Rule 16— Not exceeding one month	2 0 0	Patents Form No. 5.
„ two months	4 0 0	„ „
„ three months	6 0 0	„ „
6. For extension of time for leaving complete specification not exceeding one month	2 0 0	Patents Form No. 6.
7. For extension of time for leaving amended specification under Rules 30 or 33 or notifying acceptance of alternative under Rules 31 or 34— Not exceeding one month	10 0	Patents Form No. 7.
Each succeeding month	10 0	„ „
8. For extension of time for acceptance of complete specification— Not exceeding one month	2 0 0	Patents Form No. 8.
„ two months	4 0 0	„ „
„ three months	6 0 0	„ „
9. On application for result of a search under Sections 7 or 8	1 0 0	Patents Form No. 9.
10. On notice of opposition to grant of patent. By opponent	1 0 0	Patents Form No. 10.
11. On hearing by Comptroller. By applicant and by opponent respectively	2 0 0	Patents Form No. 11.
12. On sealing of patent	1 0 0	Patents Form No. 12.
13. For extension of time for sealing of patent— Not exceeding one month	2 0 0	Patents Form No. 13.
„ two months	4 0 0	„ „
„ three months	6 0 0	„ „

		Corresponding Form.
On application for certificate of renewal—	£ s. d.	
*14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year .	5 0 0	Patents Form No. 14.
*15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year .	6 0 0	" "
*16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year .	7 0 0	" "
*17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year .	8 0 0	" "
*18. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year .	9 0 0	" "
*19. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year .	10 0 0	" "
*20. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year .	11 0 0	" "
*21. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year .	12 0 0	" "
*22. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year .	13 0 0	" "
*23. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year .	14 0 0	" "
*24. Before the expiration of the 14th year from the date of the patent and in respect of the 15th year .	15 0 0	" "
*25. Before the expiration of the 15th year from the date of the patent and in respect of the 16th year .	16 0 0	" "
26. On enlargement of time for payment of renewal fees—		
Not exceeding one month	2 0 0	Patents Form No. 15.
" two months	4 0 0	" "
" three months	6 0 0	" "
27. On application for restoration of a lapsed patent .	20 0 0	Patents Form No. 16.
28. On notice of opposition to application for restoration of lapsed patent	1 0 0	Patents Form No. 17.
29. On hearing by Comptroller. By applicant and by opponent respectively	2 0 0	Patents Form No. 11.
30. On application to amend specification—		
Up to sealing. By applicant	1 10 0	Patents Form No. 18.
After sealing. By patentee	3 0 0	" "
31. On notice of opposition to amendment. By opponent	1 0 0	Patents Form No. 19.
32. On hearing by Comptroller. By applicant and by opponent respectively	2 0 0	Patents Form No. 11.
33. On request for indorsement of patent "Licences of Right"	1 0 0	Patents Form No. 20.
34. On application for refusal of request for indorsement of patent "Licences of Right"	2 0 0	Patents Form No. 21.
35. On hearing by Comptroller. By each party .	2 0 0	Patents Form No. 11.

* One moiety only of these fees payable on Patents indorsed "Licences of right."

		Corresponding Form.
	£ s. d.	
36. On application for settlement of terms of licence under patent indorsed "Licences of Right" .	5 0 0	Patents Form No. 22.
37. On hearing by Comptroller. By each party .	2 0 0	Patents Form No. 11.
38. On application for cancellation of indorsement of a patent "Licences of Right"	2 0 0	Patents Form No. 23.
39. On notice of opposition to cancellation of indorsement of a patent "Licences of Right"	2 0 0	Patents Form No. 24.
40. On hearing by Comptroller. By each party .	2 0 0	Patents Form No. 11.
41. On application for revocation of a patent under Section 26	2 0 0	Patents Form No. 25.
42. On hearing by Comptroller. By applicant and by patentee respectively	2 0 0	Patents Form No. 11.
43. On offer to surrender a patent under Section 26 .	1 0 0	Patents Form No. 26.
44. On hearing by Comptroller. By applicant and by opponent respectively	2 0 0	Patents Form No. 11.
45. On application for grant of compulsory Licence or revocation of a Patent under Section 27	5 0 0	Patents Form No. 27.
46. On request for hearing under Section 27 (10) .	2 0 0	Patents Form No. 28.
47. On hearing by Comptroller. By each party .	2 0 0	Patents Form No. 11.
48. On application for Licence under Section 38A (2) .	5 0 0	Patents Form No. 29.
49. On hearing by Comptroller. By each party .	2 0 0	Patents Form No. 11.
50. For altering name or address or address for service in register	5 0	Patents Form No. 30.
51. For entry of two addresses for service in register .	5 0	Patents Form No. 31.
52. On application for entry of name of subsequent proprietor in the register of patents, if made within six months from date of acquisition of proprietorship or the coming into force of these Rules— In respect of one patent	1 0 0	Patents Form No. 32.
For each additional patent	2 6	" "
53. On application for entry of name of subsequent proprietor in the register of patents, if made after expiration of six months from date of acquisition of proprietorship and the coming into force of these Rules— In respect of one patent	10 0 0	" "
For each additional patent	2 6	" "

	—	Corresponding Form.
54. On application for entry of notice of a mortgage or licence in the register of patents, if made within six months from date of acquisition of interest or the coming into force of these Rules—	£ s. d.	
In respect of one patent	1 0 0	Patents Form No. 33.
For each additional patent	2 6	" "
55. On application for entry of notice of a mortgage or licence in the register of patents, if made after expiration of six months from date of acquisition of interest and the coming into force of these Rules—		
In respect of one patent	10 0 0	Patents Form No. 33.
For each additional patent	2 6	" "
56. On application for entry of notification of a document in the register of patents, if made within six months from date of document, the grant of the patent, or the coming into force of these Rules—		
In respect of one patent	1 0 0	Patents Form No. 34.
57. On application for entry of notification of a document in the register of patents, if made after expiration of six months from date of document, the grant of the patent and the coming into force of these Rules—		
In respect of one patent	10 0 0	Patents Form No. 34.
For each additional patent	2 6	" "
58. On request to Comptroller to correct a clerical error—		
Up to sealing	10 0	Patents Form No. 35.
After sealing	1 0 0	" "
59. For certificate of Comptroller under Section 78 .	10 0	Patents Form No. 36.
60. For duplicate of letters patent	2 0 0	Patents Form No. 37.
61. On notice to Comptroller of intended exhibition or publication of an invention under Section 45 .	1 0 0	Patents Form No. 38.
62. On notice of Order of Court for amendment of specification or rectification of register . .	10 0	Patents Form No. 39.
63. Inspection fee	1 0	
64. For office copies every 100 words (but never less than one shilling)	6	
65. For office copies of drawings, cost according to agreement		
66. For certifying office copies, MSS. or printed each	2 6	

A. C. Geddes,
President of the Board of Trade.

Dated the 25th day of February, 1920.

Approved :
James Parker,
J. Towyn Jones,
Lords Commissioners of
His Majesty's Treasury.

THE SECOND SCHEDULE.

FORMS.	Page.	Corresponding Fee.
Patents Form No. 1.—Application for Patent . . .	250	£1
„ No. 1A.—Application for Patent communicated from abroad . . .	252	£1
„ No. 1B.—Application for Patent under International and Colonial arrangements . . .	253	£1
„ No. 1B*.—Application for Patent by Legal Representatives or Assignees under International and Colonial Arrangements . . .	254	£1
„ No. 1C.—Application for Patent of Addition . . .	255	£1
„ No. 1C*.—Application for Patent of Addition under International and Colonial Arrangements . . .	256	£1
„ No. 1C**.—Application for Patent of Addition for Invention communicated from abroad . . .	257	£1
„ No. 1C*†.—Application for Patent of Addition by Legal Representatives or Assignees under International and Colonial Arrangements . . .	258	£1
„ No. 1C***.—Application for Patent of Addition . . .	259	£1
„ No. 1D.—Application for Secret Patent . . .	260	—
„ No. 2.—Provisional Specification . . .	261	—
„ No. 3.—Complete Specification . . .	262	£3
„ No. 4.—Appeal to Law Officer . . .	263	£3
„ No. 5.—Application for extension of Time under Rule 16 . . .	264	£2, £4, or £6
„ No. 6.—Application for extension of Time for leaving Complete Specification . . .	265	£2
„ No. 7.—Application for extension of Time for leaving an amended Specification under Rules 30 or 33 or notifying acceptance of alternative offered under Rules 31 or 34 . . .	266	Fee item 7
„ No. 8.—Application for extension of Time for acceptance of Complete Specification . . .	267	£2, £4, or £6
„ No. 9.—Application for the result of a search made under Sections 7 or 8 . . .	268	£1
„ No. 10.—Notice of Opposition to Grant of Patent . . .	269	£1
„ No. 11.—Notice that Hearing before the Comptroller will be attended . . .	270	£2
„ No. 12.—Notice of Desire to have Patent sealed . . .	271	£1

FORMS.	Page.	Corresponding Fee.
Patents Form No. 13.—Application for extension of Time for the sealing of a Patent . . .	272	£2, £4, or £6
„ No. 14.—Application for Certificate of Payment of Renewal Fee . . .	273	<i>Fee items 14 to 25</i>
„ No. 15.—Application for Enlargement of Time for Payment of Renewal Fee . . .	274	£2, £4, or £6
„ No. 16.—Application for the restoration of a lapsed Patent . . .	275	£20
„ No. 17.—Opposition to application for restoration of a lapsed Patent . . .	276	£1
„ No. 18.—Application for Amendment of Specification otherwise than under Rules 33 or 34 . . .	277	£1 10s. or £3
„ No. 19.—Opposition to Amendment of Specification . . .	278	£1
„ No. 20.—Request for indorsement of Patent “Licences of Right” . . .	279	£1
„ No. 21.—Application for refusal of request for indorsement of Patent “Licences of Right” . . .	280	£2
„ No. 22.—Application for settlement of terms of Licence under Patent indorsed “Licences of Right” . . .	281	£5
„ No. 23.—Application for cancellation of indorsement of a Patent “Licences of Right” . . .	282	£2
„ No. 24.—Opposition to cancellation of indorsement of a Patent “Licences of Right” . . .	283	£2
„ No. 25.—Application for Revocation of a Patent under Section 26 . . .	284	£2
„ No. 26.—Offer to Surrender a Patent . . .	285	£1
„ No. 27.—Application for Grant of Compulsory Licence or Revocation of a Patent under Section 27 . . .	286	£5
„ No. 28.—Request for Hearing under Section 27 (10) . . .	287	£2
„ No. 29.—Application for Licence under Section 38A(2) . . .	288	£5
„ No. 30.—Notice for Alteration of Name or Address or Address for Service in Register . . .	289	5s.
„ No. 31.—Request to enter two Addresses for Service in Register . . .	290	5s.
„ No. 32.—Application for entry of name of proprietor in Register . . .	291	<i>Fee items 52 & 53</i>
„ No. 33.—Application for entry of Notice of Mortgage or Licence in Register . . .	292	<i>Fee items 54 & 55</i>
„ No. 34.—Application for entry of Notification of Document in Register . . .	293	<i>Fee items 56 & 57</i>
„ No. 35.—Request for Correction of Clerical Error . . .	294	10s. or £1

FORMS.	Page.	Corresponding Fee.
Patents Form No. 36.—Request for Certificate of Comptroller	295	10s.
„ No. 37.—Application for Duplicate of Letters Patent	296	£2
„ No. 38.—Notice of Intended Exhibition or Publication of Unpatented Invention	297	£1
„ No. 39.—Application for Entry of Order of Court	298	10s.

PATENTS FORM NO. 1.

PATENT

£1

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 2 or of
Patents Form No. 3.)

APPLICATION FOR PATENT.

(a) Here insert (in
full) name, address,
and nationality of
applicant or
applicants.

(a) I (or we)—.....

.....

.....

.....

.....

.....do hereby....

declare that I am (or we are) in possession of an invention the

(b) Here insert title
of invention.

title of which is (b)

.....

.....

(c) State here who is
or are the inventor or
inventors.

that (c)

claim to be the true and first inventor thereof; that the same
is not in use by any other person or persons to the best of my
(or our) knowledge and belief; and I (or we) humbly pray that
a Patent may be granted to me (or us) for the said invention.

Dated the.....day of....., 19.....

(d) To be signed by
applicant or
applicants.

In the case of a Firm,
each member of
the Firm must sign.

(d).....

.....

.....

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

(1.) *Where application is made through a Solicitor, Patent Agent, or other person.*

I (or we) hereby appoint.....
of.....
to act for me (or us) as my (or our) Solicitor*
Agent in respect of the
within application for a Patent, and request that all notices,
requisitions, and communications relating thereto may be sent
to him or them at the above address.

Dated the.....day of....., 19.....

†.....
.....
.....
.....

† To be signed by
applicant or
applicants.

* The unnecessary words should be cancelled. The word "Agent" should be used only when a Patent Agent is employed. When a person other than a Solicitor or Registered Patent Agent is employed the words "as my (or our) Solicitor" should be struck through.
Agent

(2.) *Where application is made without an Agent (Rule 8).*

I (or we) hereby request that all notices, requisitions, and
communications in respect of the within application may be sent
to..... at.....

Dated the.....day of....., 19.....

*.....
.....
.....
.....

* To be signed by
applicant or
applicants.



PATENTS FORM NO. 1A.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3.)

PATENT

£1

**APPLICATION FOR PATENT FOR INVENTION
COMMUNICATED FROM ABROAD.**

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(a) I (or we)
of.....

.....do hereby declare that I am
(or we are) in possession of an invention the title of which is

(b) Here insert title of invention.

(b)

(c) Here insert name, address, and nationality of communicator

which invention has been communicated to me (or us) by (c)

.....
.....
.....
that I (or we) claim to be the true and first inventor thereof ;
and that the same is not in use within the United Kingdom of
Great Britain and Ireland and the Isle of Man by any other
person or persons to the best of my (or our) knowledge and
belief ; and I (or we) humbly pray that a Patent may be granted
to me (or us) for the said invention.

Dated the.....day of....., 19.....

(d) To be signed by applicant or applicants.

(d).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS FORM NO. 1B.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 3.)

PATENT

£1

**APPLICATION FOR PATENT UNDER INTERNATIONAL AND
COLONIAL ARRANGEMENTS.**

(a) I (or we)

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

do hereby declare that I (or we) have made applications for protection of my (or our) invention of (b)

(b) Here insert title of invention.

in the following Foreign States and on the following official dates, viz. : (c)

(c) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.

and in the following British Possessions and on the following official dates, viz. : (d)

(d) Here insert the name of each British Possession, followed by the official date of the application in each respectively.

that the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (e)

(e) Here insert the official date of the earliest foreign application.

to the best of my (or our) knowledge, and belief, and I (or we) humbly pray that a patent may be granted to me (or us) for the said invention in priority to other applicants, and that such patent shall have the date (f)

(f) Here insert the official date of the earliest foreign application.

(g).....

(g) Signature of applicant or of each of applicants.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.



PATENTS FORM NO. 1B.*

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 3.)

APPLICATION FOR PATENT BY LEGAL REPRESENTATIVES OR ASSIGNEES UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(a) I (or we)

.....
.....
.....do hereby declare that I am (we are)

(b) Here give name, address, and nationality of foreign applicant or applicants.

the legal representative of (b).....
..... deceased
or

(c) Here specify the particulars of such document, giving its date, and the parties to the same (in case of assignment), and showing how the claim here made is substantiated.

the assignee of (b).....
by virtue of (c).....
And I (or we) do hereby declare that (b).....
.....has (or have) made

(d) Here insert title of invention.

applications for protection of his (or their) invention of (d).....
in the following Foreign States and on the following official dates,
viz. : (e)

(e) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.

and in the following British Possessions and on the following official dates, viz. : (f).....

(f) Here insert the name of each British Possession, followed by the official date of the application in each respectively.

(g) Here insert the official date of the earliest foreign application.

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (g).....
to the best of my (or our) knowledge, and belief, and I (or we) humbly pray that a patent may be granted to me (or us) for the said invention in priority to other applicants, and that such patent shall have the date (h).....

(h) Here insert the official date of the earliest foreign application.

(i) Signature of applicant or applicants.

(i).....
.....
.....

*To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.*

PATENTS FORM No. 1c.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 2 or of
Patents Form No. 3.)

PATENT

£1

APPLICATION FOR PATENT OF ADDITION.

(a) I (or we),.....

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

....., do hereby....

declare that I am (or we are) in possession of an invention the
title of which is (b).....

(b) Here insert title of invention.

that (c).....claim to be the true and first
inventor...thereof; that the same is not in use by any other
person or persons to the best of my (or our) knowledge and belief,
and that the said invention is an improvement in or modification
of my (or our) invention for which a patent was applied for on
the....., and numbered....., [for which $\frac{\text{I was}}{\text{we were}}$ the applicant....]

(c) State here who is or are the inventor or inventors.

[of which $\frac{\text{I am}}{\text{we are}}$ the patentee....]; I (or we) humbly pray that a
patent may be granted to me (or us) for the said invention, and
request that the term limited in such further patent for the
duration thereof be the same as that of the original patent, or
so much of that term as is unexpired.

Dated the.....day of....., 19.....

(d).....

(d) To be signed by applicant or applicants.
In the case of a Firm, each member of the Firm must sign.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENT

£1

PATENTS FORM No. 1c.*

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 3.)

APPLICATION FOR PATENT OF ADDITION UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(a) Here insert (*in full*) name, address, and nationality of applicant or applicants.

(a) I (or we),.....

(b) Here insert title of invention.

do hereby declare that I (or we) have made applications for protection of my (or our) invention of (b),.....

(c) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.

in the following Foreign States and on the following official dates, viz. : (c)

(d) Here insert the name of each British Possession, followed by the official date of the application in each respectively.

and in the following British Possession and on the following official dates, viz. : (d)

(e) Here insert the official date of the earliest foreign application.

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (e)..... to the best of my (or our) knowledge, and belief, and that the said invention is an improvement in or modification of my (or our) invention for which a patent was applied for on the.....

and numbered....., [for which $\frac{\text{I was}}{\text{we were}}$ the applicant....] [of

which $\frac{\text{I am}}{\text{we are}}$ the patentee....]; and I (or we) humbly pray that a

(f) Here insert the official date of the earliest foreign application.

patent may be granted to me (or us) for the said invention in priority to other applicants, and that such patent shall have the date (f)..... and request that the term limited in such further patent for the duration thereof be the same as that of the original patent, or so much of that term as is unexpired.

(g) Signature of applicant or of applicants.

(g).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3.)

PATENT

£1

**APPLICATION FOR PATENT OF ADDITION FOR INVENTION
COMMUNICATED FROM ABROAD.**

(a) I (or we),.....

(a) Here insert (in full) name, address, and nationality of applicant of applicants.

....., do hereby
declare that I am (or we are) in possession of an invention the
title of which is (b).....

(b) Here insert title of invention.

which invention has been communicated to me (or us) by (c).....

(c) Here insert name, address, and nationality of communicator.

that I (or we) claim to be the true and first inventor...thereof;
that the same is not in use within the United Kingdom of Great
Britain and Ireland and the Isle of Man by any other person or
persons to the best of my (or our) knowledge and belief, and that
the said invention is an improvement in or modification of my (or
our) invention for which a patent was applied for on the.....,

and numbered....., [for which $\frac{\text{I was}}{\text{we were}}$ the applicant....]

[of which $\frac{\text{I am}}{\text{we are}}$ the patentee....]; and I (or we) humbly pray

that a patent may be granted to me (or us) for the said invention,
and request that the term limited in such further patent for the
duration thereof be the same as that of the original patent, or
so much of that term as is unexpired.

Dated the.....day of....., 19.....

(d).....

(d) To be signed by applicant or applicants.
In case of a Firm, each member of the Firm must sign.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENT

£1

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 3.)

APPLICATION FOR PATENT OF ADDITION BY LEGAL REPRESENTATIVES OR ASSIGNEES UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(b) Here give name, address, and nationality of foreign applicant or applicants.

(c) Here specify the particulars of such document, giving its date, and the parties to the same (in case of assignment), and showing how the claim here made is substantiated.

(d) Here insert title of invention.

(e) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.

(f) Here insert the name of each British Possession, followed by the official date of the application in each respectively.

(g) Here insert the official date of the earliest foreign application.

(h) Here insert the official date of the earliest foreign application.

(i) Signature of applicant or of applicants.

(a) I (or we)

.....do hereby declare that I am (we are) the legal representative of (b).....

..... deceased

or

the assignee of (b).....

by virtue of (c).....

And I (or we) do hereby declare that (b).....

.....has (or have) made applications for protection of his (or their) invention of (d).....

in the following Foreign States and on the following official dates, viz. : (e)

and in the following British Possessions and on the following official dates, viz. : (f)

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (g).....to the best of my (or our) knowledge, and belief, and that the said invention is an improvement in or modification of my (or our) invention for which a patent was applied for on the....., and numbered..... [for which I was (we were) the applicant....] [of which I am (we are) the patentee....]; and I (or we) humbly pray that a patent may be granted to me (or us) for the said invention in priority to other applicants, and that such patent shall have the date (h)....., and request that the term limited in such further patent for the duration thereof be the same as that of the original patent, or so much of that term as is unexpired.

(i).....

To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.
(To be accompanied by two copies of Patents Form No. 2 or of
Patents Form No. 3.)

APPLICATION FOR PATENT OF ADDITION.

PATENT

£1

(a) I (or we),.....
.....
.....
.....

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

....., do hereby
declare that I am (or we are) in possession of an invention the
title of which is (b).....
.....
.....

(b) Here insert title of invention.

that (c)..... claim to be the
true and first inventor.....thereof ; that the same is not in use by
any other person or persons to the best of my (or our) knowledge
and belief, and that the said invention is an improvement in or
modification of my (or our) invention, for which a patent (here-
inafter called the original patent) was applied for on the.....,

(c) State here who is or are the inventor or inventors.

and numbered....., [for which $\frac{\text{I was}}{\text{we were}}$ the applicant.....]

[of which $\frac{\text{I am}}{\text{we were}}$ the patentee.....], as improved upon or
modified by my (or our) invention for which a Patent of Addition
was applied for on the....., and numbered.....[for which

Patent of Addition $\frac{\text{I was}}{\text{we were}}$ the applicant....] [of which Patent of

Addition $\frac{\text{I am}}{\text{we are}}$ the patentee....]; and I (or we) humbly pray

that a patent may be granted to me (or us) for the said invention,
and request that the term limited in such further patent for
the duration thereof be the same as that of the original patent,
or so much of that term as is unexpired.

Dated the.....day of....., 19.....

(d).....
.....
.....
.....

(d) To be signed by applicant or applicants.
In case of a Firm, each member of the Firm must sign.

To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS FORM NO. 1D.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3, and a certificate under Section 30 (3).)

APPLICATION FOR A SECRET PATENT.

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(a) I (or we).....

.....
.....
.....

....., do hereby
declare that I am (or we are) in possession of an invention the

(b) Here insert title of invention.

title of which is (b).....

.....
.....

(c) State here who is or are the inventor or inventors.

that (c).....

claim to be the true and first inventor.....thereof ; and that the
same is not in use by any other person or persons to the best
of my (or our) knowledge and belief ; and I (or we) humbly pray
that a secret patent may be granted to me (or us) for the said
invention.

Dated the.....day of....., 19.....

(d) To be signed by applicant or applicants.
In the case of a Firm, each member of the Firm must sign.

(d).....

.....

.....

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS FORM No. 2.

To be issued with Patents Forms Nos. 1, 1A, 1C, 1C**, 1C*** or 1D.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a)..... (a) Here insert title
..... verbally agreeing
..... with that in the
..... application form.

(b) (I or we)..... (b) Here insert (in
..... full) name, address,
..... and nationality of
..... applicant or
..... applicants as in
..... application form

do hereby declare the nature of this invention to be as follows :

(c)..... (c) Here begin
..... description of the
..... nature of the
..... invention. The
..... continuation of the
..... specification should
..... be upon wide-ruled
..... paper of the same
..... size, on one side only,
..... with a margin of one
..... inch and a half on the
..... left hand part of the
..... paper. The
..... specification and
..... the duplicate thereof
..... must be signed at the
..... end, and dated (thus):
..... " Dated the
..... day of
..... 19 .."

PATENT

£5

Where provisional specification or specifications have been left, quote No. or Nos., and date or dates.

No. _____
Date _____

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(a) Here insert title verbally agreeing with that in the application form.

(a).....
.....
.....

(b) Here insert (in full) name, address, and nationality of applicant or applicants as in application form.

(b) I (or we).....
.....
.....
.....

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :

(c).....
.....
.....
.....
.....
.....
.....
.....
.....
.....

(c) Here begin full description of invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of one inch and a half on the left-hand part of the paper. The completion of the description should be followed by the words, "Having now particularly described and ascertained the nature of my (or our) said invention, and in what manner the same is to be performed, I (or we) declare that what I (or we) claim is," after which should be written the claim or claims numbered consecutively. The specification and the duplicate thereof must be signed at the end and dated (thus): "Dated the _____ day of _____, 19____."

NOTE.—In the preparation of the claim or claims careful attention should be paid to the terms of Rule 14 of the Patents Rules, 1920. Any unnecessary multiplicity of claims or prolixity of language should be avoided.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

APPEAL TO LAW OFFICER.

PATENT

£3

In the matter of an application by.....

for Letters Patent No.....of 19.....

and

In the matter of an opposition thereto by (a).....

(a) Here insert the name (or names) of the opponent (or opponents) when the application is opposed.

(b) I (or we).....

(b) Here insert name and full address of appellant or appellants.

hereby give notice of my (or our) intention to appeal to the Law

Officer from (c).....

(c) Here insert "the decision" or "that," part of the decision as the case may be.

of the.....dated the.....day of.....

19 , whereby he (d).....

(d) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

Signature.....

Date.....

NOTE.—This notice must be sent to the Comptroller at the Patent Office, London, W.C.2, and an unstamped copy of the same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

PATENTS FORM No. 5.

PATENT

£2, £4 or £6

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR EXTENSION OF TIME FOR LEAVING
COPY OR COPIES OF THE FOREIGN SPECIFICATION
OR SPECIFICATIONS, TRANSLATIONS, DRAWINGS, OR
DOCUMENTS UNDER RULE 16.**

I (or we) hereby apply for.....month extension of time
for leaving copy or copies of the foreign specification or speci-
fications, translations, drawings or documents under Rule 16 in
respect of application No.....of 1.....

(a) To be signed by
applicant or
applicants or his or
their agents.

(a).....
.....
.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM NO. 6.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

**APPLICATION FOR EXTENSION OF TIME FOR
LEAVING A COMPLETE SPECIFICATION.**

I (or we) hereby, in respect of application No.....
dated....., apply for one month's extension of time in
which to leave a complete specification.

(a).....

(a) To be signed by
applicant or
applicants or his
or their agent

.....

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENT

Fee : Item 7

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR EXTENSION OF TIME FOR LEAVING
AN AMENDED SPECIFICATION UNDER RULES 30 OR
33, OR NOTIFYING ACCEPTANCE OF ALTERNATIVE
OFFERED UNDER RULES 31 OR 34.**

I (or we) hereby apply for.....month.....

extension of time within which

(a) and (b) Strike out
the words which are
inapplicable.

(a) an amended specification may be left under Rules 30
or 33,

(b) agreement to the amendment of the specification or to
the insertion of a reference under Rules 31 or 34 may
be notified.

in connection with application No.....dated.....

(c) To be signed by
applicant or
applicants, or his or
their agent.

(c).....
.....
.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM NO. 8.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2, £4 or £6

**APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE
OF A COMPLETE SPECIFICATION.**

I (or we) hereby apply for.....month.....
extension of time for the acceptance of the Complete Specifica-
tion upon application No.....dated.....

(a).....

(a) To be signed by
applicant or
applicants or his or
their agent.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 9.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£1

**APPLICATION FOR THE RESULT OF A SEARCH MADE
UNDER SECTIONS 7 OR 8.**

I (or we) hereby request that I (or we) may be informed of the
result of the search made under the above Sections in connection
with Application for Patent No.....

(a).....

a) Here insert name
and full address to
which information is
to be sent.

To the Comptroller,

*The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.*

(This part to be filled in at the Patent Office.)

Result of a search made under Sections 7 or 8 of the Patents
and Designs Acts, 1907 and 1919, in connection with Application
for Patent No.....

Specifications cited under Section 7.	Specifications cited under Section 8.

Dated this.....day of....., 19.....

Comptroller-General.

NOTE.—Citations may be made during the examination of the
specification which are not relevant to the specification as
accepted. Citations under Section 7 are completed before
acceptance of the specification, but citations under Section 8
may be made subsequently.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

NOTICE OF OPPOSITION TO GRANT OF PATENT.

(To be accompanied by an unstamped copy and statement of case,
in duplicate.)

PATENT

£1

*I (or we).....

* Here state (in full) name and address.

hereby give notice of my (or our) intention to oppose the grant of
Letters Patent upon application No....., applied for by.....

upon the ground†.....

† Here state upon which of the grounds of opposition permitted by Sect. 11 of the Acts the grant is opposed.

My (or our) address for service in the United Kingdom is—

† To be signed by
opponent or
opponents.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 11.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

NOTICE THAT HEARING BEFORE THE COMPTROLLER
WILL BE ATTENDED.

(a) Here insert (in
full) name and
address.

(a) I (or we).....

hereby give notice that the hearing in reference to.....

.....will be attended by myself (or ourselves) or by

some person on my (or our) behalf.

(b) Signature.

(b).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 12.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£1

NOTICE OF DESIRE TO HAVE PATENT SEALED.

(a) I (or we) desire to have a patent sealed on my (or our) Application No. _____, and I (or we) hereby transmit the prescribed fee on sealing, and request that the following may be entered on the Register as my (or our) address for service—

(a) Here insert name of applicant or applicants.

(b).....
.....
(b) Signature of applicant or applicants or his or their agent.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2, £4 or £6

**APPLICATION FOR EXTENSION OF TIME FOR THE
SEALING OF A PATENT.**

I (or we) hereby apply for.....months' extension of time
for the sealing of a patent upon application No.....

The circumstances and grounds upon which this extension is
applied for are as follows (a)—

(a) The circum-
stances and grounds
must be stated in
detail.

.....
.....
.....
.....
.....
.....
.....

(b) To be signed by
the applicant or
applicants, or his or
their agent.

(b).....
.....
.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 14.

[When stamped this Form must be at once sent to or left at the
Patent Office.]

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR CERTIFICATE OF PAYMENT OF
RENEWAL FEE.**

PATENT

Fee : Items

14 to 25

I (or we) hereby transmit the fee for the continuation in force
of*.....Patent No....., of 1..... for a further * Here insert name
period of..... of patentee.

It is requested that the address for service of the patentee
in the United Kingdom shall be—
.....

Name†..... † Here insert name
Address and full address to
is to be sent.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

[This part of the Form to be filled in at the Patent Office.]

CERTIFICATE OF PAYMENT OF RENEWAL FEE.

Letters Patent No.....of 1.....

This is to certify that.....did this.....day
of.....19....., make the prescribed payment of £.....
in respect of a period of.....from.....and that by
virtue of such payment the rights of the patentee remain in force.*

* See Sect. 17 of the
Patents and Designs
Acts, 1907 and 1919.

Seal

The Patent Office, London.

PATENTS FORM No. 15.

PATENT

£2, £4 or £8

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR ENLARGEMENT OF TIME FOR
PAYMENT OF RENEWAL FEE.**

I (or we) hereby apply for an enlargement of time for.....
month in which to make the.....payment of.....
upon my (or our) Patent, No.....of 1.....

(b) Here insert
name and full
address to which
receipt is to be sent.

(b).....
.....
.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR THE RESTORATION OF A LAPSED
PATENT UNDER SECTION 20.**

PATENT

£20

I (or we) hereby apply for an Order of the Comptroller for the
restoration of Patent No.....dated.....

The circumstances which have led to the omission of the
payment of the fee of (a).....on or
before the (b).....are as follows : (c).....

(a) State amount
of fee.

(b) State last day
when fee was due.

(c) The circum-
stances must be
stated in detail.

My (or our) address for service in the United Kingdom is :

(d)..... (d) To be signed by
the applicant or
applicants.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£1

NOTICE OF OPPOSITION TO AN APPLICATION FOR THE
RESTORATION OF A Lapsed PATENT.

(To be accompanied by an unstamped copy and statement of case,
in duplicate.)

* Here state (in full)
name and address of
opponent or
opponents.

*I or (we).....

.....

.....

.....

.....

hereby give notice of opposition to the application for restoration

of Patent No.....dated.....for the

† Here state reason
of opposition;

following reason : †.....

.....

.....

.....

.....

.....

.....

My (or our) address for service in the United Kingdom is :

.....

† To be signed by
the opponent or
opponents.

†.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£1 10s. or £3.

APPLICATION FOR AMENDMENT OF SPECIFICATION
OTHERWISE THAN UNDER RULES 33 OR 34.

*I (or we).....
.....
.....
.....

* Here state (in full)
name and address
of applicant or
patentee.

seek leave to amend the specification of Letters Patent No.....
of 1....., as shown in red ink in the certified copy of the
original specification hereunto annexed.

†I (or we) declare that no action for infringement or pro-
ceedings before the Court for the revocation of the Letters
Patent in question is pending.

† These words are
to be struck out when
Letters Patent have
not been sealed.

My (or our) reasons for making this amendment are as follows†
.....
.....
.....
.....
.....

† Here state reasons
for seeking
amendment; and,
where the applicant
is not the patentee,
state what interest
he possesses in the
Letters Patent.

My (or our) address for service in the United Kingdom is—

§

§ To be signed by
applicant or
patentee.

To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

N.B.—No amendment is permissible that would make the
invention substantially larger or substantially different. See
Section 21 of the Acts.

NOTICE OF OPPOSITION TO AMENDMENT OF SPECIFICATION.

* Here state (in full) name and address of opponent or opponents.

*I (or we).....

[illegible]

hereby give notice of opposition to the proposed amendment of
the specification of Letters Patent No.....of 1.....for the
following reason: †.....

† Here state reason
of opposition.

This image shows a single sheet of white paper with horizontal blue or grey ruling lines. The lines are evenly spaced and run across the width of the page. There is no handwriting or other markings on the paper.

My (or our) address for service in the United Kingdom is—

‡ To be signed by
opponent or
opponents.

To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**REQUEST FOR INDORSEMENT OF PATENT "LICENCES OF
RIGHT."**

PATENT

£1

I (or we) hereby request that Patent No.....may be
indorsed "Licences of Right."

My (or our) address for service in the United Kingdom is—
.....

*

* To be signed by
the patentee or
patentees.

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

NOTE.—This form should be accompanied by a statutory
declaration, etc., as required by Rule 69.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

**APPLICATION FOR REFUSAL OF REQUEST FOR INDORSE-
MENT OF PATENT "LICENCES OF RIGHT."**

*(To be accompanied by an unstamped copy and a statement of case
in duplicate.)*

(a) Here insert (in
full) name, address,
and nationality of
applicant or
applicants.

(a) I (or we)

hereby declare that the request for the indorsement of Patent
No..... "Licences of Right" is contrary to a contract in
which I am (or we are) interested and I (or we) apply that such
request may be refused.

My (or our) address for service in the United Kingdom is—

(b) To be signed by
the applicant or
applicants.

(b).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

APPLICATION FOR SETTLEMENT OF TERMS OF LICENCE
UNDER PATENT INDORSED "LICENCES OF RIGHT."

PATENT

15

(To be accompanied by an unstamped copy and a statement of case
in duplicate.)

(a) I (or we)..... (a) Here insert (in
full) name, address,
and nationality of
applicant or
applicants.

hereby apply for settlement of the terms of a Licence to be
granted under Patent No.....(b) and request that an (b) Strike out these
words if
inapplicable.
Order may be made entitling me to surrender the licence
dated.....granted to me by the Patentee.

The Licence is applied for by (c)..... (c) Here insert full
name and address of
the applicant for
Licence, or strike out
the words if the
application is made
by the applicant for
the Licence.

(d)..... (d) To be signed by
patentee or applicant
for Licence.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM NO. 23.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

**APPLICATION FOR CANCELLATION OF INDORSEMENT OF
A PATENT "LICENCES OF RIGHT."**

I (or we).....

hereby apply that the indorsement of Patent No.....

"Licences of Right" may be cancelled, and I (or we) enclose
Patents Form No. 14 in respect of the unpaid moiety of all
renewal fees which have become due since the indorsement.

I (or we) declare that there is no existing licence under the
Patent.

My (or our) address for service is.....

.....

(a) To be signed by
the patentee or
patentees.

(a).....

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

**NOTICE OF OPPOSITION TO CANCELLATION OF INDORSE-
MENT OF A PATENT "LICENCES OF RIGHT."**

*(To be accompanied by an unstamped copy and statement of case
in duplicate.)*

I (or we)*.....

* Here state (in full)
name and address of
opponent or
opponents.

.....
.....
hereby give notice of opposition to the application for the
cancellation of the indorsement "Licences of Right" in respect
of Patent No.....

My (or our) address for service in the United Kingdom is—
.....

†.....

† To be signed by the
opponent or
opponents.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£2

**APPLICATION FOR THE REVOCATION OF A PATENT UNDER
SECTION 26.**

*(To be accompanied by an unstamped copy, and statement of case,
in duplicate.)*

* Here state (in full)
name and address of
applicant, or
applicants, for
revocation.

*I (or we).....

.....
.....
.....

hereby apply for an Order for the revocation of the Patent

No.....dated.....on the following grounds :

† The ground or
grounds of an
application for
revocation under
Sect. 26 of the Act
must be any one or
more of the grounds
on which the grant of
the patent might
have been opposed.

†
.....
.....
.....
.....
.....
.....

‡ If such an action is
pending in any
Court the application
cannot be made
without the leave of
the Court.

No action‡ for infringement or proceedings for the revocation
of the patent are pending.

My (or our) address for service in the United Kingdom is—

.....
.....

§ To be signed by the
applicant, or
applicants, for
revocation.

§.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

OFFER TO SURRENDER A PATENT UNDER SECTION 26.

PATENT

£1

*I (or we).....

* Here state (in full)
name and address of
patentee or
patentees.

hereby offer to surrender Patent No.....dated.....

No action† for infringement or proceedings for the revocation
of the patent are pending.

† If any action or
proceedings are
pending, state what
is their nature.

My (or our) reasons for making this offer are as follows—

My (or our) address for service in the United Kingdom is—

†.....

† To be signed by
the patentee or
patentees.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

£5

**APPLICATION FOR GRANT OF COMPULSORY LICENCE OR
REVOCATION OF A PATENT UNDER SECTION 27.**

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(a) I (or we).....

hereby declare that there has been an abuse of the monopoly rights under Patent No.....

* Here set out the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks.

*

.....

.....

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.....

.....

My (or our) address for service in the United Kingdom is—

.....

.....

† To be signed by the applicant or applicants.

†

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 28.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

REQUEST FOR HEARING UNDER SECTION 27 (10).

PATENT

£2

I (or we) hereby request that a hearing may be appointed in
connection with the application made under the provisions of
Section 27 in respect of Patent No.....

*
.....
.....

* To be signed by
the applicant (or
applicants), or his
(or their) agent.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM NO. 29.

PATENT

5a

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

APPLICATION FOR LICENCE UNDER SECTION 38A. (2).

(a) Here insert (in full) name, address, and nationality of applicant or applicants.

(a) I (or we).....

hereby apply for a licence under Patent No.....limited to the use of the invention for the purposes of the preparation or production of food or medicine.

(b) Here set out the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks.

(b).....

My (or our) address for service in the United Kingdom is—

(c) To be signed by the applicant or applicants.

(c).....

To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

5s

**NOTICE FOR ALTERATION OF A NAME OR AN ADDRESS
OR AN ADDRESS FOR SERVICE IN REGISTER OF
PATENTS.**

In the matter of Patent No.....

of.....

(a) I (or we).....

(a) Here state (in
full) name or names
and address of
applicant or
applicants.

hereby request that.....name, address [or.....address

for service] now upon the Register of Patents may be altered to

(b).....

(b) Here insert
name or full
address.

(c).....

(c) Signature of
applicant or
applicants.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 31.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

5s

**REQUEST FOR ENTRY OF TWO ADDRESSES FOR SERVICE
IN REGISTER OF PATENTS.**

In the matter of Patent No.....

of.....

a) Here state (in full) name or names and address of applicant or applicants.

(a) I (or we).....

.....
.....
.....
.....

hereby request that the two following addresses for service may
be entered in the Register of Patents—

(b) Here insert full addresses.

(b) (1)

.....

(2)

.....

(c) Signature of applicant or applicants.

(c).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

Fee: Items

52 & 53

**APPLICATION FOR ENTRY OF NAME OF PROPRIETOR OR
PART PROPRIETOR IN REGISTER OF PATENTS.**

(a) I (or we)..... (a) Here insert (in full) name, address, and nationality.

hereby apply that you will enter my (or our) name (or names)
in the Register of Patents as proprietor (or part proprietor) of
Patent No.....of 1 granted to (b)..... (b) Here give name and address of person to whom Patent was granted.

the title of which is (c)..... (c) Here insert title of the invention.

I (or we) claim to be so entitled by virtue of (d)..... (d) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

An in proof whereof I (or we) transmit the accompanying
(e)..... (e) Here insert the nature of the document.
with an attested copy thereof.

My (or our) address for service in the United Kingdom is—

(f)..... (f) Signature.
(g) (g) Here state in what capacity the signatory is acting.

*To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.*

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

Fee: Items

54 & 55

APPLICATION FOR ENTRY OF NOTICE OF A MORTGAGE
OR LICENCE IN REGISTER OF PATENTS.

(a) Here insert (in full) name, address, and nationality.

(a) I (or we).....

hereby apply that you will enter in the Register of Patents a notice of the following interest in a patent—

(b) Here insert the nature of the claim, whether by way of Mortgage or Licence.
(c) Here give name and address of person to whom Patent was granted.

I (or we) claim to be entitled (b).....
.....to an interest in
Patent No..... of 1....., granted to (c).....

(d) Here insert title of the invention.

the title of which is (d).....

(e) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

by virtue of (e).....

(f) Here insert the nature of the document.

And in proof whereof I (or we) transmit the accompanying (f).....with an attested copy thereof.

My (or our) address for service in the United Kingdom is—

(g) Signature.

(g)

(h) Here state in what capacity the signatory is acting.

(h)

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

PATENT

Fee: Items

56 & 57

**APPLICATION FOR ENTRY OF NOTIFICATION OF
DOCUMENT IN REGISTER OF PATENTS.**

I (or we) transmit herewith an attested copy of (a).....

(a) Here insert a description of the nature of the document, giving its date and the names, addresses and nationality of the parties thereto.

.....
.....
under Patent No.....of 1....., as well as the original document for verification, and I (or we) apply that a notification thereof may be entered in the Register.

(b).....

b) Signature.

(c).....

(c) Here insert full address of party benefiting under the document.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 35.

PATENT

10s. or £1

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

REQUEST FOR CORRECTION OF CLERICAL ERROR.

I (or we) hereby request that the following clerical error

(a) or errors.

(a).....

in the (b).....

No..... of 1....., may be corrected in the manner shown

(b) Here state
whether in applica-
tion, specification or
register.

in red ink in the certified copy of the original (b).....

hereunto annexed.

(c) Signature.

(c).....

(d) Address in full.

(d).....

.....

.....

*To the Comptroller,
The Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.2.*

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

REQUEST FOR CERTIFICATE OF COMPTROLLER.

PATENT

10s

In the matter of the Patent No.....

of 1.....

I (or we).....

of

hereby request you to furnish me (or us) with your Certificate

to the effect that (a).....

(a) Here set out the particulars which the Comptroller is requested to certify.

(b).....

(b) Name and full address to which Certificate is to be sent.

Dated the.....day of.....19.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1910.

PATENT

£2

APPLICATION FOR DUPLICATE OF LETTERS PATENT.

Date

* Here insert date, number, full name and address of grantee or grantees.

I (or we) regret to have to inform you that the Letters Patent dated*

No.

granted to

† Here insert title of invention.

for an invention the title of which is†

‡ Here insert the word "destroyed" or "lost," as the case may be, and state, in full, the circumstances of the case, which must be verified by statutory declaration.

has been‡

I (or we) beg therefore to apply for the issue of a duplicate of

§ Here state interest possessed by applicant or applicants in the Patent.

such Letters Patent.§

|| Signature of patentee or patentees.

.....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**NOTICE OF INTENDED EXHIBITION OR PUBLICATION OF
AN UNPATENTED INVENTION.**

PATENT

£1

*I (or we).....

* Here state (*in full*)
name and address of
applicant or
applicants.

hereby give notice of my (of our) intention

(a) to exhibit a.....of.....at the.....

(a) or (b) Strike out
words which are
inapplicable.

Exhibition, which†.....on the..... day of.....

† State "opened"
or "is to open."

19.....under the provisions of the Patents and Designs

Acts, 1907 and 1919.

(b) to publish my invention for.....

by reading a paper before.....

on the.....or

by permitting publication of the paper in the Society's

transactions.

‡ I (or we) herewith enclose a brief description of my (or our)
invention.....

‡ This description of
invention should be
accompanied by
drawings if
necessary.

†.....

† To be signed by
the applicant or
applicants.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

PATENTS FORM No. 39.

PATENT

10s

PATENTS AND DESIGNS ACTS, 1907 AND 1919.

**APPLICATION FOR ENTRY OF ORDER OF COURT IN
REGISTER.**

(a) Here state (in
full) name and
address of applicant
or applicants.

(a) I (or we).....

hereby transmit an office copy of an Order of the Court with

(b) Here state the
purport of the order.

reference to (b).....

(c) Signature.

(c).....

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.2.

FORM A.

THE THIRD SCHEDULE

FORM OF PATENT

GEORGE V., by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

WHEREAS
hath declared that he is in possession of an invention for

that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention:

And whereas We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, (*) may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of sixteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of sixteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:

(*) For forms of restricted grants, see Appendix V, p. 305.

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us and the same may be revoked and made void accordingly : Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided ; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained : Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted : And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the

one thousand nine hundred

and

Here is to be inserted the name of the Comptroller-General.

Comptroller-General of Patents, Designs, and Trade Marks.



FORM B.

FORM OF PATENT OF ADDITION

GEORGE V., by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India : To all to whom these presents shall come greeting :

WHEREAS
hath declared that he is in possession of an invention for

that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief, and that the said invention is an

improvement in or modification of his invention for which a patent was applied for on and numbered and on which a patent (hereinafter called the original patent) has been granted for which he was the applicant (or of which he is the patentee).

AND WHEREAS the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention :

AND WHEREAS the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention, and has requested that the term limited in such patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired :

AND WHEREAS We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request :

KNOW YE, THEREFORE, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of sixteen years from the day of being the date of the said original patent No. , or so much of that term as is unexpired.

AND to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned :

PROVIDED ALWAYS that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us, and the same may be revoked and made void accordingly : PROVIDED ALSO, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of the said original letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the



PATENTS FOR INVENTIONS

time being by law provided ; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained : PROVIDED ALSO that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted : AND lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

IN WITNESS whereof we have caused these our letters to
be made patent and to be sealed as of the one
thousand nine hundred and

* Here is to be inserted the name of the Comptroller-General.



Comptroller-General of Patents,
Designs, and Trade Marks.

Dated the 25th day of February, 1920.

A. C. Geddes,

President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file, in the Patent Office, a notice of such his intention.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the Chief Clerk, Law Officers' Department, at Room 549, Royal Courts of Justice, London; and, when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Chief Clerk, Law Officers' Department, all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal shall be given by the Chief Clerk, Law Officers' Department, unless special leave be given by the law officer that any shorter notice may be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless, in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of Section 40 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Law Officers' Department.

XIV. Any notice or other document required to be given to the Chief Clerk, Law Officers' Department, under these Rules, may be sent by a prepaid letter through the post.

John L. Walton,
Attorney-General.

W. S. Robson,
Solicitor-General.

Law Officers' Department,
11th December, 1907.

APPENDIX V

FORMS OF RESTRICTED GRANTS ARISING FROM WAR LEGISLATION AND REGULATIONS

(1) IN cases where the applicant has been granted an extension of time for filing his application or any other document under War Emergency Legislation, the usual form of grant set out in Appendix IV, p. 299, is followed, but with words intended to protect the rights of persons who may be in possession of the invention at the time of the grant and whose position would otherwise be prejudiced by the grant. Such cases include *inter alia* applications by nationals of the countries who were parties to the Berne Agreement of 1920 (*see* p. 140) and applications by citizens of the U.S.A. which, although not a party to the Berne Agreement, gave similar reciprocal rights to British applicants under the Nolan Act.

The Comptroller alone has a complete discretion as to the terms and conditions imposed and the limitations of the grant and the protection afforded to intervening inventors are governed by the terms and conditions inserted in the grant.

In most cases the following words have been inserted after the words "and no other,"^(a) viz. : "except such persons as may have been *bona fide* in possession of the invention before the date of application in this country (may at all times, etc.)."

In other cases and in special circumstances more specific terms and conditions have been imposed by the Comptroller in the exercise of his discretion^(b).

(2) In cases where priority of date has been obtained under the provisions of a Treaty of Peace, the terms and conditions under which the grant is made, and the protection afforded to intervening inventors, depends upon the interpretation of the terms of the Peace Treaty itself. In these cases the following words have been inserted in the usual form of grant on p. 299, after the words "and no others," viz. : "save such persons as are excepted by article of the Treaty of Peace with (may at all times, etc.)." The relevant article in the case of Germany is Article 308 and in the case of Austria, Article 260.

(a) *See* p. 299.

(b) Case 19(a).

APPENDIX VI

STATUTORY RULES AND ORDERS, 1919, No. 1517

PEACE, TREATY OF

THE TREATY OF PEACE ORDER, 1919

At the Court at Buckingham Palace, the 18th day of August, 1919.

PRESENT,

The King's Most Excellent Majesty in Council.

Whereas at Versailles on the twenty-eighth day of June, nineteen hundred and nineteen, a Treaty of Peace (hereinafter referred to as "the Treaty") was signed on behalf of His Majesty :

And whereas by the Treaty of Peace Act, 1919, it was provided that His Majesty might make such appointments, establish such offices, make such Orders in Council and do such things as appeared to him to be necessary for carrying out the Treaty, and for giving effect to any of the provisions of the Treaty, and that any Order in Council made under that Act might provide for the imposition by summary process or otherwise of penalties in respect of breaches of the provisions thereof :

And whereas the Treaty contained the Sections set out in the Schedule to this Order, and it is expedient that for giving effect to those Sections the provisions hereinafter contained should have effect :

And whereas by Treaty grant usage sufferance or other lawful means His Majesty has power and jurisdiction in British Protectorates, and is pleased by virtue and in exercise of the powers vested in Him by the Foreign Jurisdiction Act, 1890, or otherwise to extend the provisions of this Order to such Protectorates :

Now, therefore, His Majesty, by and with the advice of His Privy Council, is pleased to order, and it is hereby ordered, as follows—

1. The Sections of the Treaty set out in the Schedule to this Act shall have full force and effect as law, and for the purpose of carrying out the said Sections the following provisions shall have effect—

(i) There shall be established in the United Kingdom a Clearing Office under the control and management of such person (hereinafter referred to as the Controller) as the Board of Trade may appoint for the purpose, and there shall be attached thereto such officers and servants as the Board of Trade, subject to the consent of the Treasury as to number, may determine, and there shall be paid to the Controller and to such officers and servants such salaries or other remuneration as the Treasury may determine.

In the event of a local office being established in any part of His Majesty's dominions outside the United Kingdom or in any Protectorate, the provisions relating to the Clearing Office hereinafter contained shall apply thereto for the purpose of the functions authorized to be performed by a local Clearing Office under paragraph 1 of the Annex to Section III. of Part X. of the Treaty.

(ii) It shall not be lawful for any person to pay or accept payment of any enemy debt except in cases where recovery thereof in a court of law is allowed as hereinafter provided, otherwise than through the Clearing Office, and no person interested in any such debt as debtor or creditor shall have any communications with any other person interested therein as creditor or debtor except through or by leave of the Clearing Office, and if any person contravenes this provision he shall be guilty of an offence and liable to be proceeded against and punished as if he had been guilty of the offence of trading with the enemy, and section one of the Trading with the Enemy Act, 1914, shall apply accordingly.

(iii) It shall not be lawful for any person to take proceedings in any court for the recovery of any enemy debt except in the circumstances provided under paragraphs 16, 23 and 25 of the Annex to the said Section III.

(iv) The Clearing Office shall have power to enforce the payment of any enemy debt against the person by whom the debt is due, together with such interest as is payable under paragraph 22 of the Annex to the said Section III, and for that purpose shall have all such rights and powers as if they were the creditor; and if the debt has been admitted by the debtor or the debt or amount thereof has been found by arbitration or by the Mixed Arbitral Tribunal or by a court of law in manner provided by paragraph 16 of the Annex to the said Section III, the Clearing Office may certify the amount so admitted or found due, and on production to the proper officer of the Supreme Court of the part of His Majesty's Dominions or the Protectorate in which the debtor resides of such certificate, the certificate shall be registered by that officer and shall from the date of such registration be of the same force and effect, and all proceedings may be taken thereon, as if the certificate were a judgment obtained in that court for the recovery of a debt of the amount specified in the certificate and entered upon the date of such registration, and all reasonable costs and charges attendant upon the registration of such certificate shall be recoverable in like manner as if they were part of such judgment.

(v) It shall be lawful for the Clearing Office to recover from any person by whom a fine is payable under paragraph 10 of the Annex to the said Section III the amount of such fine.

(vi) It shall be lawful for the Clearing Office to deduct from any sum payable by the Clearing Office to a creditor such commission, not exceeding two-and-a-half per cent of the amount payable, as may be fixed by the Clearing Office.

(vii) If any creditor refuses or fails to give such notice or to furnish such documents or information as are mentioned in paragraph 5 of the Annex to the said Section III he shall, on summary conviction, be liable to a fine not exceeding ten pounds.

(viii) If any person collusively gives notice of or admits any debt which is not due, or furnishes any false information with respect to any debt, he shall, on summary conviction, be liable to a fine not exceeding one hundred pounds or to imprisonment for a term not exceeding three months or to both such imprisonment and fine.

(ix) If His Majesty so agrees with any of the other Allied or Associated Powers the provisions of this Order, so far as they relate to enemy debts, shall apply to debts due to or from the nationals of that Power resident in any part of His Majesty's Dominions or Protectorates in like manner as they apply to debts due to or from British nationals so resident.

(x) Proceedings by and on behalf of the Clearing Office may be taken

by and in the name of the Controller of the Clearing Office, who may by that name sue and be sued, and costs may be awarded to or against the Controller.

(xi) Every document purporting to be an order or other instrument issued by the Clearing Office and to be signed by the Controller or by the secretary or other person authorized by the Controller shall be received in evidence and shall be deemed to be such order or instrument without further proof unless the contrary is shown.

(xii) A certificate signed by the Controller that an order or other instrument purporting to be made or issued by the Clearing Office is so made or issued shall be conclusive evidence of the facts so certified.

(xiii) The Documentary Evidence Act, 1868, as amended by any subsequent enactment, shall apply to the Clearing Office in like manner as if the Clearing Office were mentioned in the first column of the First Schedule to that Act, and as if the Controller or Secretary of the Clearing Office or any person authorized by the Controller to act on his behalf were mentioned in the second column of that Schedule, and as if the regulations referred to in that Act included any documents issued by or on behalf of the Clearing Office.

(xiv) All decisions of the Mixed Arbitral Tribunal constituted under Section VI of Part X of the Treaty, if within the jurisdiction of that tribunal, shall be final and conclusive and binding on all courts.

(xv) For the purpose of enforcing the attendance of witnesses before the Mixed Arbitral Tribunal, wherever sitting, whether within or without His Majesty's Dominions, and compelling the production before the tribunal of documents, a Secretary of State shall have power to issue orders which shall have the like effect as if the proceedings before the tribunal were an action in a court and the order were a formal process issued by that court in the due exercise of its jurisdiction, and shall be enforceable by that court accordingly, and disobedience to any such order shall be punishable as contempt of court.

(xvi) All property, rights and interests within His Majesty's Dominions or Protectorates belonging to German nationals at the date when the Treaty comes into force (not being property rights or interests acquired under any general licence issued by or on behalf of His Majesty), and the net proceeds of their sale, liquidation or other dealings therewith, are hereby charged—

(a) in the first place, with payment of the amounts due in respect of claims by British nationals with regard to their property, rights and interests, including companies and associations in which they are interested in German territory, or debts owing to them by German nationals, and with payment of any compensation awarded by the Mixed Arbitral Tribunal, or by an arbitrator appointed by that Tribunal in pursuance of paragraph (e) of Article 297, and with payment of claims growing out of acts committed by the German Government or by German authorities since the thirty-first day of July, and before the fourth day of August, nineteen hundred and fourteen; and

(b) secondly, with payment of the amounts due in respect of claims by British nationals with regard to their property, rights and interests in the territories of Austria-Hungary, Bulgaria and Turkey, in so far as those claims are not otherwise satisfied.

Provided that any particular property rights or interests so charged may at any time, if His Majesty thinks fit, be released from the charge so created.

(xvii) With a view to making effective and enforcing such charge as aforesaid—

(a) no person shall, without the consent of the Custodian, transfer, part with or otherwise deal in any property, right or interest subject to the charge, and if he does so he shall be liable on summary conviction to a fine not exceeding one hundred pounds or to imprisonment for a term not exceeding three months or to both such imprisonment and fine ;

(b) every person owning or having the control or management of any property right or interest subject to the charge (including where the property right or interest consists of shares stocks or other securities issued by a company municipal authority or other body or any right or interest therein such company authority or body) shall, unless particulars thereof have already been furnished to the Custodian in accordance with the Trading with the Enemy Acts 1914 to 1918, within one month from the date when this Order comes into operation by notice in writing communicate the fact to the Custodian, and shall furnish the Custodian with such particulars in relation thereto as the Custodian may require, and if any person fails to do so he shall on summary conviction be liable to a fine not exceeding one hundred pounds ;

(c) where the property charged consists of inscribed or registered stock, shares or other securities, any company, municipal authority or other body by whom the securities were issued or are managed shall, on application being made by the Custodian, enter the Custodian in the books in which the securities are inscribed or registered as the proprietor of the securities subject to the charge, and the Custodian shall, subject to the consent of the Board of Trade, have power to sell or otherwise deal with the securities as proprietor of which he is so registered or inscribed ;

(d) the Board of Trade may by order vest in the Custodian any property, rights and interests subject to the charge, or the right to transfer the same, and for that purpose Section four of the Trading with the Enemy (Amendment) Act, 1916, shall apply as if such property, rights and interests were property belonging to an enemy or enemy subject ;

(e) if any person called upon to pay any money or to transfer or otherwise to deal with any property rights or interests has reason to suspect that the same are subject to such charge as aforesaid he shall before paying transferring or dealing with the same report the matter to the Custodian and shall comply with any directions that the Custodian may give with respect thereto.

(xviii) The time at which the period of prescription or limitation of right of action referred to in Article 300 shall begin again to run shall be at the expiration of six months after the coming into force of the Treaty, and the period to be allowed within which presentation of negotiable instruments for acceptance or payment and notice of non-acceptance or non-payment or protest may be made under Article 300 shall be six months from the coming into force of the Treaty.

(xix) Rules made during the war by any recognized Exchange or Commercial Association providing for the closure of contracts entered into before the war by an enemy and any action taken thereunder are hereby confirmed subject to the provisos contained in paragraph 4 (a) of the Annex to Section V of Part X of the Treaty.

(xx) There shall be imposed on rights of industrial, literary or artistic property (with the exception of trade marks) acquired before or during the

war, or which may be acquired hereafter, by German nationals, such limitations, conditions or restrictions as the Board of Trade may prescribe, for the purpose, in the manner, in the circumstances, and subject to the limitations, contained in Article 306 of the Treaty, and any transfer in whole or in part or other dealing with any rights so acquired as aforesaid effected since the first day of August, nineteen hundred and fourteen, shall if and so far as it is inconsistent with any limitations conditions or restrictions so imposed be void and of no effect.

(xxi) So far as may be necessary for the purpose of Article 307 the Patents, Designs, and Trade Marks (Temporary Rules) Act, 1914 (except paragraph (b) of Section one of the Patents, Designs, and Trade Marks (Temporary Rules) (Amendment) Act, 1914), shall in relation to German nationals continue in force after the Treaty comes into force as if references therein to subjects of a State at war with His Majesty included references to German nationals.

(xxii) The duly qualified tribunal for the purposes of Article 310 of the Treaty shall be the Comptroller-General of Patents, Designs and Trade Marks.

2. For the purposes of this Order—

The expression "enemy debt" has the meaning assigned to it by paragraph 2 of the Annex to Section III of Part X of the Treaty, and includes any sum which under the Treaty is to be treated or dealt with in like manner as an enemy debt :

The expression "nationals" in relation to any State includes the subjects or citizens of that State and any company or corporation incorporated therein according to the law of that State and in the case of a Protectorate the natives thereof :

The expression "Custodian" means the Custodian of enemy property appointed under the Trading with the Enemy (Amendment) Act, 1914.

The Interpretation Act, 1889, applies for the interpretation of this Order in like manner as it applies for the interpretation of an Act of Parliament, and as if this Order were an Act of Parliament.

3. This Order shall apply to the whole of His Majesty's Dominions and Protectorates, except the Dominion of Canada, the Commonwealth of Australia (which for this purpose shall be deemed to include Papua and Norfolk Island), the Union of South Africa, the Dominion of New Zealand, Newfoundland and India, but in its application to the parts of His Majesty's Dominions outside the United Kingdom and to British Protectorates shall be subject to such modifications as may be made by the legislatures of those parts or those Protectorates for adapting to the circumstances thereof the provisions of this Order.

Provided that such of the provisions of this Order as give effect to Section III of Part X of the Treaty shall not apply to Egypt.

4. This Order shall come into operation on the date when the Treaty of Peace comes into force, but so much of this Order as relates to Section III of Part X of the Treaty and the Annex to that section shall cease to be in operation after the expiration of one month from the deposit of the ratifications of the Treaty by His Majesty, unless in the meantime the notification referred to in paragraph (e) of Article 296 has been given to Germany by His Majesty.

5. This Order may be cited as the Treaty of Peace Order, 1919.

Almeric FitzRoy.

Schedule.

SECTIONS III TO VII OF PART X OF THE TREATY.

SECTION III.—DEBTS.

ARTICLE 296.

There shall be settled through the intervention of clearing offices to be established by each of the High Contracting Parties within three months of the notification referred to in paragraph (e) hereafter the following classes of pecuniary obligations:

1. Debts payable before the war and due by a national of one of the Contracting Powers, residing within its territory, to a national of an Opposing Power, residing within its territory.

2. Debts which became payable during the war to nationals of one Contracting Power residing within its territory and arose out of transactions or contracts with the nationals of an Opposing Power, resident within its territory, of which the total or partial execution was suspended on account of the declaration of war.

3. Interest which has accrued due before and during the war to a national of one of the Contracting Powers in respect of securities issued by an Opposing Power, provided that the payment of interest on such securities to the nationals of that Power or to neutrals has not been suspended during the war.

4. Capital sums which have become payable before and during the war to nationals of one of the Contracting Powers in respect of securities issued by one of the Opposing Powers, provided that the payment of such capital sums to nationals of that Power or to neutrals has not been suspended during the war.

The proceeds of liquidation of enemy property, rights, and interests mentioned in Section IV and in the Annex thereto will be accounted for through the clearing offices, in the currency and at the rate of exchange hereinafter provided in paragraph (d) and disposed of by them under the conditions provided by the said Section and Annex.

The settlements provided for in this Article shall be effected according to the following principles and in accordance with the Annex to this Section—

(a) Each of the High Contracting Parties shall prohibit, as from the coming into force of the present Treaty, both the payment and the acceptance of payment of such debts, and also all communications between the interested parties with regard to the settlement of the said debts otherwise than through the clearing offices.

(b) Each of the High Contracting Parties shall be respectively responsible for the payment of such debts due by its nationals, except in the cases where before the war the debtor was in a state of bankruptcy or failure, or had given formal indication of insolvency or where the debt was due by a company whose business has been liquidated under emergency legislation during the war. Nevertheless, debts due by the inhabitants of territory invaded or occupied by the enemy before the Armistice will not be guaranteed by the States of which those territories form part.

(c) The sums due to the nationals of one of the High Contracting Parties by the nationals of an Opposing State will be debited to the clearing office of the country of the debtor, and paid to the creditor by the clearing office of the country of the creditor.

(d) Debts shall be paid or credited in the currency of such one of the Allied and Associated Powers, their colonies or protectorates, or the British

Dominions or India, as may be concerned. If the debts are payable in some other currency they shall be paid or credited in the currency of the country concerned, whether an Allied or Associated Power, Colony, Protectorate, British Dominion or India, at the pre-war rate of exchange.

For the purpose of this provision the pre-war rate of exchange shall be defined as the average cable transfer rate prevailing in the Allied or Associated country concerned during the month immediately preceding the outbreak of war between the said country concerned and Germany.

If a contract provides for a fixed rate of exchange governing the conversion of the currency in which the debt is stated into the currency of the Allied or Associated country concerned, then the above provisions concerning the rate of exchange shall not apply.

In the case of new States the currency in which and the rate of exchange at which debts shall be paid or credited shall be determined by the Reparation Commission provided for in Part VIII (Reparation).

(e) The provisions of this Article and of the Annex hereto shall not apply as between Germany on the one hand and any one of the Allied and Associated Powers, their colonies or protectorates, or any one of the British Dominions or India on the other hand, unless within a period of one month from the deposit of the ratifications of the present Treaty by the Power in question, or of the ratification on behalf of such Dominion or of India, notice to that effect is given to Germany by the Government of such Allied or Associated Power or of such Dominion or of India as the case may be.

(f) The Allied and Associated Powers who have adopted this Article and the Annex hereto may agree between themselves to apply them to their respective nationals established in their territory so far as regards matters between their nationals and German nationals. In this case the payments made by application of this provision will be subject to arrangements between the allied and associated clearing offices concerned.

ANNEX.

1. Each of the High Contracting Parties will, within three months from the notification provided for in Article 296, paragraph (e), establish a clearing office for the collection and payment of enemy debts.

Local clearing offices may be established for any particular portion of the territories of the High Contracting Parties. Such local clearing offices may perform all the functions of a central clearing office in their respective districts, except that all transactions with the clearing office in the Opposing State must be effected through the central clearing office.

2. In this Annex the pecuniary obligations referred to in the first paragraph of Article 296 are described as "enemy debts," the persons from whom the same are due as "enemy debtors," the persons to whom they are due as "enemy creditors," the clearing office in the country of the creditor is called the "Creditor Clearing Office," and the clearing office in the country of the debtor is called the "Debtor Clearing Office."

3. The High Contracting Parties will subject contraventions of paragraph (a) of Article 296 to the same penalties as are at present provided by their legislation for trading with the enemy. They will similarly prohibit within their territory all legal process relating to payment of enemy debts, except in accordance with the provisions of this Annex.

4. The Government guarantee specified in paragraph (b) of Article 296 shall take effect whenever, for any reason, a debt shall not be recoverable, except in a case where at the date of the outbreak of war the debt was barred by the laws of prescription in force in the country of the debtor, or where the debtor was at that time in a state of bankruptcy or failure or had given

formal indication of insolvency, or where the debt was due by a company whose business had been liquidated under emergency legislation during the war. In such case the procedure specified by this Annex shall apply to payment of the dividends.

The terms "bankruptcy" and "failure" refer to the application of legislation providing for such juridical conditions. The expression "formal indication of insolvency" bears the same meaning as it has in English law.

5. Creditors shall give notice to the Creditor Clearing Office within six months of its establishment of debts due to them, and shall furnish the Clearing Office with any documents and information required of them.

The High Contracting Parties will take all suitable measures to trace and punish collusion between enemy creditors and debtors. The clearing offices will communicate to one another any evidence and information which might help the discovery and punishment of such collusion.

The High Contracting Parties will facilitate as much as possible postal and telegraphic communication at the expense of the parties concerned and through the intervention of the clearing offices between debtors and creditors desirous of coming to an agreement as to the amount of their debt.

The Creditor Clearing Office will notify the Debtor Clearing Office of all debts declared to it. The Debtor Clearing Office will, in due course, inform the Creditor Clearing Office which debts are admitted and which debts are contested. In the latter case, the Debtor Clearing Office will give the grounds for the non-admission of debt.

6. When a debt has been admitted, in whole or in part, the Debtor Clearing Office will at once credit the Creditor Clearing Office with the amount admitted, and at the same time notify it of such credit.

7. The debt shall be deemed to be admitted in full and shall be credited forthwith to the Creditor Clearing Office unless within three months from the receipt of the notification or such longer time as may be agreed to by the Creditor Clearing Office notice has been given by the Debtor Clearing Office that it is not admitted.

8. When the whole or part of a debt is not admitted the two clearing offices will examine into the matter jointly and will endeavour to bring the parties to an agreement.

9. The Creditor Clearing Office will pay to the individual creditor the sums credited to it out of the funds placed at its disposal by the Government of its country and in accordance with the conditions fixed by the said Government, retaining any sums considered necessary to cover risks, expenses or commissions.

10. Any person having claimed payment of an enemy debt which is not admitted in whole or in part shall pay to the clearing office, by way of fine, interest at 5 per cent on the part not admitted. Any person having unduly refused to admit the whole or part of a debt claimed from him shall pay, by way of fine, interest at 5 per cent on the amount with regard to which his refusal shall be disallowed.

Such interest shall run from the date of expiration of the period provided for in paragraph 7 until the date on which the claim shall have been disallowed or the debt paid.

Each clearing office shall, in so far as it is concerned, take steps to collect the fines above provided for, and will be responsible if such fines cannot be collected.

The fines will be credited to the other clearing office, which shall retain them as a contribution towards the cost of carrying out the present provisions.

11. The balance between the clearing offices shall be struck monthly and the credit balance paid in cash by the debtor State within a week.

Nevertheless, any credit balances which may be due by one or more of the Allied and Associated Powers shall be retained until complete payment

shall have been effected of the sums due to the Allied or Associated Powers or their nationals on account of the war.

12. To facilitate discussion between the clearing offices each of them shall have a representative at the place where the other is established.

13. Except for special reasons all discussion in regard to claims will, so far as possible, take place at the Debtor Clearing Office.

14. In conformity with Article 296, paragraph (b), the High Contracting Parties are responsible for the payment of the enemy debts owing by their nationals.

The Debtor Clearing Office will therefore credit the Creditor Clearing Office with all debts admitted, even in case of inability to collect them from the individual debtor. The Governments concerned will, nevertheless, invest their respective clearing offices with all necessary powers for the recovery of debts which have been admitted.

As an exception, the admitted debts owing by persons having suffered injury from acts of war shall only be credited to the Creditor Clearing Office when the compensation due to the person concerned in respect of such injury shall have been paid.

15. Each Government will defray the expenses of the clearing office set up in its territory, including the salaries of the staff.

16. Where the two clearing offices are unable to agree whether a debt claimed is due, or in case of a difference between an enemy debtor and an enemy creditor or between the clearing offices, the dispute shall either be referred to arbitration, if the parties so agree under conditions fixed by agreement between them, or referred to the Mixed Arbitral Tribunal provided for in Section VI hereafter.

At the request of the Creditor Clearing Office the dispute may, however, be submitted to the jurisdiction of the Courts of the place of domicile of the debtor.

17. Recovery of sums found by the Mixed Arbitral Tribunal, the Court, or the Arbitration Tribunal to be due shall be effected through the clearing offices as if these sums were debts admitted by the Debtor Clearing Office.

18. Each of the Governments concerned shall appoint an agent who will be responsible for the presentation to the Mixed Arbitral Tribunal of the cases conducted on behalf of its clearing office. This agent will exercise a general control over the representatives or counsel employed by its nationals.

Decisions will be arrived at on documentary evidence, but it will be open to the Tribunal to hear the parties in person, or according to their preference by their representatives approved by the two Governments, or by the agent referred to above, who shall be competent to intervene along with the party or to re-open and maintain a claim abandoned by the same.

19. The clearing offices concerned will lay before the Mixed Arbitral Tribunal all the information and documents in their possession, so as to enable the Tribunal to decide rapidly on the cases which are brought before it.

20. Where one of the parties concerned appeals against the joint decision of the two clearing offices he shall make a deposit against the costs, which deposit shall only be refunded when the first judgment is modified in favour of the appellant and in proportion to the success he may attain, his opponent in case of such a refund being required to pay an equivalent proportion of the costs and expenses. Security accepted by the Tribunal may be substituted for a deposit.

A fee of 5 per cent of the amount in dispute shall be charged in respect of all cases brought before the Tribunal. This fee shall, unless the Tribunal directs otherwise, be borne by the unsuccessful party. Such fee shall be added to the deposit referred to. It is also independent of the security.

The Tribunal may award to one of the parties a sum in respect of the expenses of the proceedings.

Any sum payable under this paragraph shall be credited to the clearing office of the successful party as a separate item.

21. With a view to the rapid settlement of claims, due regard shall be paid in the appointment of all persons connected with the clearing offices or with the Mixed Arbitral Tribunal to their knowledge of the language of the other country concerned. Each of the clearing offices will be at liberty to correspond with the other, and to forward documents in its own language.

22. Subject to any special agreement to the contrary between the Governments concerned, debts shall carry interest in accordance with the following provisions—

Interest shall not be payable on sums of money due by way of dividend, interest, or other periodical payments which themselves represent interest on capital.

The rate of interest shall be 5 per cent per annum except in cases where, by contract, law, or custom, the creditor is entitled to payment of interest at a different rate. In such cases the rate to which he is entitled shall prevail.

Interest shall run from the date of commencement of hostilities (or, if the sum of money to be recovered fell due during the war, from the date at which it fell due) until the sum is credited to the clearing office of the creditor.

Sums due by way of interest shall be treated as debts admitted by the clearing offices and shall be credited to the Creditor Clearing Office in the same way as such debts.

23. Where by decision of the clearing offices or the Mixed Arbitral Tribunal a claim is held not to fall within Article 296, the creditor shall be at liberty to prosecute the claim before the Courts or to take such other proceedings as may be open to him.

The presentation of a claim to the clearing office suspends the operation of any period of prescription.

24. The High Contracting Parties agree to regard the decisions of the Mixed Arbitral Tribunal as final and conclusive, and to render them binding upon their nationals.

25. In any case where a Creditor Clearing Office declines to notify a claim to the Debtor Clearing Office, or to take any step provided for in this Annex, intended to make effective in whole or in part a request of which it has received due notice, the enemy creditor shall be entitled to receive from the clearing office a certificate setting out the amount of the claim, and shall then be entitled to prosecute the claim before the Courts or to take such other proceedings as may be open to him.

SECTION IV.—PROPERTY, RIGHTS AND INTERESTS.

ARTICLE 297.

The question of private property, rights and interests in an enemy country shall be settled according to the principles laid down in this Section and to the provisions of the Annex hereto—

(a) The exceptional war measures and measures of transfer (defined in paragraph 3 of the Annex hereto) taken by Germany with respect to the property, rights and interests of nationals of Allied or Associated Powers, including companies and associations in which they are interested, when liquidation has not been completed, shall be immediately discontinued or stayed and the property, rights, and interests concerned restored to their owners, who shall enjoy full rights therein in accordance with the provisions of Article 298.

(b) Subject to any contrary stipulations which may be provided for in the present Treaty, the Allied and Associated Powers reserve the right to retain and liquidate all property, rights, and interests belonging at the date of the coming into force of the present Treaty to German nationals, or

companies controlled by them, within their territories, colonies, possessions and protectorates, including territories ceded to them by the present Treaty.

The liquidation shall be carried out in accordance with the laws of the Allied or Associated State concerned, and the German owner shall not be able to dispose of such property, rights, or interests nor to subject them to any charge without the consent of that State.

German nationals who acquire *ipso facto* the nationality of an Allied or Associated Power in accordance with the provisions of the present Treaty will not be considered as German nationals within the meaning of this paragraph.

(c) The price or the amount of compensation in respect of the exercise of the right referred to in the preceding paragraph (b) will be fixed in accordance with the methods of sale or valuation adopted by the laws of the country in which the property has been retained or liquidated.

(d) As between the Allied and Associated Powers or their nationals on the one hand and Germany or her nationals on the other hand, all the exceptional war measures, or measures of transfer, or acts done or to be done in execution of such measures as defined in paragraphs 1 and 3 of the Annex hereto shall be considered as final and binding upon all persons except as regards the reservations laid down in the present Treaty.

(e) The nationals of Allied and Associated Powers shall be entitled to compensation in respect of damage or injury inflicted upon their property, rights, or interests, including any company or association in which they are interested, in German territory as it existed on 1st August, 1914, by the application either of the exceptional war measures or measures of transfer mentioned in paragraphs 1 and 3 of the Annex hereto. The claims made in this respect by such nationals shall be investigated, and the total of the compensation shall be determined by the Mixed Arbitral Tribunal provided for in Section VI or by an Arbitrator appointed by that Tribunal. This compensation shall be borne by Germany, and may be charged upon the property of German nationals within the territory or under the control of the claimant's State. This property may be constituted as a pledge for enemy liabilities under the conditions fixed by paragraph 4 of the Annex hereto. The payment of this compensation may be made by the Allied or Associated State, and the amount will be debited to Germany.

(f) Whenever a national of an Allied or Associated Power is entitled to property which has been subjected to a measure of transfer in German territory and expresses a desire for its restitution, his claim for compensation in accordance with paragraph (e) shall be satisfied by the restitution of the said property if it still exists in specie.

In such case Germany shall take all necessary steps to restore the evicted owner to the possession of his property, free from all encumbrances or burdens with which it may have been charged after the liquidation, and to indemnify all third parties injured by the restitution.

If the restitution provided for in this paragraph cannot be effected, private agreements arranged by the intermediation of the Powers concerned or the clearing offices provided for in the Annex to Section III may be made, in order to secure that the national of the Allied or Associated Power may secure compensation for the injury referred to in paragraph (e) by the grant of advantages or equivalents which he agrees to accept in place of the property, rights, or interests of which he was deprived.

Through restitution in accordance with this Article, the price or the amount of compensation fixed by the application of paragraph (e) will be reduced by the actual value of the property restored, account being taken of compensation in respect of loss of use or deterioration.

(g) The rights conferred by paragraph (f) are reserved to owners who

are nationals of Allied or Associated Powers within whose territory legislative measures prescribing the general liquidation of enemy property, rights, or interests were not applied before the signature of the Armistice.

(h) Except in cases where, by application of paragraph (f), restitutions in specie have been made, the net proceeds of sales of enemy property, rights or interests, wherever situated, carried out, either by virtue of war legislation, or by application of this Article, and in general all cash assets of enemies, shall be dealt with as follows—

(1) As regards Powers adopting Section III and the Annex thereto, the said proceeds and cash assets shall be credited to the Power of which the owner is a national, through the clearing office established thereunder; any credit balance in favour of Germany resulting therefrom shall be dealt with as provided in Article 243.

(2) As regards Powers not adopting Section III and the Annex thereto, the proceeds of the property, rights and interests, and the cash assets, of the nationals of Allied or Associated Powers held by Germany shall be paid immediately to the person entitled thereto or to his Government; the proceeds of the property, rights and interests, and the cash assets, of German nationals received by an Allied or Associated Power shall be subject to disposal by such Power in accordance with its laws and regulations and may be applied in payment of the claims and debts defined by this Article or paragraph 4 of the Annex hereto. Any property, rights and interests or proceeds thereof or cash assets not used as above provided may be retained by the said Allied or Associated Power and if retained the cash value thereof shall be dealt with as provided in Article 243.

In the case of liquidations effected in new States, which are signatories of the present Treaty as Allied and Associated Powers, or in States which are not entitled to share in the reparation payments to be made by Germany, the proceeds of liquidations effected by such States shall, subject to the rights of the Reparation Commission under the present Treaty, particularly under Articles 235 and 260, be paid direct to the owner. If on the application of that owner, the Mixed Arbitral Tribunal, provided for by Section VI of this Part or an arbitrator appointed by that Tribunal, is satisfied that the conditions of the sale or measures taken by the Government of the State in question outside its general legislation were unfairly prejudicial to the price obtained, they shall have discretion to award to the owner equitable compensation to be paid by that State.

(i) Germany undertakes to compensate its nationals in respect of the sale or retention of their property, rights or interests in Allied or Associated States.

(j) The amount of all taxes and imposts upon capital levied or to be levied by Germany on the property, rights, and interests of the nationals of the Allied or Associated Powers from 11th November, 1918, until three months from the coming into force of the present Treaty, or, in the case of property, rights or interests which have been subjected to exceptional measures of war, until restitution in accordance with the present Treaty, shall be restored to the owners.

ARTICLE 298.

Germany undertakes, with regard to the property, rights, and interests, including companies and associations in which they were interested, restored to nationals of Allied and Associated Powers in accordance with the provisions of Article 297, paragraph (a) or (f)—

(a) to restore and maintain, except as expressly provided in the present Treaty, the property, rights and interests of the nationals of Allied or Associated Powers in the legal position obtaining in respect of the property,

rights and interests of German nationals under the laws in force before the war ;

(b) not to subject the property, rights or interests of the nationals of the Allied or Associated Powers to any measures in derogation of property rights, which are not applied equally to the property, rights and interests of German nationals, and to pay adequate compensation in the event of the application of these measures.

ANNEX.

1. In accordance with the provisions of Article 297, paragraph (d), the validity of vesting orders and of orders for the winding up of businesses or companies, and of any other orders, directions, decisions, or instructions of any Court or any Department of the Government of any of the High Contracting Parties made or given, or purporting to be made or given, in pursuance of war legislation with regard to enemy property, rights, and interests is confirmed. The interests of all persons shall be regarded as having been effectively dealt with by any order, direction, decision, or instruction dealing with property in which they may be interested, whether or not such interests are specifically mentioned in the order, direction, decision, or instruction. No question shall be raised as to the regularity of a transfer of any property, rights or interests dealt with in pursuance of any such order, direction, decision, or instruction. Every action taken with regard to any property, business, or company, whether as regards its investigation, sequestration, compulsory administration, use, requisition, supervision, or winding up, the sale or management of property, rights, or interests, the collection or discharge of debts, the payment of costs, charges, or expenses, or any other matter whatsoever, in pursuance of orders, directions, decisions, or instructions of any Court or of any department of the Government of any of the High Contracting Parties, made or given, or purporting to be made or given, in pursuance of war legislation with regard to enemy property, rights, or interests, is confirmed. Provided that the provisions of this paragraph shall not be held to prejudice the titles to property heretofore acquired in good faith and for value and in accordance with the laws of the country in which the property is situated by nationals of the Allied and Associated Powers.

The provisions of this paragraph do not apply to such of the above-mentioned measures as have been taken by the German authorities in invaded or occupied territory, nor to such of the above-mentioned measures as have been taken by Germany or the German authorities since 11th November, 1918, all of which shall be void.

2. No claim or action shall be made or brought against any Allied or Associated Power or against any person acting on behalf of or under the direction of any legal authority or Department of the Government of such a Power by Germany or by any German national wherever resident in respect of any act or omission with regard to his property, rights, or interests during the war or in preparation for the war. Similarly no claim or action shall be made or brought against any person in respect of any act or omission under or in accordance with the exceptional war measures, laws or regulations of any Allied or Associated Power.

3. In Article 297 and this Annex the expression "exceptional war measures" includes measures of all kinds, legislative, administrative, judicial, or others, that have been taken or will be taken hereafter with regard to enemy property, and which have had or will have the effect of removing from the proprietors the power of disposition over their property, though without affecting the ownership, such as measures of supervision, of compulsory administration, and of sequestration ; or measures which have had or will have as an object the seizure of, the use of, or the interference with enemy assets for whatsoever motive, under whatsoever form, or in whatsoever place.

Acts in the execution of these measures include all detentions, instructions, orders, or decrees of Government departments or Courts applying these measures to enemy property, as well as acts performed by any person connected with the administration or the supervision of enemy property, such as the payment of debts, the collecting of credits, the payment of any costs, charges, or expenses, or the collecting of fees.

Measures of transfer are those which have affected or will affect the ownership of enemy property by transferring it in whole or in part to a person other than the enemy owner, and without his consent, such as measures directing sale, liquidation, or devolution of ownership in enemy property, or the cancelling of titles or securities.

4. All property, rights, and interests of German nationals within the territory of any Allied or Associated Power and the net proceeds of their sale, liquidation or other dealing therewith may be charged by that Allied or Associated Power in the first place with payment of amounts due in respect of claims by the nationals of that Allied or Associated Power with regard to their property, rights, and interests, including companies and associations in which they are interested, in Germany territory, or debts owing to them by German nationals, and with payment of claims growing out of acts committed by the German Government or by any German authorities since 31st July, 1914, and before that Allied or Associated Power entered into the war. The amount of such claims may be assessed by an arbitrator appointed by Mr. Gustave Ador, if he is willing, or, if no such appointment is made by him, by an arbitrator appointed by the Mixed Arbitral Tribunal provided for in Section VI. They may be charged in the second place with payment of the amounts due in respect of claims by the nationals of such Allied or Associated Power with regard to their property, rights, and interests in the territory of other enemy Powers, in so far as those claims are otherwise unsatisfied.

5. Notwithstanding the provisions of Article 297, where immediately before the outbreak of war a company incorporated in an Allied or Associated State had rights in common with a company controlled by it and incorporated in Germany to the use of trade-marks in third countries, or enjoyed the use in common with such company of unique means of reproduction of goods or articles for sale in third countries, the former company shall alone have the right to use these trade-marks in third countries to the exclusion of the German company, and these unique means of reproduction shall be handed over to the former company, notwithstanding any action under German war legislation with regard to the latter company or its business, industrial property or shares. Nevertheless, the former company, if requested, shall deliver to the latter company derivative copies permitting the continuation of reproduction of articles for use within German territory.

6. Up to the time when restitution is carried out in accordance with Article 297, Germany is responsible for the conservation of property, rights, and interests of the nationals of Allied or Associated Powers, including companies and associations in which they are interested, that have been subjected by her to exceptional war measures.

7. Within one year from the coming into force of the present Treaty the Allied or Associated Powers will specify the property, rights, and interests over which they intend to exercise the right provided in Article 297, paragraph (f).

8. The restitution provided in Article 297 will be carried out by order of the German Government or of the authorities which have been substituted for it. Detailed accounts of the action of administrators shall be furnished to the interested persons by the German authorities upon request, which may be made at any time after the coming into force of the present Treaty.

9. Until completion of the liquidation provided for by Article 297, paragraph

(b), the property, rights, and interests of German nationals will continue to be subject to exceptional war measures that have been or will be taken with regard to them.

10. Germany will, within six months from the coming into force of the present Treaty, deliver to each Allied or Associated Power all securities, certificates, deeds, or other documents of title held by its nationals and relating to property, rights, or interests situated in the territory of that Allied or Associated Power, including any shares, stock, debentures, debenture stock, or other obligations of any company incorporated in accordance with the laws of that Power.

Germany will at any time on demand of any Allied or Associated Power furnish such information as may be required with regard to the property, rights, and interests of German nationals within the territory of such Allied or Associated Power, or with regard to any transaction concerning such property, rights, or interests effected since 1st July, 1914.

11. The expression "cash assets" includes all deposits or funds established before or after the declaration of war, as well as all assets coming from deposits, revenues, or profits collected by administrators, sequestrators, or others from funds placed on deposit or otherwise, but does not include sums belonging to the Allied or Associated Powers or to their component States, Provinces, or Municipalities.

12. All investments wheresoever effected, with the cash assets of nationals of the High Contracting Parties, including companies and associations in which such nationals were interested, by persons responsible for the administration of enemy properties or having control over such administration, or by order of such persons or of any authority whatsoever, shall be annulled. These cash assets shall be accounted for irrespective of any such investment.

13. Within one month from the coming into force of the present Treaty, or on demand at any time, Germany will deliver to the Allied and Associated Powers all accounts, vouchers, records, documents, and information of any kind which may be within Germany territory, and which concern the property, rights, and interests of the nationals of those Powers, including companies and associations in which they are interested, that have been subjected to an exceptional war measure, or to a measure of transfer either in German territory or in territory occupied by Germany or her allies.

The controllers, supervisors, managers, administrators, sequestrators, liquidators, and receivers shall be personally responsible under guarantee of the German Government for the immediate delivery in full of these accounts and documents, and for their accuracy.

14. The provisions of Article 297 and this Annex relating to property, rights, and interests in an enemy country, and the proceeds of the liquidation thereof, apply to debts, credits, and accounts, Section III regulating only the method of payment.

In the settlement of matters provided for in Article 297 between Germany and the Allied or Associated States, their colonies or protectorates, or any one of the British Dominions or India, in respect of any of which a declaration shall not have been made that they adopt Section III, and between their respective nationals, the provisions of Section III respecting the currency in which payment is to be made and the rate of exchange and of interest shall apply unless the Government of the Allied or Associated Power concerned shall within six months of the coming into force of the present Treaty notify Germany that the said provisions are not to be applied.

15. The provisions of Article 297 and this Annex apply to industrial, literary and artistic property which has been or will be dealt with in the liquidation of property, rights, interests, companies or businesses under war legislation by the Allied or Associated Powers, or in accordance with the stipulations of Article 297, paragraph (b).

SECTION V.—CONTRACTS, PRESCRIPTIONS, JUDGMENTS.

ARTICLE 299.

(a) Any contract concluded between enemies shall be regarded as having been dissolved as from the time when any two of the parties became enemies, except in respect of any debt or other pecuniary obligation arising out of any act done or money paid thereunder, and subject to the exceptions and special rules with regard to particular contracts or classes of contracts contained herein or in the Annex hereto.

(b) Any contract of which the execution shall be required in the general interest, within six months from the date of the coming into force of the present Treaty, by the Allied or Associated Governments of which one of the parties is a national, shall be excepted from dissolution under this Article.

When the execution of the contract thus kept alive would, owing to the alteration of trade conditions, cause one of the parties substantial prejudice the Mixed Arbitral Tribunal provided for by Section VI shall be empowered to grant to the prejudiced party equitable compensation.

(c) Having regard to the provisions of the Constitution and law of the United States of America, of Brazil, and of Japan, neither the present Article, nor Article 300, nor the Annex hereto shall apply to contracts made between nationals of these States and German nationals; nor shall Article 305 apply to the United States of America or its nationals.

(d) The present Article and the Annex hereto shall not apply to contracts the parties to which became enemies by reason of one of them being an inhabitant of territory of which the sovereignty has been transferred, if such party shall acquire under the present Treaty the nationality of an Allied or Associated Power, nor shall they apply to contracts between nationals of the Allied and Associated Powers between whom trading has been prohibited by reason of one of the parties being in Allied or Associated territory in the occupation of the enemy.

(e) Nothing in the present Article or the Annex hereto shall be deemed to invalidate a transaction lawfully carried out in accordance with a contract between enemies if it has been carried out with the authority of one of the belligerent Powers.

ARTICLE 300.

(a) All periods of prescription, or limitation of right of action, whether they began to run before or after the outbreak of war, shall be treated in the territory of the High Contracting Parties, so far as regards relations between enemies, as having been suspended for the duration of the war. They shall begin to run again at earliest three months after the coming into force of the present Treaty. This provision shall apply to the period prescribed for the presentation of interest or dividend coupons or for the presentation for repayment of securities drawn for repayment or repayable on any other ground.

(b) Where, on account of failure to perform any act or comply with any formality during the war, measures of execution have been taken in German territory to the prejudice of a national of an Allied or Associated Power, the claim of such national shall, if the matter does not fall within the competence of the Courts of an Allied or Associated Power, be heard by the Mixed Arbitral Tribunal provided for by Section VI.

(c) Upon the application of any interested person who is a national of an Allied or Associated Power the Mixed Arbitral Tribunal shall order the restoration of the rights which have been prejudiced by the measures of execution referred to in paragraph (b), wherever, having regard to the particular circumstances of the case, such restoration is equitable and possible.

If such restoration is inequitable or impossible the Mixed Arbitral Tribunal

may grant compensation to the prejudiced party to be paid by the German Government.

(d) Where a contract between enemies has been dissolved by reason either of failure on the part of either party to carry out its provisions or of the exercise of a right stipulated in the contract itself the party prejudiced may apply to the Mixed Arbitral Tribunal for relief. The Tribunal will have the powers provided for in paragraph (c).

(e) The provisions of the preceding paragraphs of this Article shall apply to the nationals of Allied and Associated Powers who have been prejudiced by reason of measures referred to above taken by Germany in invaded or occupied territory, if they have not been otherwise compensated.

(f) Germany shall compensate any third party who may be prejudiced by any restitution or restoration ordered by the Mixed Arbitral Tribunal under the provisions of the preceding paragraphs of this Article.

(g) As regards negotiable instruments, the period of three months provided under paragraph (a) shall commence as from the date on which any exceptional regulations applied in the territories of the interested Power with regard to negotiable instruments shall have definitely ceased to have force.

ARTICLE 301.

As between enemies no negotiable instrument made before the war shall be deemed to have become invalid by reason only of failure within the required time to present the instrument for acceptance or payment or to give notice of non-acceptance or non-payment to drawers or indorsers or to protest the instrument, nor by reason of failure to complete any formality during the war.

Where the period within which a negotiable instrument should have been presented for acceptance or for payment, or within which notice of non-acceptance or non-payment should have been given to the drawer or indorser, or within which the instrument should have been protested, has elapsed during the war, and the party who should have presented or protested the instrument or have given notice of non-acceptance or non-payment has failed to do so during the war, a period of not less than three months from the coming into force of the present Treaty shall be allowed within which presentation, notice of non-acceptance or non-payment or protest may be made.

ARTICLE 302.

Judgments given by the Courts of an Allied or Associated Power in all cases which, under the present Treaty, they are competent to decide, shall be recognized in Germany as final, and shall be enforced without it being necessary to have them declared executory.

If a judgment in respect of any dispute which may have arisen has been given during the war by a German Court against a national of an Allied or Associated State in a case in which he was not able to make his defence, the Allied and Associated national who has suffered prejudice thereby shall be entitled to recover compensation, to be fixed by the Mixed Arbitral Tribunal provided for in Section VI.

At the instance of the national of the Allied or Associated Power the compensation above mentioned may, upon order to that effect of the Mixed Arbitral Tribunal, be effected where it is possible by replacing the parties in the situation which they occupied before the judgment was given by the German Court.

The above compensation may likewise be obtained before the Mixed Arbitral Tribunal by the nationals of Allied or Associated Powers who have suffered prejudice by judicial measures taken in invaded or occupied territories, if they have not been otherwise compensated.

ARTICLE 303.

For the purpose of Sections III, IV, V, and VII, the expression "during the war" means for each Allied or Associated Power the period between the commencement of the state of war between that Power and Germany and the coming into force of the present Treaty.

ANNEX.

I. GENERAL PROVISIONS.

1. Within the meaning of Articles 299, 300, and 301, the parties to a contract shall be regarded as enemies when trading between them shall have been prohibited by or otherwise become unlawful under laws, orders, or regulations to which one of those parties was subject. They shall be deemed to have become enemies from the date when such trading was prohibited or otherwise became unlawful.

2. The following classes of contracts are excepted from dissolution by Article 299 and, without prejudice to the rights contained in Article 297 (b) of Section IV, remain in force subject to the application of domestic laws, orders, or regulations made during the war by the Allied and Associated Powers and subject to the terms of the contracts—

(a) Contracts having for their object the transfer of estates or of real or personal property where the property therein had passed or the object had been delivered before the parties became enemies;

(b) Leases and agreements for leases of land and houses;

(c) Contracts of mortgage, pledge, or lien;

(d) Concessions concerning mines, quarries, or deposits;

(e) Contracts between individuals or companies and States, provinces, municipalities, or other similar juridical persons charged with administrative functions and concessions granted by States, provinces, municipalities, or other similar juridical persons charged with administrative functions.

3. If the provisions of a contract are in part dissolved under Article 299, the remaining provisions of that contract shall, subject to the same application of domestic laws as is provided for in paragraph 2, continue in force if they are severable, but where they are not severable the contract shall be deemed to have been dissolved in its entirety.

II. PROVISIONS RELATING TO CERTAIN CLASSES OF CONTRACTS.

Stock Exchange and Commercial Exchange Contracts.

4. (a) Rules made during the war by any recognized Exchange or Commercial Association providing for the closure of contracts entered into before the war by an enemy are confirmed by the High Contracting Parties, as also any action taken thereunder, provided—

(i) That the contract was expressed to be made subject to the rules of the Exchange or Association in question.

(ii) That the rules applied to all persons concerned.

(iii) That the conditions attaching to the closure were fair and reasonable.

(b) The preceding paragraph shall not apply to rules made during the occupation by Exchanges or Commercial Associations in the districts occupied by the enemy.

(c) The closure of contracts relating to cotton "futures," which were closed as on 31st July, 1914, under the decision of the Liverpool Cotton Association, is also confirmed.

Security.

5. The sale of a security held for an unpaid debt owing by an enemy shall be deemed to have been valid irrespective of notice to the owner if the creditor

acted in good faith and with reasonable care and prudence, and no claim by the debtor on the ground of such sale shall be admitted.

This stipulation shall not apply to any sale of securities effected by an enemy during the occupation in regions invaded or occupied by the enemy.

Negotiable Instruments.

6. As regards Powers which adopt Section III and the Annex thereto the pecuniary obligations existing between enemies and resulting from the issue of negotiable instruments shall be adjusted in conformity with the said Annex by the instrumentality of the Clearing Offices, which shall assume the rights of the holder as regards the various remedies open to him.

7. If a person has either before or during the war become liable upon a negotiable instrument in accordance with an undertaking given to him by a person who has subsequently become an enemy, the latter shall remain liable to indemnify the former in respect of his liability notwithstanding the outbreak of war.

III. CONTRACTS OF INSURANCE.

8. Contracts of insurance entered into by any person with another person who subsequently became an enemy will be dealt with in accordance with the following paragraphs—

Fire Insurance.

9. Contracts for the insurance of property against fire entered into by a person interested in such property with another person who subsequently became an enemy shall not be deemed to have been dissolved by the outbreak of war, or by the fact of the person becoming an enemy, or on account of the failure during the war and for a period of three months thereafter to perform his obligations under the contract, but they shall be dissolved at the date when the annual premium becomes payable for the first time after the expiration of a period of three months after the coming into force of the present Treaty.

A settlement shall be effected of unpaid premiums which became due during the war, or of claims for losses which occurred during the war.

10. Where by administrative or legislative action an insurance against fire effected before the war has been transferred during the war from the original to another insurer, the transfer will be recognized and the liability of the original insurer will be deemed to have ceased as from the date of the transfer. The original insurer will, however, be entitled to receive on demand full information as to the terms of the transfer, and if it should appear that these terms were not equitable they shall be amended so far as may be necessary to render them equitable.

Furthermore, the insured shall, subject to the concurrence of the original insurer, be entitled to re-transfer the contract to the original insurer as from the date of the demand.

Life Insurance.

11. Contracts of life insurance entered into between an insurer and a person who subsequently became an enemy shall not be deemed to have been dissolved by the outbreak of war, or by the fact of the person becoming an enemy.

Any sum which during the war became due upon a contract deemed not to have been dissolved under the preceding provision shall be recoverable after the war with the addition of interest at five per cent per annum from the date of its becoming due up to the day of payment.

Where the contract has lapsed during the war owing to non-payment of premiums, or has become void from breach of the conditions of the contract the assured or his representatives or the persons entitled shall have the right

at any time within twelve months of the coming into force of the present Treaty to claim from the insurer the surrender value of the policy at the date of its lapse or avoidance.

Where the contract has lapsed during the war owing to non-payment of premiums the payment of which has been prevented by the enforcement of measures of war, the assured or his representative or the persons entitled shall have the right to restore the contract on payment of the premiums with interest at five per cent per annum within three months from the coming into force of the present Treaty.

12. Any Allied or Associated Power may within three months of the coming into force of the present Treaty cancel all the contracts of insurance running between a German insurance company and its nationals under conditions which shall protect its nationals from any prejudice.

To this end the German insurance company will hand over to the Allied or Associated Government concerned the proportion of its assets attributable to the policies so cancelled and will be relieved from all liability in respect of such policies. The assets to be handed over shall be determined by an actuary appointed by the Mixed Arbitral Tribunal.

13. Where contracts of life insurance have been entered into by a local branch of an insurance company established in a country which subsequently became an enemy country, the contract shall, in the absence of any stipulation to the contrary in the contract itself, be governed by the local law, but the insurer shall be entitled to demand from the insured or his representatives the refund of sums paid on claims made or enforced under measures taken during the war, if the making or enforcement of such claims was not in accordance with the terms of the contract itself or was not consistent with the laws or treaties existing at the time when it was entered into.

14. In any case where by the law applicable to the contract the insurer remains bound by the contract, notwithstanding the non-payment of premiums, until notice is given to the insured of the termination of the contract, he shall be entitled, where the giving of such notice was prevented by the war, to recover the unpaid premiums with interest at 5 per cent per annum from the insured.

15. Insurance contracts shall be considered as contracts of life assurance for the purpose of paragraphs 11 to 14 when they depend on the probabilities of human life combined with the rate of interest for the calculation of the reciprocal engagements between the two parties.

Marine Insurance.

16. Contracts of marine insurance including time policies and voyage policies entered into between an insurer and a person who subsequently became an enemy, shall be deemed to have been dissolved on his becoming an enemy, except in cases where the risk undertaken in the contract had attached before he became an enemy.

Where the risk had not attached, money paid by way of premium or otherwise shall be recoverable from the insurer.

Where the risk had attached effect shall be given to the contract notwithstanding the party becoming an enemy, and sums due under the contract either by way of premiums or in respect of losses shall be recoverable after the coming into force of the present Treaty.

In the event of any agreement being come to for the payment of interest on sums due before the war to or by the nationals of States which have been at war and recovered after the war, such interest shall in the case of losses recoverable under contracts of marine insurance run from the expiration of a period of one year from the date of the loss.

17. No contract of marine insurance with an insured person who subsequently became an enemy shall be deemed to cover losses due to belligerent

action by the Power of which the insurer was a national or by the allies or associates of such Power.

18. Where it is shown that a person who had before the war entered into a contract of marine insurance with an insurer who subsequently became an enemy entered after the outbreak of war into a new contract covering the same risk with an insurer who was not an enemy, the new contract shall be deemed to be substituted for the original contract as from the date when it was entered into, and the premiums payable shall be adjusted on the basis of the original insurer having remained liable on the contract only up till the time when the new contract was entered into.

Other Insurances.

19. Contracts of insurance entered into before the war between an insurer and a person who subsequently became an enemy, other than contracts dealt with in paragraphs 9 to 18 shall be treated in all respects on the same footing as contracts of fire insurance between the same persons would be dealt with under the said paragraphs.

Reinsurance.

20. All treaties of reinsurance with a person who became an enemy shall be regarded as having been abrogated by the person becoming an enemy, but without prejudice in the case of life or marine risks which had attached before the war to the right to recover payment after the war for sums due in respect of such risks.

Nevertheless if, owing to invasion, it has been impossible for the reinsured to find another reinsurer, the treaty shall remain in force until three months after the coming into force of the present Treaty.

Where a reinsurance treaty becomes void under this paragraph, there shall be an adjustment of accounts between the parties in respect both of premiums paid and payable and of liabilities for losses in respect of life or marine risk which had attached before the war. In the case of risks other than those mentioned in paragraphs 11 to 18 the adjustment of accounts shall be made as at the date of the parties becoming enemies without regard to claims for losses which may have occurred since that date.

21. The provisions of the preceding paragraph will extend equally to reinsurances existing at the date of the parties becoming enemies of particular risks undertaken by the insurer in a contract of insurance against any risks other than life or marine risks.

22. Reinsurance of life risks effected by particular contracts and not under any general treaty remain in force.

The provisions of paragraph 12 apply to treaties of reinsurance of life insurance contracts in which enemy companies are the reinsurers.

23. In case of a reinsurance effected before the war of a contract of marine insurance, the cession of a risk which had been ceded to the reinsurer shall, if it had attached before the outbreak of war, remain valid and effect be given to the contract notwithstanding the outbreak of war; sums due under the contract or reinsurance in respect either of premiums or of losses shall be recoverable after the war.

24. The provisions of paragraphs 17 and 18 and the last part of paragraph 16 shall apply to contracts for the reinsurance of marine risks.

SECTION VI.—MIXED ARBITRAL TRIBUNAL.

ARTICLE 304.

(a) Within three months from the date of the coming into force of the present Treaty, a Mixed Arbitral Tribunal shall be established between each of the Allied and Associated Powers on the one hand and Germany on the

other hand. Each such Tribunal shall consist of three members. Each of the Governments concerned shall appoint one of these members. The President shall be chosen by agreement between the two Governments concerned.

In case of failure to reach agreement, the President of the Tribunal and two other persons, either of whom may in case of need take his place, shall be chosen by the Council of the League of Nations, or, until this is set up, by M. Gustave Ador if he is willing. These persons shall be nationals of Powers that have remained neutral during the war.

If any Government does not proceed within a period of one month in case there is a vacancy to appoint a member of the Tribunal, such member shall be chosen by the other Government from the two persons mentioned above other than the President.

The decision of the majority of the members of the Tribunal shall be the decision of the Tribunal.

(b) The Mixed Arbitral Tribunals established pursuant to paragraph (a) shall decide all questions within their competence under Sections III, IV, V, and VII.

In addition, all questions, whatsoever their nature, relating to contracts concluded before the coming into force of the present Treaty between nationals of the Allied and Associated Powers and German nationals shall be decided by the Mixed Arbitral Tribunal, always excepting questions which, under the laws of the Allied, Associated or Neutral Powers, are within the jurisdiction of the National Courts of those Powers. Such questions shall be decided by the National Courts in question, to the exclusion of the Mixed Arbitral Tribunal. The party who is a national of an Allied or Associated Power may nevertheless bring the case before the Mixed Arbitral Tribunal if this is not prohibited by the laws of his country.

(c) If the number of cases justifies it, additional members shall be appointed and each Mixed Arbitral Tribunal shall sit in divisions. Each of these divisions will be constituted as above.

(d) Each Mixed Arbitral Tribunal will settle its own procedure except in so far as it is provided in the following Annex, and is empowered to award the sums to be paid by the loser in respect of the costs and expenses of the proceedings.

(e) Each Government will pay the remuneration of the member of the Mixed Arbitral Tribunal appointed by it and of any agent whom it may appoint to represent it before the Tribunal. The remuneration of the President will be determined by special agreement between the Governments concerned; and this remuneration and the joint expenses of each Tribunal will be paid by the two Governments in equal moieties.

(f) The High Contracting Parties agree that their courts and authorities shall render to the Mixed Arbitral Tribunal direct all the assistance in their power, particularly as regards transmitting notices and collecting evidence.

(g) The High Contracting Parties agree to regard the decisions of the Mixed Arbitral Tribunal as final and conclusive, and to render them binding upon their nationals.

ANNEX.

1. Should one of the members of the Tribunal either die, retire, or be unable for any reason whatever to discharge his functions, the same procedure will be followed for filling the vacancy as was followed for appointing him.

2. The Tribunal may adopt such rules of procedure as shall be in accordance with justice and equity and decide the order and time at which each party must conclude its arguments, and may arrange all formalities required for dealing with the evidence.

3. The agent and counsel of the parties on each side are authorized to present orally and in writing to the Tribunal arguments in support or in defence of each case.

4. The Tribunal shall keep record of the questions and cases submitted and the proceedings thereon, with the dates of such proceedings.

5. Each of the Powers concerned may appoint a secretary. These secretaries shall act together as joint secretaries of the Tribunal and shall be subject to its direction. The Tribunal may appoint and employ any other necessary officer or officers to assist in the performance of its duties.

6. The Tribunal shall decide all questions and matters submitted upon such evidence and information as may be furnished by the parties concerned.

7. Germany agrees to give the Tribunal all facilities and information required by it for carrying out its investigations.

8. The language in which the proceedings shall be conducted shall, unless otherwise agreed, be English, French, Italian, or Japanese, as may be determined by the Allied or Associated Power concerned.

9. The place and time for the meetings of each Tribunal shall be determined by the President of the Tribunal.

ARTICLE 305.

Whenever a competent Court has given or gives a decision in a case covered by Sections III, IV, V, or VII, and such decision is inconsistent with the provisions of such Sections, the party who is prejudiced by the decision shall be entitled to obtain redress which shall be fixed by the Mixed Arbitral Tribunal. At the request of the national of an Allied or Associated Power, the redress may, whenever possible, be effected by the Mixed Arbitral Tribunal directing the replacement of the parties in the position occupied by them before the judgment was given by the German Court.

SECTION VII.—INDUSTRIAL PROPERTY.

ARTICLE 306.

Subject to the stipulations of the present Treaty, rights of industrial, literary, and artistic property, as such property is defined by the International Conventions of Paris and of Berne, mentioned in Article 286, shall be re-established or restored, as from the coming into force of the present Treaty, in the territories of the High Contracting Parties, in favour of the persons entitled to the benefit of them at the moment when the state of war commenced or their legal representatives. Equally, rights which, except for the war, would have been acquired during the war in consequence of an application made for the protection of industrial property, or the publication of a literary or artistic work, shall be recognized and established in favour of those persons who would have been entitled thereto, from the coming into force of the present Treaty.

Nevertheless, all acts done by virtue of the special measures taken during the war under legislative, executive or administrative authority of any Allied or Associated Power in regard to the rights of German nationals in industrial, literary or artistic property shall remain in force and shall continue to maintain their full effect.

No claim shall be made or action brought by Germany or German nationals in respect of the use during the war by the Government of any Allied or Associated Power, or by any persons acting on behalf or with the assent of such Government, of any rights in industrial, literary or artistic property, nor in respect of the sale, offering for sale, or use of any products, articles or apparatus whatsoever to which such rights applied.

Unless the legislation of any one of the Allied or Associated Powers in force at the moment of the signature of the present Treaty otherwise directs, sums due or paid in virtue of any act or operation resulting from the execution of the special measures mentioned in paragraph 1 of this Article shall be dealt with in the same way as other sums due to German nationals are directed to be dealt with by the present Treaty; and sums produced by any special

measures taken by the German Government in respect of rights in industrial, literary or artistic property belonging to the nationals of the Allied or Associated Powers shall be considered and treated in the same way as other debts due from German nationals.

Each of the Allied and Associated Powers reserves to itself the right to impose such limitations, conditions, or restrictions on rights or industrial, literary, or artistic property (with the exception of trade-marks) acquired before or during the war, or which may be subsequently acquired in accordance with its legislation, by German nationals, whether by granting licences, or by the working, or by preserving control over their exploitation, or in any other way, as may be considered necessary for national defence, or in the public interest, or for assuring the fair treatment by Germany of the rights of industrial, literary, and artistic property held in German territory by its nationals, or for securing the due fulfilment of all the obligations undertaken by Germany in the present Treaty. As regards rights of industrial, literary, and artistic property acquired after the coming into force of the present Treaty, the right so reserved by the Allied and Associated Powers shall only be exercised in cases where these limitations, conditions, or restrictions may be considered necessary for national defence or in the public interest.

In the event of the application of the provisions of the preceding paragraph by any Allied or Associated Power, there shall be paid reasonable indemnities or royalties which shall be dealt with in the same way as other sums due to German nationals are directed to be dealt with by the present Treaty.

Each of the Allied or Associated Powers reserves the right to treat as void and of no effect any transfer in whole or in part of or other dealing with rights of or in respect of industrial, literary, or artistic property effected after 1st August, 1914, or in the future, which would have the result of defeating the objects of the provisions of this article.

The provisions of this article shall not apply to rights in industrial, literary, or artistic property which have been dealt with in the liquidation of businesses or companies under war legislation by the Allied or Associated Powers, or which may be so dealt with by virtue of Article 297, paragraph (b).

ARTICLE 307.

A minimum of one year after the coming into force of the present Treaty shall be accorded to the nationals of the High Contracting Parties, without extension fees or other penalty, in order to enable such persons to accomplish any act, fulfil any formality, pay any fees, and generally satisfy any obligation prescribed by the laws or regulations of the respective States relating to the obtaining, preserving, or opposing rights to, or in respect of, industrial property either acquired before 1st August, 1914, or which, except for the war, might have been acquired since that date as a result of an application made before the war or during its continuance, but nothing in this article shall give any right to reopen interference proceedings in the United States of America where a final hearing has taken place.

All rights in, or in respect of, such property, which may have lapsed by reason of any failure to accomplish any act, fulfil any formality, or make any payment, shall revive, but subject in the case of patents and designs to the imposition of such conditions as each Allied or Associated Power may deem reasonably necessary for the protection of persons who have manufactured or made use of the subject matter of such property while the rights had lapsed. Further, where rights to patents or designs belonging to German nationals are revived under this article, they shall be subject in respect of the grant of licences to the same provisions as would have been applicable to them during the war, as well as to all the provisions of the present Treaty.

The period from 1st August, 1914, until the coming into force of the present Treaty shall be excluded in considering the time within which a patent should be worked or a trade mark or design used, and it is further agreed that no patent, registered trade mark, or design in force on 1st August, 1914, shall be subject to revocation or cancellation by reason only of the failure to work such patent or use such trade mark or design for two years after the coming into force of the present Treaty.

ARTICLE 308.

The rights of priority, provided by Article IV of the International Convention for the Protection of Industrial Property of Paris, of 20th March, 1883, revised at Washington in 1911 or by any other Convention or Statute, for the filing or registration of applications for patents or models of utility, and for the registration of trade marks, designs, and models which had not expired on 1st August, 1914, and those which have arisen during the war, or would have arisen but for the war, shall be extended by each of the High Contracting Parties in favour of all nationals of the other High Contracting Parties for a period of six months after the coming into force of the present Treaty^(a).

Nevertheless, such extension shall in no way affect the right of any of the High Contracting Parties or of any person who before the coming into force of the present Treaty^(b) was *bona fide* in possession of any rights of industrial property conflicting with rights applied for by another who claims rights of priority in respect of them, to exercise such rights by itself or himself personally, or by such agents or licensees as derived their rights from it or him before the coming into force of the present Treaty; and such persons shall not be amenable to any action or other process of law in respect of infringement.

ARTICLE 309.

No action shall be brought and no claim made by persons residing or carrying on business within the territories of Germany on the one part and of the Allied or Associated Powers on the other, or persons who are nationals of such Powers respectively, or by any one deriving title during the war from such persons, by reason of any action which has taken place within the territory of the other party between the date of the declaration of war and that of the coming into force of the present Treaty, which might constitute an infringement of the rights of industrial property or rights of literary and artistic property, either existing at any time during the war or revived under the provisions of Articles 307 and 308.

Equally, no action for infringement of industrial, literary, or artistic property rights by such persons shall at any time be permissible in respect of the sale or offering for sale for a period of one year after the signature of the present Treaty in the territories of the Allied or Associated Powers on the one hand or Germany on the other, of products or articles manufactured, or of literary or artistic works published during the period between the declaration of war and the signature of the present Treaty, or against those who have acquired and continue to use them. It is understood, nevertheless, that this provision shall not apply when the possessor of the rights was domiciled or had an industrial or commercial establishment in the districts occupied by Germany during the war.

This Article shall not apply as between the United States of America on the one hand and Germany on the other.

(a) This period was extended to 10th January, 1921, by virtue of the provisions of the War Emergency (Continuance) Act, 1920, which extended the powers of the Comptroller of Patents Designs and Trade Marks under the Patents, Designs and Trade Marks (Temporary Rules) Act, 1914.

(b) See pp. 141, 142 *ante*.

ARTICLE 310.

Licences in respect of industrial, literary, or artistic property concluded before the war between nationals of the Allied or Associated Powers or persons residing in their territory or carrying on business therein, on the one part, and German nationals on the other part, shall be considered as cancelled as from the date of the declaration of war between Germany and the Allied or Associated Power. But, in any case, the former beneficiary of a contract of this kind shall have the right, within a period of six months after the coming into force of the present Treaty, to demand from the proprietor of the rights the grant of a new licence, the conditions of which, in default of agreement between the parties, shall be fixed by the duly qualified tribunal in the country under whose legislation the rights have been acquired, except in the case of licences held in respect of rights acquired under German law. In such cases the conditions shall be fixed by the Mixed Arbitral Tribunal referred to in Section VI of this Part. The tribunal may, if necessary, fix also the amount which it may deem just should be paid by reason of the use of the rights during the war.

No licence in respect of industrial, literary, or artistic property, granted under the special war legislation of any Allied or Associated Power, shall be affected by the continued existence of any licence entered into before the war, but shall remain valid and of full effect, and a licence so granted to the former beneficiary of a licence entered into before the war shall be considered as substituted for such licence.

Where sums have been paid during the war by virtue of a licence or agreement concluded before the war in respect of rights of industrial property or for the reproduction or the representation of literary, dramatic, or artistic works, these sums shall be dealt with in the same manner as other debts or credits of German nationals, as provided by the present Treaty.

This Article shall not apply as between the United States of America on the one hand and Germany on the other.

ARTICLE 311.

The inhabitants of territories separated from Germany by virtue of the present Treaty shall, notwithstanding this separation and the change of nationality consequent thereon, continue to enjoy in Germany all the rights in industrial, literary, and artistic property to which they were entitled under German legislation at the time of the separation.

Rights of industrial, literary, and artistic property which are in force in the territories separated from Germany under the present Treaty at the moment of the separation of these territories from Germany or which will be re-established or restored in accordance with the provisions of Article 306 of the present Treaty, shall be recognized by the State to which the said territory is transferred and shall remain in force in that territory for the same period of time given them under the German law.

APPENDIX VII

STATUTORY RULES AND ORDERS, 1920, No. 1336

TRADING WITH THE ENEMY Patents of German Nationals Vested in Custodian

ORDER OF THE BOARD OF TRADE, DATED 19TH JULY, 1920, UNDER SECTION 5 (1) OF THE TRADING WITH THE ENEMY AMENDMENT ACT, 1914 (5 GEO. 5, c. 12), AS TO "VESTED PATENTS," "VESTED APPLICATIONS" AND "RESTORED PATENTS."

In the matter of divers patents and applications for patents vested in the Custodian; and

In the matter of the Trading with the Enemy Acts, 1914 to 1918; and

In the matter of the Treaty of Peace (with Germany) Act, 1919; and

In the matter of the Treaty of Peace (with Germany) Order, 1919.(*)

Whereas the expression "British Patent" when hereinafter used means Letters Patent which have been granted in and for the United Kingdom of Great Britain and Ireland and the Isle of Man:

And whereas prior to the Order of the Board of Trade of the 30th October, 1918, hereinafter recited, divers British Patents which had been granted to or for the benefit of German Nationals (as defined by the Treaty of Peace (with Germany) Order, 1919), the shares and interests of German Nationals in divers other British Patents and also the benefit so far as the same belonged to German Nationals of or in divers applications which had been made by or on behalf or for the benefit of German Nationals, either alone or jointly with other parties, for grants of such patents were by or by virtue of Orders which were made by the High Court of Justice or the Board of Trade under the Trading with the Enemy Acts, 1914-1918, or some or one of such Acts duly vested in the Public Trustee, the Custodian for England and Wales under the Trading with the Enemy Amendment Act, 1914 (hereinafter called "the Custodian"):

And whereas by an Order dated the 30th October, 1918, and so made by the Board of Trade as aforesaid, after reciting that the expression "hostile person" when thereinafter used meant and included (a) a person, firm, body or company being an enemy or enemy subject within the meaning of the Trading with the Enemy Amendment Acts, 1916 and 1918(†), (b) a Company with respect to which an Order had been made under Section 1 of the Trading with the Enemy Amendment Act, 1916, or Section 3 of the Trading with the Enemy Amendment Act, 1918, and (c) a Company being an enemy controlled corporation within the meaning of the Trading with the Enemy Amendment Act, 1918, it was amongst other things ordered that (1) all and every the interest, share and right of every hostile person in, of or to any British patent, and (2) the benefit of every application which had been made by or on behalf or for the benefit of any hostile person for any British patent should, except in so far as the same should already have been vested by any

(*) S.R. & O., 1919, No. 1517.

(†) 5-6 G. 5. c. 105 and 8-9 G. 5. c. 31.

Order made under the Trading with the Enemy Amendment Acts, or any of them, vest in the Custodian :

And whereas as regards certain of the said applications patents have in pursuance of the Trading with the Enemy Amendment Act, 1916, been duly granted to the Custodian :

And whereas the expression "vested patent" as hereinafter used means such interest, share, rights or title in, of or to a British patent as may by reason or on account of the late war between the United Kingdom and Germany have been so vested in or granted to the Custodian as aforesaid, and the expression "vested application" as hereinafter used means such benefit and rights of or in respect of any application for the grant of a British patent as may by reason or on account of the said late war have been so vested in the Custodian as aforesaid :

And whereas it is expedient that such Order or Orders and directions as are hereinafter contained shall be made and given in regard to vested patents and vested applications :

Now, therefore, the Board of Trade in exercise of the powers conferred upon them by Section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and/or the Treaty of Peace (with Germany) Order, 1919, and of all other powers (if any) then hereunto enabling do hereby order and direct as follows—

1. (i) Subject to the provisions hereinafter contained the Custodian shall forthwith divest himself of the vested patents and of the vested applications in favour as the case may be of the respective persons who were at the commencement of the late war between the United Kingdom and Germany or would but for such war and the relative Vesting Orders now be entitled thereto.

Provided always that if by any Order made under the Trading with the Enemy Amendment Acts, or any of them which may affect any vested patent or vested application, any condition was imposed upon the Custodian which might operate so as to prohibit him from dealing with such patent or application, the prohibiting condition shall be and stand discharged upon the Board of Trade certifying to that effect, but so nevertheless that such divesting as aforesaid shall not take effect as regards such patent or application unless and until the Board of Trade shall so certify :

(ii) In the subsequent provisions of this Order the following expressions shall mean and be construed as follows, that is to say : "restored patent" shall mean and include any vested patent of which the Custodian shall have divested himself under the directions in the preceding sub-clause contained and also such interest, share, rights or title in, of or to any British patent as may be or may have been granted upon or in pursuance or by virtue of a restored application : "restored application" shall mean and include any vested application of which the Custodian shall have divested himself as aforesaid and also to the extent to which the same may be or may have been revived as next hereinafter mentioned any application for the grant of a British patent which may be or may have been revived under the provisions of the Treaty of Peace between the United Kingdom and Germany (hereinafter referred to as the "Treaty of Peace") : "patentee" shall mean and include the person for the time being entitled to the benefit of a restored patent : "licensee" shall in relation to a licence mean and include any person for the time being entitled to the benefit of the licence.

2. Subject to the provisions of this Order dealings in regard to a restored patent are permitted between British Nationals and German Nationals (as respectively defined by the said Treaty of Peace Order).

3. An assignment or assurance *inter vivos* of a restored patent or a restored application shall not be made nor shall any licence be granted under a restored patent except after notice to and with the consent of the Board of Trade, and any such purporting licence which may be made or granted

except after such notice and with such consent shall be void and of no effect. And any devolution of a restored patent or of a restored application otherwise than by an assignment or assurance *inter vivos* shall not be operative unless and until assented to by the Board of Trade.

4. A restored patent shall remain and be subject to any licence under or in respect thereof which may have been granted by the Board of Trade under the Patents, Designs and Trade Marks (Temporary Rules) Acts, 1914.(*) or by the Custodian under Section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and any such licence shall with the additional rights, powers and privileges next hereafter conferred upon the Licensee, be and remain as valid and effectual as if this Order had not been made :

Provided always that in addition to any other rights, privileges or powers to which he may be entitled the Licensee, exclusive or otherwise as the case may be, shall be deemed to have and shall have all the rights, privileges and powers of such a Licensee under the provisions of Section 1 of the Patents and Designs Act, 1919(†) :

Provided further that all powers which by or under any such licence as aforesaid may have been given to or vested in the Board of Trade or the Custodian shall as regards any powers given to or vested in the Custodian be and be deemed to have been transferred to the Board of Trade and as to all such powers whether given to or vested in the Board of Trade or given to or vested in the Custodian shall be and remain exercisable by the Board of Trade.

5. The Board of Trade have and shall continue to have power upon the application of any person to grant to or in favour of the applicant a compulsory licence under any restored patent upon such terms as to royalty or otherwise as may be thought fit (a) if in the opinion of the Board of Trade it is in the public interest that such licence shall be granted, or (b) if the Patentee shall refuse to grant to the applicant a licence upon reasonable terms. And for the purpose of and in connection with the exercise of such power the Board of Trade shall have all the powers of the Comptroller of Patents, Trade Marks and Designs (hereinafter called the Comptroller) under the Patents and Designs Act, 1919, in a case in which abuse of the monopoly rights has been established.

6. The Board of Trade shall as regards any licence which has been or may be granted under any restored patent, whether the licence is granted as mentioned in Clause 4 hereof or as mentioned in Clause 5 hereof, have power upon the application of the Licensee or of the Patentee to make such revisions or amendments in the licence as may be thought fit whether as regards the royalty payable thereunder or otherwise, and any such revision or amendment may consist of or include a provision which will preclude the Patentee (a) from importing into the United Kingdom any goods the importation of which would if effected by a person other than the Patentee be an infringement of the patent, and/or (b) from working or using the patented invention in the United Kingdom.

7. Notwithstanding anything herein contained the Board of Trade shall as regards any restored patent or restored application have power either without or upon the application of any person interested to expropriate, take over or sell any such patents or the patent rights under any such application on such terms as to indemnity, purchase, consideration or otherwise as may be determined by a special Tribunal to be nominated by the Lord Chancellor for the time being but so that the President or Chairman of such Tribunal shall be a high judicial officer or a barrister of not less than ten years' standing, and in such case the Board of Trade shall be deemed to have all the powers of the patentee or proprietor and may make a good title to any transfer, licence or other assurance provided always that the

(*) 4-5 G. 5. cc. 27 and 73.

(†) 9-10 G. 5. c. 80.

power hereby conferred shall not be exercised unless in the opinion of the Board of Trade the exercise thereof is necessary for the National Defence or in the public interest or for securing the due fulfilment of all the obligations undertaken by Germany in the Treaty of Peace.

8. All royalties and/or other monies which but for this provision would by virtue of anything done under or in pursuance of any provision contained in this Order be payable to a German National shall be divided and paid as follows, namely—

(a) in the case of voluntary dealings—75 per cent of such royalties and/or other monies shall be paid to the Controller of the Clearing Office for the purposes of such Office and the remaining 25 per cent thereof shall be paid to the other party or parties who may be concerned :

(b) in every other case the whole of such royalties and/or other monies shall be paid to the Controller of the Clearing Office for the purpose of such Office.

Provided always that any royalties under any such licence as is mentioned in Clause 4 hereof which have accrued prior to the date upon which the patent shall have become a restored patent or which may thereafter accrue shall be retained by or paid to the Custodian as the case may be.

9. The conditions imposed by and other provisions contained in Clauses 3 to 8 of this Order upon or in regard to restored patents and restored applications shall not, except as hereafter mentioned, apply as regards vested patents or vested applications of which the Custodian shall have divested himself under the directions contained in Clause 1 (1) herein in favour of persons who, by or by virtue of or in pursuance of the Treaty of Peace, have ceased to be German nationals : Provided nevertheless that as regards such patents as last mentioned—

(i) The patents shall remain and be subject to any licence under or in respect thereof which may have been granted by the Board of Trade under the Patents, Designs and Trade Marks (Temporary Rules) Acts, 1914, or by the Custodian under Section 5 (1) of the Trading with the Enemy Amendment Act, 1914, and any such licence shall be and remain as valid and effectual as if this Order had not been made.

(ii) The Board of Trade shall as regards any licence which has been granted as aforesaid under the patent have power upon the application of the licensee or of the patentee to make such revisions or amendments in the licence as may be thought fit whether as regards the royalty payable thereunder or otherwise.

10. Any application to be made under any provision herein contained shall be made to the Comptroller.

11. The Board of Trade may from time to time make such rules as may be necessary or expedient for the purpose of carrying out the provisions of this Order and by any such rules may regulate the procedure to be followed and may prescribe the payment of fees and fix the amount thereof and any such rules whilst in force shall be of the same effect as if the same were contained in this Order.

12. This Order shall not nor shall anything herein contained apply to any patent or application for the grant of a patent which has been effectually dealt with in or for the purpose of the liquidation of any business or company as regards which a Winding-up Order has been made under or in pursuance of the Trading with the Enemy Acts, 1914 to 1918, or any of them.

13. The Board of Trade may at any time revoke or vary this Order and any provisions herein contained as well as any rules made under Clause 11 hereof.

Dated this 19th day of July, 1920.

R. S. Horne,

President of the Board of Trade.

APPENDIX VIII

(8) STATUTORY RULES AND ORDERS, 1920, No. 1371

PATENTS FOR INVENTIONS

THE PATENTS (TREATY OF PEACE) RULES, 1920. DATED 24TH JULY, 1920

By virtue of the provisions of the Trading with the Enemy Acts, 1914 to 1918, the Treaty of Peace Act, 1919, (*) the Treaty of Peace Order, 1919, (†) and the Order of the Board of Trade, dated 19th July, 1920, (‡) the Board of Trade do hereby make the following Rules—

PRELIMINARY.

1. These Rules may be cited as the Patents (Treaty of Peace) Rules, 1920, and shall come into operation from and immediately after the 19th day of July, 1920.

INTERPRETATION.

2. In the construction of these Rules any words herein used, the meanings of which are defined by the Order of the Board of Trade dated the 19th day of July, 1920, shall have the meanings thereby assigned to them respectively.

FEES.

3. The fees to be paid under these Rules shall be those specified in the first Schedule to these Rules.

FORMS.

4. The forms herein referred to are the forms contained in the second Schedule to these Rules. Such forms shall be used in all cases to which they are applicable and may be modified as directed by the Comptroller to meet other cases.

VOLUNTARY DEALINGS IN OR UNDER RESTORED PATENTS, &c.

5. Where any assignment or assurance of a restored patent or of the benefit of a restored application or any licence under a restored patent has been agreed between parties, application for the consent of the Board of Trade to any such assignment, assurance, or licence shall be made on Patents Form No. 40 before the execution of the document effecting such assignment, assurance or licence. Such application shall be accompanied by a copy of the draft document proposed to be executed.

DEVOLUTION OF TITLE BY OPERATION OF LAW.

6. Where any person claims to be entitled to the benefit of or any interest in a restored patent or restored application by virtue of operation of law, arising after the outbreak of war, he shall make application for the consent of the Board of Trade to his title as claimed being recognized upon Patents Form No. 41. Such application shall be accompanied by a copy of the instrument or other document under which the applicant claims title.

(*) 9-10 G. 5. c. 33.

(†) S.R. & O., 1919, No. 1517.

(‡) S.R. & O., 1920, No. 1336,

APPLICATION FOR LICENCE UNDER RESTORED PATENT OTHER THAN UNDER RULE 5.

7. An application for the grant of a licence under a restored patent or a patent granted upon a restored application shall be made upon Patents Form No. 42. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the reason for making the application, the facts upon which the applicant bases his case and the terms of the licence which he is prepared to accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee at his address for service on the Register of Patents.

Upon such application being made and copy thereof transmitted to the patentee, the latter, if desirous of contesting the application, shall within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which the application is contested and, on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement, and or any further evidence the Comptroller may require, the Comptroller shall proceed to determine the application.

APPLICATION FOR REVISION OF LICENCE.

8. An application for the revision of a licence whether granted by the Board of Trade, the Custodian, or under these Rules under a restored patent shall be made upon Patents Form No. 43. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the facts upon which the applicant bases his case and the terms of such licence as he is prepared to accept or grant. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee, at his address for service on the Register of Patents or the Licensee concerned, as the case may be.

Upon such application being made and copy thereof transmitted, the patentee or licensee, as the case may be, if desirous of contesting the application, shall within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which the application is contested and, on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement and or any further evidence the Comptroller may require, the Comptroller shall proceed to determine the application.

APPLICATION FOR THE EXPROPRIATION, TAKING OVER OR SELLING ANY RESTORED PATENT.

9. An application for the expropriation, taking over or sale of any restored patent or a patent granted upon a restored application shall be made upon Patents Form No. 44. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the reason for making the application and the facts upon which the applicant bases his case. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee at his address for service on the Register of Patents.

Upon such application being made and copy thereof transmitted to the patentee, the latter, if desirous of contesting the application, shall, within one month of the receipt of such copy at his address for service, or such further time as the Comptroller may allow, leave at the Patent Office a counter-statement fully setting out the grounds upon which the application is contested and on so leaving, shall deliver to the applicant a copy thereof.

Upon receipt of such counter-statement and/or any further evidence the Comptroller may require, the Comptroller shall proceed to determine whether the application should be granted and be referred to a special tribunal for the settlement of terms.

Where it is decided to grant the application and refer it to a special tribunal for the settlement of terms application to be heard by the special tribunal shall be made upon Patents Form No. 45.

HEARINGS.

10. Before deciding any issue raised under Rules 7, 8, and 9 of these Rules or before exercising any discretionary power given to the Comptroller under the Order of the Board of Trade, dated 19th July, 1920, or these Rules, adversely to any party the Comptroller shall give ten days notice, or such longer notice as he may think fit to the party or parties as the case may be of the time when he is prepared to hear such party or parties or their representatives.

EVIDENCE.

11. In lieu of or in addition to any oral evidence that may be given at a hearing the Comptroller may require any party to file evidence by way of statutory declaration and allow any declarant to be cross-examined on his declaration.

COSTS.

12. The Comptroller may award costs in any proceedings under these Rules, and direct how and by what parties they are to be paid. Further, in any case in which he thinks fit, the Comptroller may require any person initiating proceedings to give security for costs, and in the event of such security not being forthcoming, may dismiss the application in question.

Dated this 24th day of July, 1920.

R. S. Horne,

President of the Board of Trade.

First Schedule.

FEES.

Subject or Proceeding.	Amount.	Corresponding Form.
	£ s. d.	
On application under Rule 5 for consent of Board of Trade to assignment, assurance or licence of patent rights.	2 0 0	Patents Form No. 40.
On application under Rule 6 for consent of Board of Trade to devolution of title to patent rights by operation of law.	2 0 0	„ „ No. 41.
On application for licence under restored patent.	2 0 0	„ „ No. 42.
On application for revision of licence .	5 0 0	„ „ No. 43.
On application for expropriation, taking over, or selling any restored patent rights.	5 0 0	„ „ No. 44.
On application for hearing by tribunal in respect of the expropriation, taking over, or selling of restored patent rights.	5 0 0	„ „ No. 45.

Second Schedule.

FORMS.

PATENTS FORM No. 40.

THE PATENTS (TREATY OF PEACE) RULES, 1920.

*Application under Rule 5 for consent of Board of Trade to
Assignment, Assurance, or Licence of Patent Rights.*

PATENT

£2

(a) I (or we).....

(a) Give in full,
name, address, and
nationality of
applicant(s).

hereby apply for the consent of the Board of Trade to an

(Assignment)

(Assurance) in respect of (application) No. of

(Licence) (Letters Patent

being executed.

A copy of the document in question, the terms of which have
been agreed between.....
of the one part and.....
of the other, accompanies this application.

My (our) address for service in the United Kingdom is—

.....

.....

.....

(b) Signature of Applicant(s).....

(b) To be signed by
the applicant(s).

.....

To the Comptroller,
The Patent Office,
25 Southampton Buildings,
Chancery Lane,
London, W.C.2.

PATENTS FORM No. 41.

PATENT

£2

THE PATENTS (TREATY OF PEACE) RULES, 1920.

*Application under Rule 6 for consent of Board of Trade to devolution
of title to Patent Rights by operation of Law.*

(a) Give in full,
name, address and
nationality of
applicant(s).

(a) I (or we).....

hereby apply for the consent of the Board of Trade to the benefit

of (Application) No. of devolving upon me.
 (Letters Patent)

(b) Here insert
nature of claim.

I (we) claim to be entitled to (b).....

by virtue of an instrument dated.....

a copy of which accompanies this application.

My (our) address for service in the United Kingdom is—

(c) To be signed by
applicant(s).

(c) Signature of Applicant(s).....

To the Comptroller,

The Patent Office,

25 Southampton Buildings,

Chancery Lane,

London, W.C.2.

PATENTS FORM NO. 42.

THE PATENTS (TREATY OF PEACE) RULES, 1920.

Application for Licence in respect of restored Patent under Rule 7.

(To be accompanied by an unstamped copy and also a statement of case (in duplicate)).

PATENT

£2

(a) I (we)

(a) Give in full, name, address and nationality of applicant(s).

.....
hereby apply for a licence in respect of Letters Patent No.
of

A draft licence embodying the terms which I (we) am (are)
prepared to accept is annexed.

My (our) address for service in the United Kingdom is—

.....

.....

.....

(b) Signature of Applicant(s).....

(b) To be signed by applicant(s).

.....

To the Comptroller,
The Patent Office,
25 Southampton Buildings,
Chancery Lane,
London, W.C.2.

PATENTS FORM No. 43.

THE PATENTS (TREATY OF PEACE) RULES, 1920.

PATENT

£5

Application under Rule 8 for Revision of the Terms of a Licence.

(To be accompanied by an unstamped copy and also a statement of case (in duplicate)).

(a) Give in full, name, address and nationality of applicant(s).

(a) I (we).....

hereby request that the terms of the Licence in respect of Letters
Patent No. of which licence is
dated , and was granted by.....

to.....

may be revised.

(b) Here state briefly the nature of the revision desired.

The modifications which I (we) desire to have effected are (b)

A draft licence embodying the terms which ^(we are)_(I am) prepared
to accept (or grant) is annexed.

My (our) address for service in the United Kingdom is—

(c) Signature of Applicant(s).....

(c) To be signed by the applicant(s) whether patentee(s) or licensee(s).

To the Comptroller,
The Patent Office,
25 Southampton Buildings,
Chancery Lane,
London, W.C.2.

PATENTS FORM NO. 44.

THE PATENTS (TREATY OF PEACE) RULES, 1920.

*Application under Rule 9 for the Expropriation, Taking Over, or
Selling of restored Patent Rights.*

PATENT

£5

(To be accompanied by an unstamped copy and also a statement
of case (in duplicate)).

(a) I (we).....

(a) Give in full,
name, address and
nationality of
applicant(s).

hereby apply for the expropriation, taking over or sale (b) of (c)

(b) Strike out words
which do not apply.
(c) Here insert
particulars of letters
patent, or
application.

No. of

My (our) address for service in the United Kingdom is—

Signature of Applicant(s).....

To the Comptroller,

The Patent Office,

25 Southampton Buildings,

Chancery Lane,

London, W.C.2.

PATENT

£5

PATENTS FORM No. 45.

THE PATENTS (TREATY OF PEACE) RULES, 1920.

*Application to be heard by Tribunal in Respect of the Expropriation,
Taking Over, or Selling of Restored Patent Rights.*

(a) Give in full,
name, address and
nationality of
applicant(s).

I (we) (a).....

hereby apply to be heard by the Tribunal in respect of the

(b) Strike out words
which do not apply.
(c) Here insert
particulars of letters
patent or
application.

application to (b) expropriate, take over or sell (c)

No. of

My (our) address for service in the United Kingdom is—

.....

.....

.....

Signature of Applicant(s).....

.....

To the Comptroller,

The Patent Office,

25 Southampton Buildings,

Chancery Lane,

London, W.C.2.

Dated this 24th day of July, 1920.

R. S. Horne,

President of the Board of Trade.

APPENDIX IX

STATUTORY RULES AND ORDERS,
1920, No. 2118

TRADING WITH THE ENEMY Patents of Austrian and Bulgarian Nationals Vested in Custodian

ORDER OF THE BOARD OF TRADE, DATED 9TH NOVEMBER, 1920, UNDER SECTION 5 (1) OF THE TRADING WITH THE ENEMY AMENDMENT ACT, 1914 (5 GEO. 5, C. 12), AS TO "VESTED PATENTS," "VESTED APPLICATIONS" AND "RESTORED PATENTS."

This order is in the same terms as in the order in respect of German Nationals (*see* Appendix VII *post* p. 332) with the exception that Section 3 reads as follows—

3. An assignment or assurance *inter vivos* of a restored patent or a restored application shall not be made nor shall any licence be granted under a restored patent except after notice to and with the consent of the Board of Trade and any such purporting assignment or assurance *inter vivos* or any such purporting licence which may be made or granted except after such notice and with such consent shall be void and of no effect. And any devolution of a restored patent or of a restored application otherwise than by an assignment or assurance *inter vivos* shall not be operative unless and until assented to by the Board of Trade.

APPENDIX

ABBREVIATIONS TO TABLE OF CASES

A.C.		Law Reports, Appeal Cases.
Car. & K.		Carrington & Kirwan.
C. & P.		Carrington & Payne.
C.B.N.S.		Common Bench (New Series).
Ch.		Law Reports, Chancery Appeals (if preceded by a year and number) Law Reports, Chancery Division.
Ch. D.		Law Reports, Chancery Division.
Davies P.C.		Davies' Patent Cases.
De G., J. & S.		De Gex, Jones & Smith.
E. & Bl.		Ellis & Blackburn.
Eq.		Law Reports, Equity Cases.
Griff. L.O.C.		Griffin's Law Officers' Cases.
Griff. P.C.		Griffin's Patent Cases.
H.L.C.		House of Lords' Cases.
H. & N.		Hurlston & Norman.
K.B.		(preceded by a year and number) Law Reports, King's Bench Division.
L.J. (Ch.)		Law Journal (Chancery).
L.R.H.L.		Law Reports, English and Irish Appeal Cases.
L.R.P.C.		Law Reports, Privy Council Cases.
Mac. P.C.		Macrory's Patent Cases.
M. & G.		Manning & Granger.
Moo. P.C.		Moore's Privy Council Cases.
Moo. P.C.N.S.		Moore's Privy Council Cases (New Series).
Q.B.		(preceded by a year and number) Law Reports, Queen's Bench Division.
R.P.C.		Reports of Patent Cases.
T.L.R.		<i>Times</i> Law Reports.
W.P.C.		Webster's Patent Cases.

TABLE OF CASES CITED

1. A. F.'s Application, 31 R.P.C. 58; *manner of manufacture* [59].
2. Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd., 19 R.P.C. 213; 20 R.P.C. 161; 22 R.P.C. 145—
 (a) 20 R.P.C. 161; *manner of manufacture* [59].
 (b) 22 R.P.C. 145 (at p. 155); *inventive ingenuity* [69]; *manner of manufacture* [59].
 (c) 19 R.P.C. 213; *certificate of validity* [96].
3. Ackroyd & Best, Ltd. v. Thomas & Williams, 21 R.P.C. 403, 737; *claim for general principle* [53].

4. Acteingesellschaft für Anilin Fabrikation in Berlin v. Levenstein, 31 R.P.C. 177 (at p. 190); *intelligibility* [72]; *inventive ingenuity* [71].
5. Acteingesellschaft für Cartonnagen Industrie v. Temler & Seaman, 18 R.P.C. 6; *infringement*, *defence* [85]; *assignment*; *notice of equity* [108].
6. Adair's Patent, 6 A.C. 176; *extension* [123, 124, 129].
7. Adamant Stone, etc., Co. v. Corporation of Liverpool, 14 R.P.C. 11, 264; *inventive ingenuity* [71].
8. Adam's Patent, 16 R.P.C. 1; *extension* [129].
9. African Gold Recovery Co. v. Sheba Gold Mining Co., 14 R.P.C. 660; *licence* [112].
10. Ainsworth's Patent, 13 R.P.C. 76; *amendment* [120].
11. Allen v. Doulton, 4 R.P.C. 377; *amendment* [121].
12. Allen v. Horton, 10 R.P.C. 412; *certificate of particulars* [98]; *costs* [99, 102].
13. Allen v. Oates & Green, Ltd., 15 R.P.C. 298; *certificate of particulars* [98].
14. Allison's Patent, 15 R.P.C. 408; *amendments* [120].
15. Alsop's Patent, 24 R.P.C. 684, 733—
 - (a) 24 R.P.C. 733 (at p. 753); *utility* [64].
 - (b) 24 R.P.C. 684; *amendment* [118].
16. American Braided Wire Co. v. Thomson, 5 R.P.C. 113; 6 R.P.C. 518; 7 R.P.C. 152—
 - (a) 5 R.P.C. 113; 6 R.P.C. 518; *inventive ingenuity* [67, 69].
 - (b) 7 R.P.C. 152; *damages* [94]; *costs* [100].
17. Anderson v. Patent Oxonite Co., 3 R.P.C. 279; *assignment* [107].
18. Andrew's Patent, 24 R.P.C. 349; *costs* [100].
19. Appelby's Twin Roller Chain Co., Ltd. v. Albert Eadie Chain, Ltd., 16 R.P.C. 318; *threats* [163].
- 19a. Armstrong's Application, 39 R.P.C. 146, *abnormal priority* [305].
20. Armstrong's Patent, 13 R.P.C. 501; *amendment* [119]; *revocation* [148].
21. Arnold v. Bradbury, 6 Ch. 706; *construction* [53].
22. Ashton and Knowle's application, 27 R.P.C. 181; *opposition* [36].
23. Ashworth's Patent, Griff. L.O.C. 6; *explanation* [117]; *amendment* [118].
24. Atkins and Applegarth v. Castner Kellner Alkali Co., 18 R.P.C. 281 (at p. 294); *sufficiency of description* [74].
25. Automatic Coal Gas Retort Co. v. The Mayor, etc., of Salford, 14 R.P.C. 450; *inventive ingenuity* [71].
26. Automatic Weighing Machine Co. v. Combined Weighing Machine Co., 6 R.P.C. 120, 367; *costs* [100].
27. Automatic Weighing Machine Co. v. International Hygienic Society, 6 R.P.C. 475; *costs* [100, 101].
28. Automatic Weighing Machine Co. v. Knight, 6 R.P.C. 297; *costs* [99, 100].
29. Avery's Patent, 4 R.P.C. 152 (at p. 159); *revocation* [148].
30. B. A.'s application, 32 R.P.C. 348; *manner of manufacture* [59].
31. Badische Anilin und Soda Fabrik v. Hickson, 23 R.P.C. 149, 433—
 - (a) 23 R.P.C. 433; *infringement by vending the invention* [79].
 - (b) 23 R.P.C. 149; *costs* [99].
32. Badische Anilin und Soda Fabrik v. Isler, 23 R.P.C. 173 (at p. 180); *notice of restrictions* [114].
33. Badische Anilin und Soda Fabrik v. Johnson & Co., 14 R.P.C. 405, 919; *infringement* [80].
34. Badische Anilin und Soda Fabrik v. La Societe Chimique, etc., and Wilson, 14 R.P.C. 875; 15 R.P.C. 359—
 - (a) 14 R.P.C. 875; *costs* [101].
 - (b) 15 R.P.C. (at p. 369); *intelligibility* [72].

35. *Badische Anilin und Soda Fabrik v. Levinstein*, 2 R.P.C. 73 ; 4 R.P.C. 449—
 - (a) 2 R.P.C. ; *construction of specification* (at p. 90) [51] ; *infringement of combination* (at pp. 90 and 93) [86].
 - (b) 2 R.P.C. (at p. 91) ; *manner of manufacture* [59].
 - (c) 2 R.P.C. (at p. 84) ; *utility* [64].
 - (d) 4 R.P.C. (at p. 462) ; *workman* ; *construction of specification* [46].
 - (e) 4 R.P.C. (at p. 469) ; *sufficiency of description* [73].
 - (f) 4 R.P.C. (at p. 469) ; *construction of specification* [50].
36. *Barff and Bower's Patent*, 12 R.P.C. 383 ; *extension, accounts* [124].
37. *Baxter v. Marsden*, 22 R.P.C. 18 ; *inventive ingenuity* [70].
38. *Beavis v. Rylands Glass & Engineering Co.*, 17 R.P.C. 93 ; *inventive ingenuity* [70].
39. *Beck & Justice's Patent*. Griff. L.O.C. 10 ; *correction* [117] ; *amendment* [118].
40. *Bentley v. Fleming*, 1 Car. & K. 587 ; *secret communication* [61].
41. *Berliner and Others v. Edison Bell Consolidated Phonograph Co., Ltd.*, 16 R.P.C. 336 ; *threats* [163].
- 41a. *Best and Marshall's Patent*, 34 R.P.C. 205 (at p. 208) ; *test of anticipation* [37].
- 41b. *Bettington Boilers, Ltd.*, 38 R.P.C. 349 ; *extension of expired patent* [133].
42. *Betts v. Wilmott*, 6 Ch. 239 ; *implied licence* [88, 113].
43. *Bett's Patent*, 1 Moo. P.C.N.S. 49 ; *extension* [125].
44. *Birch v. Harrap & Co.*, 13 R.P.C. 615 ; *construction* [51] ; *certificate of validity* [97].
45. *Blackett v. Dickson & Mann, Ltd.*, 26 R.P.C. 73 ; *threat to infringe* [81].
46. *Blakey v. Latham*, 6 R.P.C. 184 ; *inventive ingenuity* (at p. 189) [65] ; *costs* [99].
47. *Bloxam v. Elsee*, 1 C. & P. 558 ; *sufficiency and intelligibility* [74] ; *invention of servant* [110].
48. *Board's Patent*, 25 R.P.C. 537 ; *extension* [130].
49. *Bodmer's Patent*, 6 Moo. P.C. 468 ; *extension* [129].
50. *Bonnard v. London General Omnibus Co., Ltd.*, 38 R.P.C. 1 ; *inventive ingenuity* [68, 70].
51. *Boult's Patent*, 26 R.P.C. 383 ; *abuse of monopoly* [152, 154].
52. *Bovill's Patent*, 1 Moo. P.C.N.S. 348 ; *extension* [130].
53. *Bowden's Patent*, 22 R.P.C. 49 (at p. 57) ; *amendment* [122].
54. *Bowden (E. M.) Patents Syndicate, Ltd. v. Smith & Co.*, 21 R.P.C. 438 ; *equitable assignment* [108].
55. *Bowden Brake Co. v. Bowden Wire, Ltd.*, 30 R.P.C. 561 ; *reason for amendment* [48].
56. *Boyd v. Horrocks*, 6 R.P.C. 152 ; *construction* [51].
57. *Boyd v. The Tootal Broadhurst Lee Co.*, 11 R.P.C. 175 ; *damages* [94] ; *costs* [101].
58. *Bradford Dyers Association, Ltd. v. Bury*, 19 R.P.C. 1 ; *intelligibility* ; *validity* [72].
59. *Bray v. Gardener*, 4 R.P.C. 40, 400—
 - (a) 4 R.P.C. (at p. 406) ; *sufficiency of description* [73]
 - (b) 4 R.P.C. 40 ; *amendment* [122].
60. *Bremner's Patent*, 26 R.P.C. 114, 449—
 - (a) 26 R.P.C. 114 ; *abuse of patent rights* [150].
 - (b) 26 R.P.C. 449 ; *abuse of monopoly* [152].
61. *Briggs v. Lardeur*, 2 R.P.C. 13 ; *infringement* [78, 80].
62. *British Dynamite Co. v. Krebs*, 13 R.P.C. 190 ; *workman* ; *construction of specification* [46, 49] ; *sufficiency of description* [73].
63. *British Liquid Air Co. v. British Oxygen Co.*, 25 R.P.C. 577 ; *costs* [100].

64. British Ore Concentration, Ltd. v. Minerals Separation, Ltd., 26 R.P.C. 124; 27 R.P.C. 33—
 - (a) 26 R.P.C. 138; *prior publication* [61, 62, 65].
 - (b) 27 R.P.C. 33; *intelligibility* [72].
65. British Thomson-Houston's Patent, 36 R.P.C. 251 (at pp. 257 and 258); *amendment* [118, 119].
66. British Thomson-Houston Co., Ltd. v. Duram, Ltd., 34 R.P.C. 117; 35 R.P.C. 161—
 - (a) 34 R.P.C. (at p. 146); *claims* [53].
 - (b) 35 R.P.C. (at pp. 176-178); *novelty* [62]; *inventive ingenuity* [65].
 - (c) 35 R.P.C. (at p. 179); *title* [18].
67. British Thomson-Houston Co., Ltd. v. Corona Lamp Co., 39 R.P.C. 49; *intelligibility* [72].
68. British United Shoe Co. v. A Fussell & Sons, Ltd., 25 R.P.C. 368, 631; 27 R.P.C. 205—
 - (a) 25 R.P.C. 368; *damages*; *staying inquiry* [93].
(At p. 631) *sufficiency of description* [21, 73, 75].
 - (b) 27 R.P.C. 205; *damages* [94].
69. British United Shoe Machinery Co., Ltd. v. H. Cloughton, Ltd., 23 R.P.C. 321; *claims for subordinate integers* [53].
70. British United Shoe Machinery Co., Ltd. v. Simon Collier, Ltd., 27 R.P.C. 567; *possession of infringing articles* [79].
71. British United Shoe Co. v. Standard Rotary Machinery Co., 33 R.P.C. 245, 373; 35 R.P.C. 33; *inventive ingenuity* [70].
72. British Vacuum Cleaner Co., Ltd. v. Suction Cleaners, Ltd., 21 R.P.C. 303; *inventive ingenuity* [66].
73. British Vacuum Co., Ltd. v. Exton Hotels Co., Ltd., 25 R.P.C. 617—
 - (a) (at p. 627); *construction* [47].
 - (b) *damages* [93]; *costs* [101].
74. British Vacuum Co., Ltd. v. London & South Western Rly. Co., 27 R.P.C. 649; 28 R.P.C. 77 (at p. 96); 29 R.P.C. 309; *inventive ingenuity* [66].
75. British Foreign & Colonial, etc., Co. v. Metropolitan Gas Meters, Ltd., 29 R.P.C. 303; *certificate of particulars* [99].
76. British Westinghouse Electrical and Manufacturing Co., Ltd. v. Braulik, 27 R.P.C. 209 (at p. 230); *inventive ingenuity* [67].
77. Brook v. Ashton, Ellis & Blackburn, 478; *inventive ingenuity* [69, 70].
78. Brooks v. Lamplugh, 15 R.P.C. 33; *claims* (at p. 49) [54]; *inventive ingenuity* [71].
79. Brooks v. Steele & Currie, 14 R.P.C. 46 (at p. 73); *construction of specification* [46].
80. Brooks (J. B.) & Co., Ltd. v. Lycett's Saddle and Motor Co., 21 R.P.C. 651; *amendment* [116].
81. Brooks (J. B.) & Co., Ltd. v. Rendall, Underwood & Co., Ltd., 24 R.P.C. 17; *certificate of validity* [97].
82. Brown v. Hastie & Co., 22 R.P.C. 85; *damages* [93].
83. Brown's Patent, 37 R.P.C. 52, 142—
 - (a) 37 R.P.C. 52; *extension, war losses* [132].
 - (b) 37 R.P.C. 142; *extension, war losses* [132].
84. Burt v. Morgan, 4 R.P.C. 278; *threats* [161].
85. C. & W.'s application, 31 R.P.C. 235; *manner of manufacture* [59].
86. Cardwell's Patent, 10 Moo. P.C. 488; *extension* [130].
87. Carpenter v. Smith, 1 W.P.C. 540; *public user* [60].
88. Carr's Patent, L.R. 4 P.C. 539; *extension, accounts* [124].
89. Carter v. Leyson, 19 R.P.C. 473; *inventive ingenuity* [70].
90. Cartwright v. Armalt, Davies P.C. 240; *assignment* [108].

91. Cassel Gold Extracting Co. v. Cyanide Recovery Syndicate, Ltd., 12 R.P.C. 232, 303 (at p. 243); *utility* [64].
92. Cerekel's Patent, 15 R.P.C. 500; *revocation* [147].
93. Challenger v. Royle, 4 R.P.C. 363; 36 Ch.D. 425; *threats* [162, 163].
94. Chamberlain & Hookham, Ltd. v. Bradford Corporation, 17 R.P.C. 762; 19 R.P.C. 78—
 (a) 17 R.P.C. 762; *costs* [101].
 (b) 19 R.P.C. 78; *costs* [100].
95. Chatwood's Patent Safe & Lock Co. v. Mercantile Bank of Lancaster, Ltd., 17 R.P.C. 23; *amendment* [119].
96. Church's Patents, 3 R.P.C. 95; *extension* [123, 130].
97. Claughten v. Foster, 21 R.P.C. 17; *certificate of validity* [97].
98. Clay v. Allcock & Co., Ltd., 23 R.P.C. 745 (at p. 750); *construction* [51]; *sufficiency of description* [75].
99. Clement Talbot, Ltd. v. Wilson and another, 24 R.P.C. 511; 26 R.P.C. 467; *damages* [95].
100. Clyde Nail Co. v. Russell, 32 R.P.C. 291 (at p. 306); *inventive ingenuity* [68].
101. Cochran's Patent, Griff. P.C. 304; *amendment* [117].
102. Cole v. Saqui, 6 R.P.C. 41; *certificate of particulars* [99].
103. Colley v. Hart, 7 R.P.C. 101; *threats* [163].
104. Combined Weighing Co. v. Automatic Weighing Co., 6 R.P.C. 502; *threats* [162, 163]; *threats*; *costs* [165].
105. Consolidated Pneumatic Tool Co., Ltd. v. Clark, 23 R.P.C. 666; *construction of specification* [47, 49, 52].
106. Cooper Patent Anchor Rail Joint Co. v. London County Council, 23 R.P.C. 289; *inventive ingenuity* [70].
107. Cooper's Application, 19 R.P.C. 53; *alleged invention* [2]; *manner of manufacture* [59].
108. Coppin v. Lloyd, 15 R.P.C. 373; *licence* [112].
109. Crampton v. Patents Investment Co., 5 R.P.C. 382; 6 R.P.C. 287—
 (a) 6 R.P.C. 287; *infringement* [86].
 (b) 5 R.P.C. (at p. 404); *certificate of validity* [97].
110. Crane v. Price, W.P.C. 393; 4 M. & G. 580; *inventive ingenuity* [67].
111. Cropper v. Smith, 1 R.P.C. 81 (at pp. 89–90); *construction* [47, 49]; *amendment* [116].
112. Crosfield v. Techno-Chemical Laboratories, 30 R.P.C. 297; (at p. 312) *validity* [56]; *intelligibility* [73].
113. Curwen, re, 30 R.P.C. 128; *imported invention* [58]; *opposition to grant* [35].
114. Cummings v. Stewart, 30 R.P.C. 1; *licence* [112].
115. Cutlan v. Dawson, 14 R.P.C. 249; *licence* [112].
116. Dansk Rekyrlrifel Syndicat Actieselskab v. Snell, 25 R.P.C. 421; *legal assignments, prior charge* [108].
117. Darby's Patent, 8 R.P.C. 380; *extension of term* [124, 130].
118. Davidson's Patent, 37 R.P.C. 252; *extension, war losses* [132].
119. Davies' Patent, 11 R.P.C. 27; *extension* [124, 129].
120. Davies' Patent, 28 R.P.C. 50; *amendment* [122].
121. Day, Barrett & Elers, Ltd. v. Foster, 7 R.P.C. 54; *threats* [163].
122. Deacon's Patents, 4 R.P.C. 119; *extension* [124].
123. Deeley v. Perkes, 13 R.P.C. 581; *revocation* [148].
124. Dege's Patent, 12 R.P.C. 448; *revocation* [146].
125. Dellwik's Patent, 15 R.P.C. 687 (at p. 682); *sufficiency of description* [74].
126. Delta Metal Co. v. Maxim Nordenfellt Co., 8 R.P.C. 247; *certificate of validity* [97].
127. Dey Patents Co. v. Howard Bros., 20 R.P.C. 21; *infringement, damages* [94].

128. Dolland's Case, 1 W.P.C. 43; *first inventor* [57]; *novelty, secret user* [60].
129. Douglas v. Pintoch's Patent Lighting Co., 13 R.P.C. 673; *threats* [162].
130. Dowling v. Billington, 7 R.P.C. 191; *infringement injunction* [90]; *inventive ingenuity* [71].
131. Downton's Patent, 1 W.P.C. 565; *extension* [127].
132. Dowson Taylor & Co., Ltd. v. The Drosophore Co., Ltd., 12 R.P.C. 95; *threats* [163].
133. Driffield, etc., Co. v. Waterloo, etc., Co., 3 R.P.C. 46; *threats, continuing* [164].
134. Duckett & Son, Ltd. v. Sankey & Son, 16 R.P.C. 357; *inventive ingenuity* [70].
135. Duckett & Son, Ltd., and Another v. Whitehead, 12 R.P.C. 187 (at p. 191); *inventive ingenuity* [67, 71].
136. Dudgeon v. Thompson, 3 A.C. 34; *construction, combinations* [52]; *injunction dissolved by amendment* [91].
137. Duncan v. Lockerbie & Wilkinson, Ltd., 29 R.P.C. 454; *infringement, registered owner may sue* [78]; *damages* [92]; *assignments* [107].
138. Duncan & Wilson's Patent, 1 R.P.C. 257; *extension, accounts* [124].
139. Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co., 18 R.P.C. 313; *infringement* [79].
140. Dunlop Pneumatic Tyre Co. v. Excelsior Tyre Cement, etc., Co., 18 R.P.C. 209; *infringement, repairs and reconstruction* [80].
141. Dunlop Pneumatic Tyre Co. v. Holborn Tyre Co., Ltd., 18 R.P.C. 222; *infringement, repairs and reconstruction* [80].
142. Dunlop Pneumatic Tyre Co. v. Moseley & Sons, Ltd., and another, 21 R.P.C. 53, 274 (at p. 60); *construction combinations* [52]; (at pp. 280 and 281) *infringement* [80, 81].
143. Dunlop Pneumatic Tyre Co. v. Neal, 16 R.P.C. 247; *infringement, fair repair* [80].
144. Easterbrook v. Great Western Rly. Co., 2 R.P.C. 201; *utility* [63].
145. Edison & Swan Co. v. Holland, 5 R.P.C. 459; 6 R.P.C. 243—
 - (a) 6 R.P.C. (at pp. 279, 280); *workman; construction of specification* [46].
 - (b) 6 R.P.C. (at p. 244); *construction of specification* [47].
 - (c) 6 R.P.C. 243; *sufficiency of description* [74]; *certificate of validity* [97].
 - (d) 5 R.P.C. (at p. 483); *delivery up of infringing articles* [96].
146. Edison & Swan Co. v. Woodhouse, 3 R.P.C. 167; 4 R.P.C. 98—
 - (a) 4 R.P.C. (at pp. 106–108); *sufficiency of description* [73, 75].
 - (b) 3 R.P.C. 167, 183; *costs* [100].
147. Edison-Bell Phonograph Corporation v. Edison Phonograph Co., 11 R.P.C. 33; *certificate of validity* [97].
148. Edison United Phonograph Co. v. Young, 11 R.P.C. 489; *certificate of validity* [97].
149. Edlin v. Pneumatic Tyre and Booth's Cycle Agency, Ltd., 10 R.P.C. 311; *threats* [163].
150. Edward's Patent, 11 R.P.C. 461; *opposition to grant* [41].
151. Ehrlich v. Ihlee, 5 R.P.C. 437—
 - (a) *construction of specification* [51].
 - (b) (at p. 455); *utility* [64].
 - (c) *infringement, improvements* [86].
152. Electric Construction Co. v. Imperial Tramways Co., 16 R.P.C. 631; 17 R.P.C. 537—
 - (a) 16 R.P.C. (at p. 638); *construction of specification* [48].
 - (b) 17 R.P.C. 537; *claims* [53].
153. Elias v. Grovesend Tinplate Co., 7 R.P.C. 455; *first and true inventor* [57]; *inventive ingenuity* [68, 69].



154. *Elmslie v. Boursier*, 9 Eq. 217; *infringement by importation* [80].
155. *Engels v. Hubert Unchangeable Eyelet Syndicate, Ltd.*, 19 R.P.C. 201; *threats* [162].
156. *English & American Machinery Co. v. Gare Machine Co.*, 11 R.P.C. 627; *threats* [163].
157. *English & American Machinery Co. v. Union Boot Co.*, 11 R.P.C. 367; *infringement, particulars of objection* [83].
158. *Estler v. Adjustable Shelving, etc., Co., Ltd.*, 32 R.P.C. 501; *inventive ingenuity* [67].
159. *Farbenfabriken vorm. F. Bayer & Co. v. Bowker*, 8 R.P.C. 389; *costs* [100].
160. *Fawcett v. Homan & Rodgers*, 13 R.P.C. 398—
 - (a) *utility* [63].
 - (b) (at p. 405); *inventive ingenuity* [67, 71].
161. *Fellows v. Lench*, 32 R.P.C. 313, 525; *inventive ingenuity* [70].
162. *Fenner v. Wilson & Co.*, 10 R.P.C. 283; *threats* [164].
163. *Ferranti's Patent*, 18 R.P.C. 518; *extension* [123].
164. *Ferranti v. British Thompson-Houston Co.*, 19 R.P.C. 147; *costs* [100].
165. *Fletcher's Patent*, 10 R.P.C. 252; *register of patents* [105].
166. *Flour Oxidizing Co., Ltd. v. Carr & Co., Ltd.*, 25 R.P.C. 428—
 - (a) (at p. 448); *construction of specification* [47].
 - (b) (at p. 460); *stay of inquiry as to damages* [93].
167. *Flour Oxidizing Co., Ltd. v. Hutchinson*, 26 R.P.C. 597; *certificate of validity* [97]; *costs* [100].
168. *Fox v. Astrachans, Ltd.*, 27 R.P.C. 377; *prior publication* [61].
169. *Francis' Application*, 27 R.P.C. 86; *opposition* [38, 40].
170. *French v. O'Hanlon*, 32 R.P.C. 553; *inventive ingenuity* [69].
171. *Frearson v. Loe*, 9 Ch.D. 48; *injunction* [91].
172. *Gadd v. Mayor, etc., of Manchester*, 9 R.P.C. 516—
 - (a) (at p. 525); *inventive ingenuity* [65].
 - (b) *costs* [100].
 - (c) *disconformity* [41].
173. *Gall v. O'Neill & Brown*, 27 R.P.C. 18; *certificate of validity* [97].
174. *Galloway's Patent*, 1 W.P.C. 520, 724; (at p. 525) *experiment* [60]; (at p. 727) *extension* [130].
175. *Gandy v. Reddaway*, 2 R.P.C. 49; *sufficiency of description* [75].
176. *Garnett's Application*, 16 R.P.C. 154; *opposition* [38, 40].
177. *Gascoine's Patent*, 27 R.P.C. 78; *revocation (Sect. 26)* [149].
178. *Gavioli et Cie v. Shepherd*, 17 R.P.C. 157; *damages* [94].
180. *Geipel v. Lord Mayor of Manchester*, 21 R.P.C. 41; *inventive ingenuity* [71].
181. *General Accident Assurance Corporation, 1904*, 1 Ch. 147; *equitable owner* [111].
182. *Gerhold v. Radnall*, 30 R.P.C. 283; *certificate of validity* [97].
183. *Germ Milling Co. v. Robinson*, 3 R.P.C. 254; *certificate of particulars* [98].
184. *Gillette Safety Razor Co. v. Luna Safety Razor Co.*, 27 R.P.C. 527; *amendment* [122].
185. *Gillies v. Gane*, 34 R.P.C. 21; *inventive ingenuity* [68].
186. *Glover & Co. (W. T.), Ltd. v. American Steel and Wire Co.*, 19 R.P.C. 102; *intelligibility* [72]; *inventive ingenuity* [70].
187. *Goddard v. Lyon*, 11 R.P.C. 354; *inventive ingenuity* [71].
188. *Goerz & Hoegh's Patent*, 12 R.P.C. 370; *revocation* [147].
189. *Gold Ore Treatment of Western Australia, Ltd. v. Golden Horseshoe Estates Co., Ltd.*, 36 R.P.C. 95—
 - (a) (at p. 137); *anticipation* [62].
 - (b) (at p. 132); *sufficiency of description* [75].

190. Goldstein's Patent, 27 R.P.C. 289; *amendment* [118].
191. Gosnell v. Bishop, 5 R.P.C. 151; *inventive ingenuity* [67]; *infringement* [86].
192. Gramophone & Typewriter, Ltd. v. Ullman, 23 R.P.C. 260, 752; *inventive ingenuity* [71].
193. Guyot v. Thompson, 11 R.P.C. 541; *licence* [112].
194. Gwynne v. Drysdale, 3 R.P.C. 65; *infringement of combination* [86].
195. H. S. J.'s Application, 31 R.P.C. 47; *patent of addition* [32].
196. Haddan's Patent, Griff. L.O.C. 12; *amendment* [119].
197. Haggermacker's Patent, 15 R.P.C. 431; *revocation* [148].
198. Hale's Patent, 37 R.P.C. 171; *use by the Crown* [138].
199. Hall v. Stepney Spare Motor Wheel, Ltd., 27 R.P.C. 233; *threats* [164].
200. Hamilton Adam's Application, 35 R.P.C. 90; *manner of manufacture* [59].
201. Hamlyn v. Wood, 1891, 2 Q.B. 488; *licence* [112].
202. Hardmuth v. Baker & Son, 21 R.P.C. 505; *bona fides* [75].
203. Harris v. Rothwell, 3 R.P.C. 383; 4 R.P.C. 225; *prior publication in foreign language* [61].
204. Harrison Patents Co., Ltd. v. Nicholson (W. N.) & Sons, Ltd., 25 R.P.C. 393; *construction* (at p. 405) [53].
205. Harrison v. Anderston Foundry Co., 1 A.C. 574; *claim* (at p. 581) [52].
206. Harwood v. G. N. Rly Co., 11 H.L.C. 654; *inventive ingenuity* [68].
207. Haslam v. Hall, 5 R.P.C. 144; *certificate of validity* [97].
208. Haskell Golf Ball Co. v. Hutchinson & Main, 21 R.P.C. 497; *threats* [163].
209. Haskell Golf Ball Co. v. Hutchinson & Main, 22 R.P.C. 478; 23 R.P.C. 301; 25 R.P.C. 194—
 (a) 23 R.P.C. 301; 25 R.P.C. 194; *inventive ingenuity* [68].
 (b) 22 R.P.C. 478 (at p. 493); *sufficiency of description* [73]; *bona fides* [75].
210. Hatmaker v. Joseph Nathan, 34 R.P.C. 317; *utility* [63, 64].
211. Hatschet's Patent, 26 R.P.C. 228; *abuse of monopoly* [153].
212. Hattersley & Jackson's Patent, 15 R.P.C. 497; *revocation* [146].
213. Hattersley & Jackson's Patent, 21 R.P.C. 233; *amendment* [118].
214. Hattersley (George) & Sons, Ltd. v. Hodgson (George) Ltd., 21 R.P.C. 517; *sufficiency of specification* [74].
215. Haydock v. Bradbury, 4 R.P.C. 74; *certificate of validity* [97].
216. Hayward v. Hamilton, Griff. P.C. 115; *inventive ingenuity* (at p. 121) [67].
217. Hazlehurst v. Rylands, 9 R.P.C. 1; *assignment* (at p. 7) [107].
218. Heald's Patent, 8 R.P.C. 429; *servant's inventions* [110].
219. Heap v. Hartley, 5 R.P.C. 603; 6 R.P.C. 495—
 (a) 5 R.P.C. 603; *notice of equity* [114].
 (b) 6 R.P.C. 495 (at p. 500); *infringement, licensee's position* [78]; *assignment* [107]; *licence* [111].
220. Heath v. Unwin, 2 W.P.C. 236; *construction* (at p. 245) [51].
221. Heath's Patent, 2 W.P.C. 247; *extension* [126].
222. Heine Solly & Co. v. Coninco Incandescent Light Co., 21 R.P.C. 202; *inventive ingenuity* [71].
223. Henderson's Patent, 18 R.P.C. 449; *extension* [124, 129, 130].
224. Hennebique's Patent, 28 R.P.C. 41; *amendment* [119].
225. Hensee v. Hardie, 11 R.P.C. 421; *infringement, particulars* [83].
226. Herbert's Patent, L.R. 1 P.C. 399; *extension* [125].
227. Herrburger, Schwander et Cie v. Squire, 5 R.P.C. 581; *threats* (at p. 595) [163].
228. Hickton's Patent Syndicate v. Patents, etc., Improvement Co., 26 R.P.C. 339; *inventive idea* [66].
229. Hills v. London Gas Light Co., 5 H. & N. 312; *novelty, secret user* [60].

230. Hill's Patent, 1 Moo. P.C.N.S. 258; *extension* [124, 129].
231. Hill's Patent, 32 R.P.C. 475; *abuse of monopoly* [152].
232. Hill v. Evans, 31 L.J. (Ch.) 457; *prior publication* (at p. 463) [61, 62].
233. Hinks v. Safety Lighting Co., 4 Ch.D. 607—
 - (a) *claims* (at p. 612) [52].
 - (b) *inventive ingenuity* (at p. 615) [67].
234. Hocking & Co. v. Fraser, 3 R.P.C. 3; *delivery up of infringing articles* (at p. 7) [96]; *costs* [100].
235. Hoe v. Foster, 16 R.P.C. 33; *experiment* [60].
236. Holmes v. Associated Newspapers, Ltd., 27 R.P.C. 136; (at p. 149) *claims* [54].
237. Hopkin's Patent, 27 R.P.C. 72; *opposition*; *specific reference* [38].
238. Hopkinson v. St. James and Pall Mall Electric Light Co., Ltd., 10 R.P.C. 46; *sufficiency of description* [75]; *suspending injunction* [91]; *damages* [92]; *costs* [100].
239. Hopkinson's Patent, 14 R.P.C. 5; *extension* [129].
240. Horsey's Patent, 1 R.P.C. 225; *extension* [123].
241. Househill Co. v. Neilson, 1 W.P.C. 673—
 - (a) *abandoned user* (at p. 713) [60].
 - (b) *anticipation* (at p. 710) [60].
242. Hudson, Scott & Sons, Ltd. v. Barringer, etc., Ltd., 23 R.P.C. 502; *inventive ingenuity* [70].
243. Hughes' Patent, 4 A.C. 174; *extension* [125, 130].
244. Hughes & Kennaugh's Application, 27 R.P.C. 281; *opposition, evidence* [44].
245. Humpherson v. Syer, 4 R.P.C. 407; *want of novelty* [60].
246. Hutchinson's Patent, 14 Moo. P.C. 364; *extension* [123, 124].
247. Incandescent Gas Light Co. v. Brogden, 16 R.P.C. 179; *procuring infringement* [80]; *restrictions on sale* [114].
248. Incandescent Gas Light Co. v. Cantelo, 12 R.P.C. 262; *restrictions on sale* [88, 114].
249. Incandescent Gas Light Co. v. De Mare Light Co., 13 R.P.C. 301; (at p. 345) *infringement* [86]; *costs* [100].
250. Incandescent Gas Light Co. v. New Incandescent Mantle Co. and others, 15 R.P.C. 81; *aid and abet infringement* (at p. 83) [80].
251. Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co., Ltd., 25 R.P.C. 61; *claims* [53].
252. Innes v. Short & Beal, 15 R.P.C. 449; *infringement* [80].
253. Jackson v. Weltenhulmes, 1 R.P.C. 105; *claims* [52].
254. Jameson's Patent, 19 R.P.C. 246; *revocation* [146].
255. Jardine v. King, Mendham & Co., 13 R.P.C. 411; *certificate of validity* (at p. 428) [97]; *certificate of particulars* [98].
256. Jenkins v. Hope, 13 R.P.C. 57; *damages* [93].
257. Johnson's Application, 19 R.P.C. 56; *manner of manufacture* [59].
258. Johnson's Patent, 13 R.P.C. 659; *amendment* [118].
259. Johnson's Patent, 25 R.P.C. 709; *extension* [123, 124, 125, 126, 127, 128, 130].
260. Johnson's Patent, 26 R.P.C. 52; *abuse of monopoly* [153].
261. Justice's Patent, 18 R.P.C. 241; *revocation* [148].
262. Kane & Patterson v. Boyle & Co., 18 R.P.C. 325; *damages* [92]; *certificate of validity* [96].
263. Kaye v. Chubb, 4 R.P.C. 289; 5 R.P.C. 641—
 - (a) 5 R.P.C. 641 (at p. 652); *anticipation* [62].
 - (b) 5 R.P.C. 641; *infringement of combination* [86].
 - (c) 4 R.P.C. 289; *costs* [99].
265. Keith & Blackman Co., Ltd. v. Tilley High Pressure Gas Sign, Ltd., 30 R.P.C. 537; *inventive ingenuity* [69].

266. *Kelvin v. Whyte, Thompson & Co.*, 25 R.P.C. 177; *utility* [64].
267. *Kensington, etc., Lighting Co. v. Fox*, 8 R.P.C. 277; *equitable assignee* (at p. 280) [108]; *threats* [161].
268. *Kent's Patent*, 26 R.P.C. 666; *abuse of monopoly* [152].
269. *Klaber's Patent*, 22 R.P.C. 405; *intelligibility* (at p. 416) [72]; *bona fides* [76]; *amendment* [119].
270. *Knight v. Argyll's, Ltd.*, 30 R.P.C. 321; *intelligibility* (at p. 348) [72].
271. *Kopp v. Rosenwald*, 20 R.P.C. 154; *intelligibility* [72].
272. *Kurtz v. Spence*, 5 R.P.C. 161; *threats* [162].
273. *Laine v. Herold*, 9 R.P.C. 447; *variation of detail, infringement* [86].
274. *Lake's Patent*, 8 R.P.C. 227; *extension, accounts* [124].
275. *Lake's Patent*, 26 R.P.C. 443; *extension, accounts* [124]; *abuse of monopoly* [152].
276. *Lancashire Explosives Co. v. Roburite Explosives Co.*, 14 R.P.C. 303—
 (a) *construction* (at p. 311) [46].
 (b) *claim* (at p. 312) [52].
277. *Lancaster's Patent*, 2 Moo. P.C.N.S. 189; *extension* [125].
278. *Lanchester's Application*, 30 R.P.C. 130; *opposition, master patent* [38].
279. *Land's Patent*, 27 R.P.C. 481; *restoration* [133].
280. *Lane Fox's Patent*, 9 R.P.C. 411; *extension* [125].
281. *Lang's Patent*, 7 R.P.C. 469; *amendment* [119].
282. *Lang v. Whitecross Wire & Iron Co.*, 7 R.P.C. 389; *amendment* [121].
283. *Lawrence & Kennedy's Patent*, 27 R.P.C. 252; *extension* [129].
284. *Lawrie v. Baker*, 2 R.P.C. 213; *costs* [99].
285. *Lawson v. Macpherson & Co.*, 14 R.P.C. 696; *licence, assignment of* [113].
286. *Leadbeater v. Kitchin*, 7 R.P.C. 235; *construction* [47].
287. *Leeds Forge Co. v. Deighton's Patent Fuel Co.*, 25 R.P.C. 209; *damages* [94].
288. *Lewis v. Marling*, 1 W.P.C. 490; *bona fides* [76].
289. *Lewis & Sterkler's Patent*, 14 R.P.C. 24; *revocation* [146].
290. *Leyland v. Boldy*, 30 R.P.C. 249; *inventive ingenuity* [69].
291. *Lifeboat Co. v. Chambers*, 8 R.P.C. 418; *sufficiency of description* (at p. 421) [74].
292. *Lilley v. Artistic Novelties, Ltd.*, 30 R.P.C. 18; *amendment* [121].
293. *Lines v. Usher*, 13 R.P.C. 685; 14 R.P.C. 206; *licence, royalties* [113].
294. *Linotype and Machinery, Ltd. v. Hopkins*, 25 R.P.C. 665; 27 R.P.C. 109—
 (a) 27 R.P.C. 109 (at p. 112); *intelligibility* [72]; *bona fides* [76].
 (b) 25 R.P.C. 665; *covenants to communicate; improvements* [109].
295. *Lister v. Norton*, 3 R.P.C. 199 (at p. 203); *construction* [47, 52]; *intelligibility* [72].
296. *Lodge's Patent*, 28 R.P.C. 365; *extension* [129, 130].
297. *Longbottom v. Shaw*, 6 R.P.C. 510; *certificate of particulars* [98].
298. *Low's Patent*, 8 Moo. P.C. 1; *extension* [126].
299. *Lynch & H. Wilson & Co., Ltd. v. John Phillips & Co.*, 25 R.P.C. 694; *infringement, improvements* [86].
300. *Lyon v. Goddard*, 10 R.P.C. 334; *inventive ingenuity* [67]; *sufficiency of description* [74].
301. *Lyon's Patent*, 11 R.P.C. 537; *extension* [130].
302. *Mackie v. Berry*, 2 R.P.C. 146; *infringement* [86].
303. *Markwick's Patent*, 13 Moo. P.C. 310; *extension* [124].
304. *McCulloch's Patent*, 25 R.P.C. 684; *extension* [129].
305. *McDougal's Patent*, 5 Moo. P.C.N.S. 1; *extension* [124].
306. *McFeely's Application*, 29 R.P.C. 386; *patent of addition* [31].
307. *Mackelean v. Rennie*, 13 C.B.N.S. 52; *construction* (at p. 58) [49].
308. *McLean's Patent*, 15 R.P.C. 418; *extension, accounts* [124].

309. *McNaught v. Dawson*, 22 R.P.C. 389; *inventive ingenuity* [65].
310. *McNeill and The Pearson Fire Alarm, Ltd.*, Application, 24 R.P.C. 680; *opposition* [35].
311. *Mann & Co. v. Furnival & Co.*, 31 R.P.C. 165; 349; *inventive ingenuity* [70]; *certificate of particulars* [98].
312. *Marconi v. British Radio Telegraph Co.*, 28 R.P.C. 181 (at p. 217); *construction* [51, 52].
313. *Maxim Nordenfelt Guns, etc., Ltd. v. Anderson*, 14 R.P.C. 371; *sufficiency of description* (at p. 385) [74].
314. *Mercedes Daimler Co.'s Patents*, 27 R.P.C. 409, 762; *abuse of monopoly* [152].
315. *Mercedes Daimler Motor Co. v. Maudsley Motor Co.*, 32 R.P.C. 149; *sufficiency of description* (at p. 160) [73].
316. *Mercedes Daimler Motor Co. v. F.I.A.T. Motor Car Co.*, 30 R.P.C. 369 (at p. 381); 32 R.P.C. 393 (at p. 404); *novelty* [62]; *inventive ingenuity* [65].
317. *Merryweather's Patent*, 29 R.P.C. 64; *revocation* [148].
318. *Merten's Patent*, 31 R.P.C. 373; *inventive idea* [66].
319. *Meters, Ltd. v. Metropolitan Gas Meters, Ltd.*, 27 R.P.C. 721; 28 R.P.C. 157—
 - (a) 27 R.P.C. 721; *damages* [95].
 - (b) 28 R.P.C. (at p. 164); *damages* [95].
320. *Metropolitan etc., Wagon Co., Ltd., and Greg's Patent*, 37 R.P.C. 266; *extension, war loss* [131].
321. *Meyer's Application*, 16 R.P.C. 526; *opposition, locus standi* [39].
322. *Miller & Co. v. Clyde Bridge Steel Co.*, 9 R.P.C. 470—
 - (a) *claim* (at p. 480) [54].
 - (b) *infringement of combination* (at p. 474) [86].
323. *Miller's Patent*, 15 R.P.C. 205; *public sale, anticipation* (at p. 213) [60].
324. *Mills v. Carson*, 10 R.P.C. 9; *licence* [112, 113].
325. *Mouchel v. Coignet*, 24 R.P.C. 229 (at p. 246); *discovery* [59].
326. *Monnet v. Beck*, 14 R.P.C. 777—
 - (a) 14 R.P.C. 777 (at p. 847); *sufficiency of description* [74].
 - (b) 14 R.P.C. (at p. 850); *costs* [99].
327. *Montgomerie v. Paterson*, 11 R.P.C. 221—
 - (a) *sufficiency of description* (at p. 232) [74].
 - (b) *infringement* (at p. 237) [81].
328. *Moore v. Thompson*, 7 R.P.C. 325; *infringement* [86].
329. *Morgan's Patent*, 5 R.P.C. 186; *revocation* [146].
330. *Morgan v. Seward*, 1 W.P.C. 170; (at p. 194) *public sale, anticipation* [60]; (at p. 175) *bona fides* [76].
331. *Morgan v. Windover*, 7 R.P.C. 131; *inventive ingenuity* [68]; *certificate of particulars* [99].
332. *Morris & Bastert v. Young*, 12 R.P.C. 455; *certificate of validity* [97].
333. *Morrison v. Asplen*, 21 R.P.C. 557; *certificate of validity* [97].
334. *Moseley v. Victoria Rubber Co.*, 4 R.P.C. 241; *experiment* [60].
335. *Moser v. Marsden*, 13 R.P.C. 24; *amendment* [120].
336. *Müller's Patent*, 24 R.P.C. 465; *revocation* [146].
337. *Muntz's Patent*, 2 W.P.C. 113; *extension* [125].
338. *Murchland v. Nicholson*, 10 R.P.C. 417; *construction* (at p. 423) [48].
339. *Nairn's Patent*, 8 R.P.C. 444; *amendment* [118].
340. *National Phonograph Co. of Australia v. Menck*, 28 R.P.C. 229; *implied licence* [113, 114].
341. *Neilson v. Betts*, L.R. 5 H.L. 1; *test of anticipation* (at p. 17) [62].
342. *Natural Colour, etc., Co. v. Bioschemes, Ltd.*, 32 R.P.C. 256; *intelligibility* [72].
343. *Nettlefolds v. Reynolds*, 9 R.P.C. 270; *certificate of particulars* [98].

344. *Newell v. Elliott*, 4 C.B.N.S. 269; *experiment* [60].
345. *New Conveyor Co. v. Edinburgh Commissioners*, 21 R.P.C. 147; *amendment* [121].
346. *New Incandescent Gas Light Co., Ltd. v. Howlett*, 30 R.P.C. 169; *claim* [52]; *infringement colourable imitation* [86].
347. *New Things, Ltd.*, 31 R.P.C. 45; *opposition*, "*locus standi*" [39, 44].
348. *New Vacuum Heating Co. v. Steel & Wilson*, 32 R.P.C. 162; *inventive ingenuity* [71].
349. No. 9 Bomore Road, 1906, 1 Ch. 359; *equitable owner* [111].
350. *Nobel's Explosives Co., Ltd. v. Anderson*, 11 R.P.C. 115; *construction* [51]; *costs* [99].
351. *Normandy's Patent*, 9 Moo. P.C. 452; *extension* [130].
352. *Norton's Patent*, 1 Moo. P.C.N.S. 339; *extension* [124].
353. *North British Rubber Co. v. Gormully & Jeffery Co.*, 13 R.P.C. 691; *infringement improvements* [86].
354. *North Eastern Marine Engineering Co. v. Leeds Forge Co.*, 23 R.P.C. 96, 529; *revocation* [146].
355. *Northern Press and Engineering Co., Ltd. v. Hoe*, 23 R.P.C. 417, 613; *inventive ingenuity* [70].
356. *Nussey and Leachman's Patent*, 7 R.P.C. 22; *extension* [130].
357. *Nuttall v. Hargreaves*, 8 R.P.C. 273; *certificate of particulars* [98].
358. *Ormston v. Clarke*, 13 C.B.N.S. 337; *inventive ingenuity* [70].
359. *Osborn and another's Patent*, 26 R.P.C. 819; *abuse of monopoly* [152].
360. *Osram Lamp Works, Ltd. v. Pope's Electric Lamp Co.*, 34 R.P.C. 369—
 - (a) *construction* (at p. 384) [46].
 - (b) *construction* [at p. 391] [46, 50].
 - (c) *utility* [64]; *inventive ingenuity* [68].
361. *Otto v. Steele*, 3 R.P.C. 109—
 - (a) *construction* [47].
 - (b) *prior publication* (at p. 110) [61].
 - (c) *costs* [101].
362. *Parkinson v. Simon*, 11 R.P.C. 493; 12 R.P.C. 403—
 - (a) 11 R.P.C. 493; *construction* [48].
 - (b) 11 R.P.C. 493; *construction* (at p. 503) [49].
 - (c) 11 R.P.C. 493; *claims* (at p. 502) [53].
 - (d) 12 R.P.C. 403; *construction* (at p. 407) [47, 51].
 - (e) 12 R.P.C. 403; *construction* (at p. 411) [51].
363. *Parkinson Patents*, 13 R.P.C. 509; *amendment* [119].
364. *Parnell's Patent*, 5 R.P.C. 126; *register of patents* [105].
365. *Patent Exploitation, Ltd. v. Siemens Bros. & Co., Ltd.*, 20 R.P.C. 225; 21 R.P.C. 541—
 - (a) 20 R.P.C. 225 (at p. 234); *construction* [51].
 - (b) 21 R.P.C. 541 (at p. 549); *construction* [51].
366. *Paterson v. Gas Light & Coke Co.*, 3 A.C. 239; *want of novelty* [60].
367. *Paterson's Patent*, 6 Moo. P.C. 469; *extension* [125, 126].
368. *Peach's Patent*, 19 R.P.C. 65; *extension* [123].
369. *Peckover v. Rowland & Co.*, 10 R.P.C. 234; *infringement of combination* (at p. 238) [86].
370. *Penn v. Biddy*, 2 Ch. 127; *inventive ingenuity* (at p. 136) [68].
371. *Pessers v. Haydon*, 26 R.P.C. 58; *illegitimate use; validity* [59].
372. *Peters v. Owen*, 15 R.P.C. 663; *certificate of particulars* [98].
373. *Petman v. Bull*, 3 R.P.C. 390; *damages, inquiry* (at p. 393) [93].
374. *Philpot v. Hanbury*, 2 R.P.C. 33—
 - (a) *slight utility* (at p. 37) [64].
 - (b) *intelligibility* (at p. 38) [72].
375. *Phillips v. Ivel Cycle Co.*, 7 R.P.C. 77; *costs* [99].

376. *Pickard v. Prescott*, 7 R.P.C. 361 ; 9 R.P.C. 195—
 - (a) 7 R.P.C. 361 (at p. 365) *sufficiency of description* [75].
 - (b) 9 R.P.C. (at p. 200) ; *prior publication* [61].
377. *Pirrie v. York Street Spinning Co.*, 11 R.P.C. 429 ; *inventive ingenuity* [69].
378. *Plimpton v. Malcolmson*, 3 Ch.D. 531—
 - (a) *prior publication* (at p. 557) [61].
 - (b) *validity ; intelligibility* (at p. 576) [72].
 - (c) *sufficiency of description* (at p. 561) [73].
379. *Pneumatic Tyre Co. v. Puncture Proof, etc., Tyre Co.*, 15 R.P.C. 405 ; 16 R.P.C. 209—
 - (a) 15 R.P.C. (at p. 408) ; *damages* [95] ; *costs* [101].
 - (b) 16 R.P.C. (at p. 212) ; *damages* [95].
380. *Pneumatic Tyre Co. v. East London Rubber Co.*, 14 R.P.C. 104 ; *certificate of validity* [97].
381. *Pneumatic Tyre Co. v. Caswell*, 13 R.P.C. 375 (at p. 380) ; *inventive ingenuity* [71].
382. *Pooley v. Pointon*, 2 R.P.C. 167 ; *costs* [99].
383. *Porter v. Freudenberg*, 1915, 1 K.B. 857 ; *infringement during war* [143].
384. *Poulsen's Patent*, 30 R.P.C. 597 ; *extension* [123, 125, 127, 129].
385. *Post Card Automatic Supply Co. v. Samuel*, 6 R.P.C. 560 ; *infringement, defence* [85].
386. *Presto Gear Case and Components Co., Ltd. v. Orme, Evans & Co., Ltd.*, 18 R.P.C. 17 ; *construction* [49].
387. *Proctor v. Bayley*, 6 R.P.C. 538 ; *injunction* [90].
388. *Proctor v. Bennis*, 4 R.P.C. 333 ; *construction* [51].
389. *Proctor v. Sutton*, 5 R.P.C. 184 ; *costs* [101].
390. *Pugh v. Riley Cycle Co., Ltd.*, 30 R.P.C. 32, 514 ; 31 R.P.C. 266—
 - (a) 30 R.P.C. 32, 514 ; *prior grant* (at pp. 43, 524, 525, 529) [58].
 - (b) 31 R.P.C. 266 ; *inventive ingenuity* [70].
391. *R. v. Comptroller of Patents*, 16 R.P.C. 233 ; *jurisdiction* [5].
- 391a. *R. v. County Court Judge of Halifax*, 8 R.P.C. 338 ; *county court jurisdiction* [79].
392. *Ralston's Patent*, 26 R.P.C. 313 ; *revocation* [148].
393. *Ralston v. Smith*, 11 H.L.C. 223 (at p. 254) ; *disclaimer* [117] ; *amendment* [118].
394. *Read v. Stella Conduit Co.*, 32 R.P.C. 1 ; *inventive ingenuity* [69, 70].
395. *Redges v. Mulliner*, 10 R.P.C. 21 ; *licence* [112].
396. *Ridd Milking Machine Co. v. Simplex Milking Machine Co.*, 33 R.P.C. 309 (at p. 317) ; *principle* [53].
- 396a. *Riekmann v. Thierry*, 14 R.P.C. 105 ; *inventive ingenuity* [70].
397. *Ritchie's Patent*, 31 R.P.C. 1 ; *extension* [126, 129].
398. *Robertson v. Purdy*, 24 R.P.C. 273 ; *anticipation* (at p. 302) [60].
399. *Robert's Patent*, 1 W.P.C. 573 ; *extension* [126].
400. *Robin Electric Lamp Co.*, 32 R.P.C. 202 ; *abuse of monopoly* [153].
401. *Roper's Patent*, 4 R.P.C. 201 ; *extension* [125, 130].
402. *Ross's Application*, 8 R.P.C. 477 ; *opposition* [37].
403. *Rowcliffe v. Morris*, 3 R.P.C. 17 ; *intelligibility* [72].
404. *Rulings by the Comptroller General*—
 - (a) 1910 (D), 27 R.P.C. appendix ; *opposition (proof of utility)* [37].
 - (b) 1910 (E), 27 R.P.C. appendix ; *register of patents* [105] ; *equitable assignment* [108].
 - (c) 1910 (G), 27 R.P.C. appendix ; *Sect. 8 and opposition* [26, 39].
 - (d) 1911 (C), 28 R.P.C. appendix ; *master patent* [43].
 - (e) 1912 (B), 29 R.P.C. appendix ; "*locus standi*" [40].
 - (f) 1912 (C), 29 R.P.C. appendix ; "*locus standi*" [39].

- (g) 1912 (D), 29 R.P.C. appendix; *opposition* [39].
- (h) 1913 (A), 30 R.P.C. appendix; *opposition* [40].
- (i) 1913 (C), 30 R.P.C. appendix; *opposition* [39, 58].
- (j) 1913 (D), 30 R.P.C. appendix; *restoration* [133].
- (k) 1914 (A), 31 R.P.C. appendix; *opposition* [40].
- 405. Ryland's Patent, 5 R.P.C. 665; *amendment of specification* [118].
- 406. Saccharine Corporation, Ltd. v. Chemical and Drugs Co., 17 R.P.C. 28; *inventive ingenuity* [71].
- 407. Saccharine Corporation, Ltd. v. Reitmeyer, 17 R.P.C. 606; *acts of infringement* [79, 80].
- 408. Sadgrove v. Godfrey, 37 R.P.C. 7; *improvements* [109].
- 409. Salvo Laundry Co. v. Mackie, 10 R.P.C. 68; *common knowledge*; *inventive ingenuity* (at p. 70) [65].
- 410. Sandow v. Szalay, 23 R.P.C. 6; *construction of specification* [49].
- 411. Sarason v. Frenay, 31 R.P.C. 252, 330; *Sect. 38* [89].
- 412. Savage v. Brindle, 17 R.P.C. 228; *injunction* [91].
- 413. Saxby's Patent, L.R. 3 P.C. 292; *extension, accounts* [124].
- 414. Schwerdtfeger v. Hart, 29 R.P.C. 236; *costs* [100].
- 415. Scott v. Hamling, 14 R.P.C. 123; *costs* [99].
- 416. Scott v. Hull Steam Fishing and Ice Co., 14 R.P.C. 143; *experimental use and infringement* [80].
- 417. Scott's Patent, 23 R.P.C. 479; *extension* [130].
- 418. Semet & Solway's Patent, 12 R.P.C. 10; *extension* [125].
- 419. Serrell's Patent, 6 R.P.C. 101; *amendment* [118].
- 419a. Sheehan v. Great Eastern Rly. Co., 16 Ch.D. 59; *joint owners*; *infringement* [135].
- 420. Shoe Machinery Co. v. Cutlan, 13 R.P.C. 141; 12 R.P.C. 530—
 - (a) 13 R.P.C. (at p. 147); *infringement* [80].
 - (b) 12 R.P.C. (at p. 533); *revocation* [146].
- 421. Shone's Patent, 9 R.P.C. 438; *extension* [123].
- 422. Shrewsbury v. Sterck, 13 R.P.C. 44; *costs* [100].
- 423. Siddell v. Vickers, 5 R.P.C. 81, 416—
 - (a) (at p. 101); *delivery up of infringing articles* [95].
 - (b) (at p. 430); *inventive ingenuity* [69].
- 424. Simon, *ex parte* 4 T.L.R. 754; *amendment* [120]; *jurisdiction* [5].
- 425. Simplex Concrete Piles, Ltd. v. Stewart, 30 R.P.C. 205; *inventive ingenuity* [69].
- 426. Simpson v. Holliday, L.R. 1 H.L. 315; *sufficiency of description* [74].
- 427. Sirdar Rubber Co. v. Wallington, 22 R.P.C. 257; *infringement, fair repairs* [80].
- 428. Skinner v. Perry, 10 R.P.C. 1; *threats* [136, 162, 165].
- 428a. Smith v. London & North Western Rly. Co., 2 E. & Bl. 69; *rights of tenants in common* [136].
- 429. Smith's Patent—
 - (a) 31 R.P.C. 237; *utility* [64]; *sufficiency of description* [73].
 - (b) 13 R.P.C. 200; *opposition* [37].
- 430. Soames' Patent, 1 W.P.C. 729; *extension* [126, 129].
- 431. Société Anon. de Manuf. de Glases v. Tilghmann's Patent Sand Blast Co., 25 Ch.D. 1 (at p. 9); *implied licence* [88].
- 432. Southby's Patent, 8 R.P.C. 433; *extension* [125].
- 433. Southwell and Head's Application, 16 R.P.C. 361; *opposition*, "*master patents*" [43].
- 434. Spiel's Patent, 5 R.P.C. 281; *opposition* [35].
- 435. Stahlewerk Becker, A. G., 35 R.P.C. 81, 210; *anticipation* [60].
- 436. Standfield's Patent, 15 R.P.C. 17; *extension* [123].
- 437. Stead v. Williams, 2 W.P.C. 126 (at p. 142); *prior publication* [61].
- 438. Steers v. Rogers, 10 R.P.C. 245 (at p. 251); *patent rights* [2, 136].

439. Stepney Spare Wheel, Ltd. v. Hall, 28 R.P.C. 381; *amendment* [122].
440. Stewart v. Casey, 9 R.P.C. 9; *assignment* [107, 108].
441. Stoney's Patent, 5 R.P.C. 518; *extension* [130].
442. Stuart's Application, 9 R.P.C. 452; *opposition* [36].
443. Sugg v. Bray, 2 R.P.C. 223—
 - (a) (at p. 231) *construction of specification* [47, 48, 51].
 - (b) (at p. 223) *infringement* [86].
444. Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co., 14 R.P.C. 757; *costs* [99]; (at p. 776) *certificate of validity* [97].
- 444a. Sutcliffe v. Abbott, 20 R.P.C. 50; *common knowledge* (at p. 55) [66].
445. Taylor's Agreement Trusts, 1904, 2 Ch. 737; *equitable owner* [111].
446. Taylor's Patent, 13 R.P.C. 482; *public user* [60].
447. Taylor's Patent, 32 R.P.C. 93; 33 R.P.C. 138; *sufficiency of description* [73].
448. Temler v. H. Stevenson & Sons, 15 R.P.C. 24; *threats, costs* [165].
449. Tennant's Case, 1 W.P.C. 125; *public sale* [60].
450. Tetley v. Easton, Mac. P.C. 48; *bona fides* [76].
451. Thermit, Ltd. v. Weldite, Ltd., 24 R.P.C. 441; *combination, infringement of* [86].
452. Thomas v. Hunt, 17 C.B.N.S. 183; *implied licence* [113].
453. Thompson's Patent, 26 R.P.C. 673; *extension* [130].
454. Thornborough and Wilk's Patent, 13 R.P.C. 115; *opposition* [37].
455. Todd's Application, 9 R.P.C. 487; *opposition* [37].
456. Trantuer v. Patmore, 29 R.P.C. 60; *interim injunction* [82].
457. Trotman's Patent, L.R. 1 P.C. 118; *extension* [123].
458. Tubeless Pneumatic Tyre and Capon Heaton, Ltd., v. Trench Tubeless Tyre Co., Ltd., 16 R.P.C. 291; *utility* [63].
459. Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd., 17 R.P.C. 569; 18 R.P.C. 339; 20 R.P.C. 77—
 - (a) 17 R.P.C. (at p. 590); *claims, construction of* [53].
 - (b) 18 R.P.C. (at p. 360); *intelligibility of specification* [72].
 - (c) 20 R.P.C. 77; *construction of specification* [47, 49]; *sufficiency of description* [74].
460. Turner v. Winter, 1 W.P.C. 77; *bona fides* [76].
461. Tweeddale v. Ashworth, 7 R.P.C. 426; 9 R.P.C. 121—
 - (a) 7 R.P.C. 436; *certificate of validity* [97]; (at p. 431) *infringement* [81]
 - (b) 9 R.P.C. 121; *construction of specification* [51].
462. Ungar v. Sugg, 8 R.P.C. 385—
 - (a) (at p. 388) *threats* [162].
 - (b) *threats, damages* [165].
463. United Horse Shoe & Nail Co. v. Stewart, 2 R.P.C. 122; 4 R.P.C. 140—
 - (a) 2 R.P.C. (at p. 132); *sufficiency of description* [73].
 - (b) 2 R.P.C. (at p. 143); *damages, inquiry* [93].
 - (c) 4 R.P.C. 140; *damages* [94].
464. United Telephone Co. v. Bassano, 3 R.P.C. 295; *construction of specification, [46]; infringement* [86].
465. United Telephone Co. v. Donohoe, 3 R.P.C. 45; *damages* [93].
466. United Telephone Co. v. Sharples, 2 R.P.C. 28—
 - (a) (at p. 31) *infringement by importation* [80].
 - (b) *costs* [100].
467. United Telephone Co. v. Walker, 4 R.P.C. 63; *damages* [94, 95].
468. Unwin v. Heath, 5 H.L.C. 505 (at pp. 522, 538); *construction of specification* [51].
469. Vaisey's Patent, 11 R.P.C. 591; *revocation* [147].
470. Van Berkel v. Simpson, 23 R.P.C. 237; 24 R.P.C. 117; *appendant claims* [53].

471. Van Gelder, Apsiman & Co. v. Sowerby Bridge Co., 7 R.P.C. 208 ;
infringement, mortgagor can sue [78].
472. Van Gelder's Patent, 6 R.P.C. 22 ; *amendment* [120].
473. Van Wye's Application, 26 R.P.C. 490 ; *opposition* [37].
474. Vidal Dyes Syndicate v. Levinstein, Ltd., 28 R.P.C. 541 ; 29 R.P.C.
245—
 - (a) 28 R.P.C. (at p. 559) ; *sufficiency of description* [74].
 - (b) 29 R.P.C. (at p. 265) ; *validity* [72].
 - (c) 29 R.P.C. (at p. 266) ; *sufficiency of description* [73].
 - (d) 29 R.P.C. 245 ; *sufficiency of description* [74].
 - (e) 29 R.P.C. (at p. 269) ; *bona fides* [75].
 - (f) 29 R.P.C. (at p. 260) ; *infringement, evidence* [84].
475. Von Heyden v. Neustadt, 14 Ch.D. 230 ; 50 L.J. (Ch.) 126—
 - (a) 14 Ch.D. 230 ; *infringement* [79, 80].
 - (b) 50 L.J. (Ch.) 126 (at p. 128) ; *novelty ; mosaic of extracts* [62].
476. Vorwerk v. Evans, 7 R.C.P. 265—
 - (a) (at p. 273) *construction of specification* [51].
 - (b) (at p. 266) *manner of manufacture* [59].
477. W.'s Application, 31 R.P.C. 141 ; *alleged invention* [2, 59].
478. Wadham's Application ; 27 R.P.C. 172 ; *opposition* [38, 40].
479. Wakfer and Peck's Application, 32 R.P.C. 199 ; *specific reference* [39].
480. Walker's Patent, Griff. L.O.C. 22 ; *amendment* [118].
481. Walton v. Lavater, 8 C.B.N.S. 162 (at p. 184) ; *assignment* [107].
482. Wapshare Tube Co. v. Hyde Imperial Rubber Co., 18 R.P.C. 374 ;
infringement, defence [85].
483. Ward v. Hill, 18 R.P.C. 481 ; 20 R.P.C. 189—
 - (a) 18 R.P.C. 481 ; *infringement, burden of proof* [84].
 - (b) 20 R.P.C. (at p. 197) ; *utility* [64].
484. Wardroper v. Gibbs (George), Ltd., 20 R.P.C. 355 ; *inventive ingenuity*
[70].
485. Ward's Application, 29 R.P.C. 79 ; *invention, discovery* [59].
486. Warrall's Patent, 35 R.P.C. 226 ; *extension* [125].
487. Washburn v. Patterson, 1 R.P.C. 191 ; *delivery up of infringing articles*
[96].
488. Watson, Laidlaw & Co., Ltd. v. Pott, Cassels & Williamson, 27 R.P.C.
541 ; 30 R.P.C. 285—
 - (a) 27 R.P.C. (at p. 581) ; *intelligibility of specification* [73].
 - (b) 27 R.P.C. 541 ; *sufficiency of description* [74, 75].
 - (c) 30 R.P.C. 285 ; *damages* [94].
489. Webb v. Atkinson, 19 R.P.C. 599 ; *certificate of validity* [97].
490. Weber's Patent, 27 R.P.C. 30 ; *abuse of monopoly* [152, 154].
491. Wegmann v. Coreoran, L.R. 13 Ch.D. 65 ; *bona fides* [76].
492. Welsbach Incandescent Gas Light Co., Ltd. v. Daylight Incandescent
Gas Light Co., 16 R.P.C. 344 ; 17 R.P.C. 141—
 - (a) 16 R.P.C. 344 ; *costs* [98].
 - (b) 17 R.P.C. (at p. 148) ; *delivery up of infringing articles* [96].
493. Welsbach Incandescent Gas Light Co., Ltd. v. Dowle and London and
Suburban Maintenance Co., 16 R.P.C. 391 ; *infringement, injunction*
[90].
494. Welsbach Incandescent Gas Light Co., Ltd. v. New Incandescent
(Sunlight Patent) Gas Lighting Co., Ltd., 17 R.P.C. 237 ; *utility* [64].
495. Wenham v. Champion Gas Lamp Co., 9 R.P.C. 49 ; *redundant claim ;*
validity [73] ; *infringement* [86].
496. Wenham Co. v. Carpenter & Co., 5 R.P.C. 68 ; *damages* [92].
497. Werdermann v. Société Générale d'Electricité, 19 Ch.D. 246 ; *prior*
equity ; assignment [108].
498. Willacy's Patent, 5 R.P.C. 690 ; *extension* [123].

- 499. *Williams v. Nye*, 7 R.P.C. 62; *inventive ingenuity* [65].
- 500. *Wilson v. Union Oil Mills*, 9 R.P.C. 57; *utility* [63].
- 501. *Wood v. Raphael*, 13 R.P.C. 730; 14 R.P.C. 496; *inventive ingenuity* [69, 70].
- 502. *Wood v. Zimmer*, 1 W.P.C. 82 (*n*); *bona fides* [76].
- 503. *Woolfe v. Automatic Picture Gallery Co.*, 20 R.P.C. 177; *amendment* [117].
- 504. *Worring and Kortenbach*, 26 R.P.C. 163; *abuse of monopoly* [154].
- 505. *Worthington Pumping Engine Co. v. Moore*, 20 R.P.C. 41; *master and servant* [110].
- 506. *Wright's Patent*, 1 W.P.C. 575; *extension* [125].
- 507. *Wüterich's Patent*; 20 R.P.C. 285; *extension, accounts* [124].
- 508. *Young & Beilky v. Hermand Oil Co.*, 9 R.P.C. 373; *infringement, colourable imitation* [86]; *construction* [104].
- 509. *Young v. Morris*, 11 R.P.C. 617; *infringement, innocence* [85].
- 510. "*Z*" *Electric Lamp Manufacturing Co. v. Marples, Leach & Co., Ltd.*, 27 R.P.C. 737 (at p. 746); *sufficiency of description* [74].

INDEX

The references, unless otherwise stated, are to pages in the text

ABANDONED application. *See* Application.

— use, 60

Abridgments of specifications, 5, 32

Abuse of monopoly. *See* Compulsory Licence; Revocation of patents.

Acceptance—

of application (Sect. 4), 20

of complete specification (Sects. 9 and 10), 29, 31

infringement before (Sect. 13), 90, 92

Accident, invention the result of, 67

Account of profits (Sect. 34), 195

Accounts. *See* Extension of term of patent.

Action for infringement. (*See also* Infringement.)

acts in respect of which it may be brought, 79

amendment of specification pending, 102

burden of proof, 84

certificate of particulars, 98

certificate of validity (Sect. 35), 96, 97, 98, 100, 101

costs in—

amendment of particulars, 101, 102

certificate of particulars, 98

enquiry as to damages, 101

higher scale, 100

notice to admit facts, 99

patent with invalid claims, 88

shorthand notes, 100

solicitor and client, 100, 101

when action not contested, 98

counterclaim for revocation, 83, 147

Courts of competent jurisdiction, 78, 79

damages, 91–95

admission by defendant of amount, 93

amendment of specification, effect of, 92

delay in bringing action, 93

effect of previous damages, 94

enquiry as to, 92, 93

Action for infringement (*contd.*)—
damages (*contd.*)—

how measured, 93–95

limitation of right to, 32 90, 92

patents endorsed “Licences of right,” 95

patents lapsed and subsequently restored 92, 93

patent with invalid claims, 88

time for paying renewal fees enlarged, 92

defence, 83

defences, 84

alternative and inconsistent, 85

delivery up of infringing articles, 95, 96

equitable owner, 78

existence of a contract containing obnoxious terms (Sect. 38), 84, 89, 90

ignorance as a defence, 85, 92

injunction, 90, 91

amendment of specification after, 91

ex parte, 81

interlocutory, 81

breach of, 103

intention or threat to infringe, 90, 91

suspending, 91

innocent infringers, 85, 92

invalidity of patent, 55, 88

judgment and effect of, 102, 103

jury, 84

licence as defence, 87, 88

mortgagee, 77

non-infringement, 85

particulars of breaches, 82–84

particulars of objection, 83, 84

parties to, 71, 78

relief obtainable, 90–102

time for bringing, limitation as to, 83

title to sue, want of, 85

true and first inventor, burden of proof, 84

Action for royalties, 103, 104

Action to restrain threats (Sect. 36)—
acts which constitute threats, 162

- Action to restrain threats (*contd.*)—
 consolidation with infringement
 action, 165
 costs, 165
 damages, 164
 defences, 162–164
 infringement of patent, 162
 injunction, 164
 interlocutory injunction, 164
 parties to, 161
 stay of, 165
 validity of patent, 162
- Acts in force, 3
- Addition, Patent of (Sect. 19), 31
- Address for service (Rule 8), 17, 42,
 103, 127, 128
 — of applicant, 17
- Adequate remuneration. *See* Extension of term of patent (inadequacy of remuneration).
- Administration of the Patents Acts, 4
- Advantages of invention—
 effect on utility, 64
 statements of in specification, 51,
 75
- Advertisements—
 of acceptance of complete specification, 30, 34
 of amendments, 119–121
 of applications, 9
 of proceedings to extend the term of patent, 127
- Agent (Rule 9), 5
 authorization of, 16
 offences (Sect. 84), 6
 refusal of comptroller to recognize (Sect. 85, Rule 9), 6
 Registered Patent Agents (Sect. 84), 6
 signature of documents by (Rule 9), 5
 who can act as, 6
 of crown, use of invention by (Sect. 29), 138, 139
- Agreements of service, 109
- Aiding and abetting infringement, 80
- Alien enemy. *See* Restored Patent; Compulsory Licences
- Amendment of specification—
 advertisement of, 120
 after sealing,—
 applications to the comptroller (Sect. 21, Rules 64–66), 116, 119
 applications to the Court (Sect. 22), 116, 120
- Amendment of specification (*contd.*)—
 application before writ in infringement action, 122
 as a result of opposition, 36, 38–41
 before acceptance of application, 25–29, 116
 clerical errors (Sect. 70, Rule 96), 116
 construction of amended specification, 48
 correction, 117
 disclaimer, 117
 effects of—
 on certificate of validity, 97
 on damages for infringement, 92
 on injunctions, 91
 explanation, 117
 leave to amend, effect of (Sect. 21 (7)), 120
 opposition to, 119, 121
 order for, to be left at Patent Office (Rule 115), 121
 proceedings pending, 116
 second and subsequent applications, 119
 suspending order for revocation, pending, 122
 terms imposed as a condition of leave to amend, 121, 122
 what is allowable, 117–119
- Anticipation. *See* Specification (investigation); Novelty (prior publication, prior use).
- Appeal—
 from decision of the Comptroller, 5
 stay of execution pending, 91, 93, 96
- Application for a patent (Sect. 1, Rules 10–18), 16–19. (*See also* Specification.)
 abandoned applications (Sect. 69), 31
 acceptance of, limits of time for, 29, 30
 advertisement of acceptance, 30, 34
 advertisement of application, 5
 assignee may proceed, 30
 cognate applications (Sect. 16), 33
 death of applicant, procedure on, 30
 disputes between joint applicants, 31
 divided applications, 24, 25
 drawings. *See* Drawings
 examination of, 9, 23
 fees on, 11, 243
 forms of application, 16, 250–260

Application for a patent (*contd.*)—

- interviews, hearings and appeals, 29
- investigation as to novelty, 9, 25-27
- joint applicants, 16, 31
- legal representative of deceased inventor (Sect. 43), 17
- manner of manufacture. *See* Manner of Manufacture.
- one invention (Sect. 14 (2), Rule 13), 24
- opposition to grant. *See* Opposition to grant.
- parties to, 16, 17
- patents of addition (Sect. 19) 31
- post dating (Sects. 3 (2), 6 (3), Rule 28), 23, 28
- procedure in Patent Office, 23-31
- seal of Company, 16
- sealing of patent, 30
- secret patents, 32
- signatures to, 16
- specification. *See* Specification.
- subject matter of, Pref. vi, 1
- title, 18, 23
- true and first inventor must be a party, 8, 17, 57, 110
- under the International Convention (Sect. 91, Rule 15-18), 4, 32
- Arms (Royal) (Sect. 90), 8
- Art, State of knowledge in—
 - in construing specification, 46, 48, 49
 - inventive ingenuity decided by, 65
- Articles forfeited by Customs or Excise (Sect. 29 (4)), 193
- Artisan, well-informed, 47
- Assessor, power to appoint—
 - in appeals to Law Officer (Sect. 11 (3)), 45
 - in infringement or revocation proceedings (Sect. 31), 195
- Assignee. *See* Assignments.
- Assignment, 107-110
 - agreement to assign, 107, 108
 - assignee and assignor, position of, 107, 108
 - cannot dispute validity, 91
 - damages for infringement after assignment, 92, 107
 - co-owners, by, 107, 135-137
 - covenants to communicate improvements, 109
 - definition of, 107
 - distinguished from licence 106,

Assignment (*contd.*)—

- equitable, 108-110
 - notice of, entry on register of, 105, 109
 - grant of patent to assignee, 30, 109
 - implied agreement to assign, 110
 - joint owners, 107
 - legal, 107, 108
 - limited, 107
 - master and servant, 109, 110
 - mortgagee cannot sue, 78
 - mortgages, 110
 - notice of prior equitable interest, 108
 - of invention, 105
 - of patent before the grant, 108
 - registration of, 105, 108
 - renewal fees, payment of after, 107
 - restored patents, 166
- Attorney General—
 - appeals to, as Law Officer, 5
 - fiat of, in petition to revoke, 83, 145, 146, 147
- BANK Holiday, Patent Office closed (Rule 112), 242
- Bankruptcy of patentee, 111
- Board of Trade—
 - restored patents, 166
 - power to make rules (Sect. 86), 3
 - proceedings of (Sect. 87), 212
- Bona Fides*—
 - applicant must exercise, 21, 75
 - in meeting threats action by infringement action, 163
 - in petition to extend term of patent 123
- Burden of proof—
 - in actions for infringement, 79
 - when validity of patent is challenged, 84
- CAPITAL, When necessary to exploit a patent, exclusive licence, 156
- Carrier, Infringement by transportation, 79
- Certificate—
 - of Board of Trade as to exhibitions (Sect. 45, Rule 102), 99, 240
 - of Comptroller as to entries in Register and other documents, evidence of (Sects. 78 and 79, Rule 97), 106, 208, 239
 - of particulars. *See* Action for infringement.
 - of validity. *See* Action for infringement.

- Chemical inventions—
 claim for product (Sect. 38A(1)), 22
 proof of infringement (Sect. 38A (1)), 86
 samples of (Rule 38), 22
- Chose in Action, 2
- Christmas Day (Sect. 82, Rules 112, 113), 242
- Circulars, threats by, 162
- Claim. *See* Construction of specification; Specification; Infringement; Validity of patent.
- Clearing House—
 established under Art. 296 of Treaty of Peace, 306
 payments through, 166
- Clerical errors (Sect. 70, Rule 96), 116
- Co-applicants—
 inventor must be included in, 8, 17, 57, 110
 may include persons other than inventor, 8
 procedure in case of disputes (Sect. 12 (1) *proviso*), 31
 signature of application form, 16
- Co-assignees. *See* Assignments; Co-owners.
- Cognate inventions (Sect. 16), 25, 33
- Colourable imitation, Infringement by, 86
- Combination—
 anticipation of, 57
 construction of, 52
 infringement of, 86
 of old elements, 69, 71
- Commercial scale (Sect. 93), 215
 — success, as affecting validity, 64, 67
- Common knowledge—
 in construing specifications, 48, 49
 in judging inventive ingenuity, 65
 what is included in, 65
- Communication from abroad—
 patent granted in respect of, 8, 17, 57
 extension of term of patent, 129
- Communications, Confidential, 61
- Company—
 application for patent by, 16
 breach of injunction by, 103
 dissolution of, before assignment of patent, 111
- Complete specification. *See* Specification.
- Comptroller—
 appeal from, 5
 position of, 4
- Comptroller (*contd.*)—
 powers and duties of, in respect of—
 amending documents, general power of (Rule 110), 116
 amendment of specification (Sect. 21, Rules 64–68), 116, 119
 annual reports (Sect. 76), 208
 appearing before Court on extension petition (Sect. 18(3)) 126
 application for patent, 23–31
 certificate of entry in register (Sect. 78), 106
 certificate of payment of renewal fee (Rule 56), 233
 certified copies or extracts (Sect. 79), 208
 compulsory licences—
 abuse of monopoly, 151–157
 licences of right, 157–159
 patents for food and medicine, 159
 restored patents, 159–160
 copies of specifications, etc., transmitting (Sect. 80), 209
 correction of clerical errors (Sect. 70(a) Rule 96), 116
 costs and security for costs (Sect. 73A), 208
 discovery and production of documents (Sect. 77 (2)), 44
 dispensing with evidence, etc. (Rule 114), 242
 disputes between joint applicants, 31
 enlarging time (Rule 111), 241
 evidence (Sect. 77), 42, 43
 exercising discretion (Sect. 73, Rules 104–107), 207, 240
 opposition to grant of patent, 34–45
 refusing to accept applications contrary to law, etc. (Sect. 75), 208
 register of patents, 104–106
 restoration of lapsed patents, 132–134
 revocation of patents (Sect. 26), 149
 secret patents (Sect. 30, Rules 98–100), 32
 statutory provisions (Sects. 62, 63), 205
 taking directions of Law Officer (Sect. 74), 208

Compulsory licences—

- abuse of monopoly, as the result of (Sect. 27, Rules 79-84), 151-157
 - adjournment of application, 154
 - appeal, 155
 - application for, 151, 153
 - defence to application, 152
 - definition of abuse, 151, 152
 - exclusive licences, 156
 - existing licences, 155, 156
 - guiding principles, 150
 - "licences of right," patent may be endorsed, 155
 - locus standi* of applicant, 151
 - procedure, 153
 - prohibition against importation, 156, 157
 - reference to arbitration, 154
 - relief obtainable, 155-157
 - revocation of patent, 157
 - terms of the licences, 156
 - "working on a commercial scale" (Sect. 93), 215
- effect of order for (Sect. 27A), 192
- licences of right (Sect. 24, Rules 69-75), 157-159
 - application for licence, 157, 158
 - damages for infringement, 95
 - endorsement of patent, 115
 - cancellation of (Sect. 24(5), Rule 73), 186
 - compulsory, 115, 155
 - effect of compulsory order, 157
 - opposition to, 115
 - voluntary, 115
 - importation, covenants against, 157
 - licencee's right to sue for infringement, 158
 - modification of terms of existing licences, 158
 - renewal fees (Sect. 24(1) (f)), 12, 115
 - terms of licence, how settled, 157, 158
- patents for food and medicine (Sect. 38A, Rule 85), 159
- restored patents, 159-160
 - application for licences under, 160
 - patentees whose nationality was changed by treaties, 160, 166
 - payments of royalties to Clearing House, 160, 166

Compulsory licences (*contd.*)—

- restored patents (*contd.*)—
 - power of Board of Trade to take over and sell, 166
 - revision of terms of licence, 166
- Conditions—
 - abuse of monopoly by unfair (Sect. 27(2) (e)), 152
 - imposed on application to amend, 120, 121
 - imposed on grant of extension of term, 130, 133
 - in contracts of sale or licence, when void (Sect. 38), 89
- Construction of specification—
 - advantages, effect of setting out, 51
 - amended specification, 48
 - appendent claims, 53
 - benevolent construction, 51
 - broad or narrow construction, 46, 50
 - claims for subordinate integers, 53
 - claims as defining monopoly, 22, 52
 - combination claims, 50, 52
 - common knowledge, application of, 49, 50
 - different meaning to each claim, 53
 - equivalents, 51
 - evidence relating to, 46, 47, 48
 - nature and limits of invention determined by, 46
 - persons to whom specification addressed, 46, 47
 - previous construction binding, 47
 - principle, claim for, 50, 53
 - provisional specification, use of in construing complete, 48
 - rules for construction, 47
 - skilled workman, 47
 - state of knowledge in art, as basis of, 46-50
 - "substantially as described," 53
 - well informed artisan, 47
 - where there are two reasonable constructions, 51
 - wide or general expressions, 48
- Contempt of Court, 103, 164
- Contract—
 - affected by automatic extension of term of patent (Sect. 6 of P. and D. Act, 1919), 180
 - of service, 109
 - patent considered as a, 2
 - unlawful conditions in (Sect. 38), 89
- Contractor, Government (Sect. 29), 138, 139

- Co-owners—**
 death of one, 136
 joint tenants, 135, 137
 owners of different parts of a patent, 135, 137
 rights of, *inter se*, 135, 137
 right to grant licences, 136
 right to sue for infringement, 78, 135
 right to use invention, 136
 tenants in common, 135, 137
- Co-patentees.** *See* Co-owners.
- Corporation.** *See* Company.
- Correction.** *See* Amendment of specification.
- Costs.** *See* Action for infringement ;
 Action for threats ; Comptroller ;
 Extension of term ; Revocation of patent.
- Counsel—**
 certificate of, 146
 communication of confidential documents to (Sect. 29(1)), 193
 employment of, 6
- Counterclaim—**
 for infringement in threats action, 163
 for revocation in infringement action (Sect. 32), 83
- County Court,** 79
- Court of Appeal—**
 certificate of particulars or validity, granted by, 97, 99
 when no appeal to (Sect. 92(2)), 214
- Court of the County Palatine of Lancaster,** 78
- Covenant.** *See* Assignment ; Licence.
- Crown, Prerogative of** (Sect. 97), 217
- Crown, Rights of, to use patented inventions** (Sect. 29)
 compensation to patentee, 137, 138-140
 extent of right, 138
 invention recorded by Government Department, 139
 services of the Crown, 137
 when infringement or validity challenged, 138, 139
- Custodian—**
 divesting order (S. R. & O., 1920, No. 1336), 332
 enemy patents and applications vested in, 142
 licences granted by, 143
- Customers—**
 names of, on enquiry as to damages, 93
 threats against, 161
- DAMAGES.** *See* Action for infringement ;
 Action to restrain threats.
- Date of patent,** 10, 140-142
- Days, Excluded** (Sect. 82, Rule 113), 209
- Death—**
 of co-owner, 110, 135, 136
 of inventor, 8, 17
 of patentee, 110
- Declarations—**
 on application for patent, 17
 evidence by way of statutory (Rules 108, 109), 42, 43
 by infant, lunatic, etc. (Sect. 83), 209
- Definitions** (Sects. 92, 93), 214
- Delay—**
 in applying for interlocutory injunction, 81
 in applying for restoration of lapsed patent, 133
 in claiming damages, 93
- Description of invention—**
 in complete specification, 21, 22, 72-76
 in prior document, anticipation by, 62
 in provisional specification, 19
- Destruction of infringing articles,** 95
- Devolution of patent rights,** 110, 111
 under restored patents, 166
- Director of company, signature of,** 16
- Disclaimer.** *See* Amendment of specification ; opposition to grant.
- Disconformity—**
 applications under International Convention, 32, 41
 as a ground of invalidity, 76
 as a ground of opposition, 40
 on examination of complete specification (Sect. 6), 27
- Division of application,** 24
- Documents—**
 anticipation of patent by, 60-63
 certified copies of (Rule 97), 239
 discovery of, (Sect. 77), 44
 filing at the Patent Office (Sect. 81, Rule 7), 209
 of title. *See* Register of Patents.
 size, etc., of, (Rule 6) 223
- Drawings—**
 accompanying specification, 20, 22
 amendment of, 119
 rules as to (Rules 19-26), 226
- Due diligence in following up threats by infringement action,** 163
- Duplicate of lost patent** (Sect. 44, Rule 101), 199, 240

EMPLOYER. *See* Master and servant.

Enemy—
 person ceasing to be, by Treaty of Peace, 160, 166
 infringement of enemy patents during the War, 143
 restoration of patent to, 165

Enlargement of times by Comptroller, (Rule 111), 241

Enquiry as to damages. *See* Action for infringement.

Equitable assignments, 108–110

Equivalents, 37, 51, 86

Errors—
 clerical, correction of (Sect. 70, Rule 96), 116
 effect on validity, 74

Evidence—
 before the Comptroller. *See* Comptroller; Declarations.
 for construing specifications, 46, 48, 49
 in infringement actions, 83, 84

Examination of application for patent, (Sects. 3, 6), 23–31

Exclusive licence, 113, 156

Executor. *See* Personal representative.

Exhibition, Publication of invention at (Sect. 45, Rules 102, 103), 63

Experiment—
 affect on validity of subsequent patent, 60
 expenses of, on petition for extension, 126
 not infringement, 80
 when necessary to make invention work, 74

Explanation, Amendment of specification by way of, 117

Extension of term of patent (Sect. 18)—
 appeal, 132
 expiry of patent before application, 132
 extension allowable, 122
 hearing before appointed judge, 129, 132
 inadequacy of remuneration, petition of ground of, 123–130
 accounts of receipt and expenditure, 124
 actual inventor compared with importer or assignee, 129
 adequacy of remuneration, measure of, 125
 advertisement of petition, 127

Extension of term of patent (*contd.*)—
 inadequacy of remuneration, petition on ground of (*contd.*)—
 affidavit of advertisement, 128
 appointed day, 127, 128
 bona fides, 123
 books of accounts, 124
 circumstances considered by Court, 129, 130
 compliance with rules and requirements of the Act, 129
 Comptroller opposing, 126
 conditions imposed, 129, 132, 133
 contents of petition, 123
 copy of petition, 128
 costs of experiments and manufacture, 126
 costs of petition, 127
 delay or slackness in pushing invention, 125
 discretion of Court in granting, 129
 entering petition for trial, 128
 expenses of exploiting the invention, 126
 expiry of patent before extension, 127
 protective provisions inserted, 132, 133
 fault or neglect of patentee, 126
 foreign or colonial patents, 123, 124, 126
 invention exploited as part of larger business, 124
 invention not in general use, 125
 litigation, effect of, 126, 130
 locus standi of opponent, 126
 loss due to incendiaries, 130
 merit of invention, 125
 money received as director, 124
 notice of opposition, 128
 opposition to the petition, 126, 128
 part of patent, extension of, 129
 particulars of objection, 126, 128
 parties to the petition, 123
 patent bought as a speculation, 129
 patent of improvement, 130
 Petition, the, 122
 principles on which granted, 129
 procedure, 127
 profits of exclusive licences, 123, 129
 public advantage or detriment, 125, 130
 quarrels of patentees, 125

Extension of term of patent (*contd.*)—
 inadequacy of remuneration, petition on ground of, (*contd.*)—
 remuneration,
 adequacy of, 125
 statement of, 124
 term of extension, 122, 130
 time for presenting, 127, 131
 title to patent, 123
 trial, 129, 132
 two or more patents in same petition, 123
 utility of invention, 125
 validity of patent, how far material, 125
 what petitioner must prove, 124
 loss or damage arising from war,
 petition on ground of, 130–132
 accounts of loss and profit, 131
 loss by patentee as such, 132
 originating summons or petition, 122, 131
 patentee, subject of ex-enemy state, 131
 period of hostilities, 131
 procedure, 132
 time for applying, 131
 terms inserted where patent has expired, 132, 133
 Extension of time—
 discretionary powers of Comptroller (Rule 111), 241
 for acceptance of complete specification (Sect. 6 (5), Rule 39), 26
 for amendment of specification (Rule 30), 26
 for filing complete specification (Sect. 5(1) Rule 27), 21
 for payment of fees (Rule 51), 12
 for filing proceedings for extension of term, 127, 131
 in opposition proceedings, 42, 43
 FALSE entries in register of patents (Sect. 89), 7
 — representation as to article being patented (Sect. 84), 7
 — suggestion in specification, 74
 Fees (Sect. 65 and First Schedule of Rules), 243–249
 Fiat of Attorney General, 83, 145–147
 First inventor, 8, 57
 Foreign applications. *See* International Convention.
 — patent. *See* Extension of term of patent.

Foreign vessels (Sect. 48), 79
 Forms, 250–298, 339–344
 Fraud, obtaining invention by. *See* Opposition to grant; Revocation of patent.
 GENERAL warning, When actionable threat, 162
 Good faith—
 in drafting complete specification, 21, 75
 in petition for extension, 123
 where specification has been amended (Sect. 23), 92
 Good Friday, Patent Office closed (Rule 112), 242
 Government contractor (Sect. 29), 138, 139
 Grant of patent—
 forms of, 299–302, 305
 to persons other than the true and first inventor, 30, 31
 Great Seal, Seal of Patent Office the equivalent of (Sect. 14(1)), 1
 Guardian, Application for patent by, 8
 HOUSE of Lords—
 application to amend after judgment by, 119
 certificate of particulars, 99
 certificate of validity, 97
 IGNORANCE as a defence in infringement action, 85
 Illegal invention—
 as ground of invalidity, 59
 as ground of refusal of patent (Sect. 75), 208
 Illustrated Official Journal (Patents) (Sect. 46), 5
 Importation—
 covenants against, in licence, 156, 157
 of patented article, 80
 when an abuse of monopoly, 151
 Importer of invention, 8, 57, 58
 Improvements—
 covenants to assign, 109
 patent of addition for, 31
 rights of patentee of, 2
 Infant, Application for patent by, 8
 Infringement. *See also* Action for infringement.
 acts done abroad, 80

Infringement (*contd.*)—

- aiding and abetting, 80
 - articles capable of use as, 80
 - articles made by patented process or machine, 79
 - as evidence of utility, 64
 - before acceptance of complete specification (Sect. 13), 32, 90
 - buying patented articles, 79
 - by breach of restrictions, 88, 114
 - colourable imitations, 86
 - combination claims, 86
 - denial of, issues raised by, 85
 - enemy patent, during war, 81, 143
 - equivalents, by use of, 86
 - experiments, 80
 - foreign vessels, use of invention in, 80
 - granting licence, 81
 - ignorance as a defence, 85
 - importation of infringing articles, 80
 - improvements, 86
 - innocent infringers (Sect. 33), 85
 - intention to infringe, 81
 - licences, as defence, 87, 88
 - method of judging, 86
 - new substances, infringement of patents for, 86
 - obtaining patent, 81
 - of patents granted abnormal priority of date, 141, 142
 - parts of patented articles, selling, 81
 - possession of infringing articles, 79
 - repairing patented articles, 80
 - restrictions on sale, 88
 - sale abroad, 80
 - taking substance or essence of invention, 86
 - transportation, 79
 - user, 79
 - valid and invalid claims, 88
- Infringing articles**—
- delivery up or destruction, 95
 - ownership of, 95, 96
- Ingenuity.** *See* Inventive ingenuity.
- Injunctions.** *See* Action for infringement; Action for threats.
- Innocent infringer,** 85
- Insufficiency of specification,** 73
- Intelligibility of complete specification,** 72
- Intention**—
- of inventor, in construing specification, 48
 - to infringe, 79, 90

- International Convention** (Sect. 91), 4, 32, 41
- applications under (Rules 15–18), 32
 - explanation of, 4
 - opposition to application under, 41
 - patents granted abnormal priority of date, 140–142
 - publication of specification (Sect. 91 (3) (a); Rule 17), 31, 32
- Interview with examiner,** 29
- Invention**—
- “alleged invention” (Sect. 93), 1
 - “manner of manufacture,” 1, 59
 - part of, meaning of, 56
 - patentable invention, characteristics of, 1, 59
 - requirements to support validity, Pref. vi, 56, 59–71
- Inventive ingenuity,** 65–71
- analogous use of known article, 68
 - application of idea, 66
 - combination of known elements, 69
 - common general knowledge, applied to determine, 65
 - contrasted with novelty, 65
 - how judged, 67
 - idea underlying invention, 66
 - illustrations of cases, 69–71
 - method of arriving at invention, 67
 - requirement for valid patent, Pref. vi, 2
 - selection of alternatives, 68
 - small amount of, when sufficient, 67
 - supplying long felt want, evidence of, 67
 - utility and merit, evidence of, 67, 68
 - what may constitute, 66
- Inventor,** 8, 57, 58
- Ireland, Application of Act to,** 216
- Isle of Man, Application of Act to,** 216
- JOINT applicants**—
- disputes between, 31
 - inventor must be one of, 8, 17, 57
 - who may be, 8, 16, 17
- Joint owners.** *See* Co-owners.
- Journal.** *See* Illustrated Official Journal (Patents).
- Judge appointed under Patents Acts** (Sect. 92(2)), 214
- Jury,** 84, 92

KING's birthday (Rule 112), 242

LACHES. *See* Delay.

Lancaster, Court of County Palatine, 78

Lapsed patent—

notice of lapse, 12

restoration of (Sect. 20), 132–134

Law Officer (Sect. 93), 214

appeal from Comptroller to, 5

assistance of expert (Sect. 11(3)), 45

attendance of witnesses before, 45

Comptroller may take directions of (Sect. 74), 208

costs and security for costs, 45

decision of, final, 5

practice and procedure before, 303, 304

Learned society, publication of invention to, 63

Legal assignment. *See* Assignment.

— proceedings, threats of. *See* Action to restrain threats.

— representative, 17, 35

Letters Patent (*see also* Patent), 1

Licence—

admission of reasonableness of terms (Sect. 38(1) b(ii)), 197

assignment of, 113

breach of covenant in, 112

compulsory. *See* Compulsory Licences.

contrasted with assignment, 106

co-owners, position of, 136, 137

covenants implied in, 112

damages for infringement, based on royalties, 95

defence to infringement action, 87, 88

exclusive, 113

express, 112–113

for term of patent, statutory extension of term, 180

implied, 113, 114

infringement of patent by granting, 81

irrevocable and exclusive, 113

"licences of right." *See* Compulsory licences.

onerous terms in, effect of (Sects. 27(2)e and 38), 89, 152

period of, 113

registration of, 87

renewal fees, 112, 113

restricted, 113

restrictions, notice of, 113, 114

Licence (*contd.*)—

revocation of, 112

royalties in respect of, 113

statutory. *See* Compulsory licences.

under restored patent, 166

validity of patent, effect on, 112

what is a, 106, 111

Licensee. *See also* Licence.

sub-licence by, 113

suing infringers, 78

validity of patent challenged by, 88, 104

Limitation of time in infringement action, 90, 91, 92

Loss. *See* Extension of term; Duplicate of lost patent.

Lunatic, Application for patent by, 8

MANNER of manufacture (Sect. 93)—

ground for refusing application (Sect. 3), 24

meaning of, 1

requirement of valid patent, Pref. vi, 56, 59

what is and what is not, 59

Marking goods to indicate they are patented—

— when an offence (Sect. 89(3)), 7

— when notice of existence of patent (Sect. 33), 92

Master and servant, 110

Master patent, 38

Mechanical equivalents, 37, 51, 86

Merit of invention. *See* Extension of term.

Misrepresentation in specification, 74

Models for Board of Education (Sect. 47(2)), 200

Monopolies, Statute of, 3, 169

Mortgages, 110

Mosaic of extracts, anticipation by, 62

Munitions of war 32

Museum, Patent (Sect. 47), 200

NATURE of invention—

description of in provisional specification (Sect. 2(1)), 19

description of in complete specification (Sect. 2(2)), 21

reference to provisional specification for construing complete specification, 49

Non-user of invention—
effect of, in petition for extension,
125

effect on utility, 64

Notice—

of acceptance of specification, 30
of documents of title in register, 105
of intention to exhibit, publish or
communicate the invention
before application, 63
of opposition to grant, 41
of prior interests in patent, 108
of restrictions on sale of patented
article, 88, 114

Novelty, 59–63

amount of necessary, 60
fraudulent publication, 62
in case of disconformity, 76
industrial exhibitions, 63
inventive ingenuity contrasted, 65
mosaic of extracts, 62
prior publication, 60–62
abandoned patent, 61
confidential, 61
definition of, 61
in British specification dated 50
years or more previously
(Sect. 41), 62
in foreign language, 61
information obtained from
patentee (Sect. 41(2)), 62
oral, 60–63
privileged circumstances (Sect.
45, Rules 102, 103), 62, 63
what is required to invalidate
patent, 61, 62
written, 61
prior user, 60
experiments, 60
meaning of, 60
private or secret, 60
secret commercial workings, 60, 62
test of, 60, 62
validity, novelty essential for, 60
validity of prior patent, 62
when prior use or publication does
not invalidate (Sect. 45), 62, 63

OBTAINING invention—

a ground for opposing grant, 35
as a ground of invalidity, 58

Offences (Sect. 89), 7

Official Journal. *See* Illustrated
Official Journal (Patents).

— investigation as to novelty, 25

One invention (Sect. 14 (2), Rule 13),
24

Opponent. *See* Opposition to grant;
Extension of term; Amendment
of specification.

Opposition to grant (Sect. 11, Rules
42–49)—

amendments on, 37, 40
appeal from decision of Comp-
troller, 45
assessor, power of Law Officer to
appoint, 45
costs on, 44
counterstatement, 42
disclaimers, 38
disconformity as a ground of, 40
discovery and production of docu-
ments, 44
evidence of parties, 42, 43
grounds of, stated (Sect. 11), 34
fraud, as a ground of, 35, 36
hearing before Comptroller, 43
hearing on appeal before Law
Officer, 45
insufficient description, as ground
of, 39

International Convention applica-
tions, 41

joint inventions, 35, 36
locus standi of opponent, 39, 40, 44
master patents, 38, 43, 44
notice of opposition, 41
obtaining invention from opponent,
35

prior grant, as ground of, 39
prior patent, validity of not
material, 37
prior publication, as ground of, 37
procedure, 41
record of proceedings, inspection
of, 105

reference to publication, at the
hearing, 44

refusal of grant, 38

sealing patent, effect of opposition
on, 34

security for costs, 42

specific references, insertion of, 37
time for taking, 34

Trade Marks, references in specifi-
cation, 40

utility, proof of not usually re-
quired, 37

Opposition to amendment of speci-
fication. *See* Amendment of
specification.

Opposition to extension of term. *See*
Extension of term.

Order in Council (Sect. 88), 212

- Originating summons, application for extension of term by, 122, 131
- PARTICULARS of breaches. *See* Action for infringement.
- of objection. *See* Action for infringement; Extension of term; Revocation of patent.
- Parties—
 action defective for want of, 78
 to a petition to extend the term, 123
 to application for a patent, 8, 16
- Patent—
 agent (Sect. 84). *See* Agent.
 considered as a contract, 2
 date of, 10, 140–142
 forms of (Rules 52–54), 299–302, 305
 improper use of word (Sect. 89(3)), 7
 loss or destruction of (Sect. 44, Rule 101), 199, 240
 meaning of (Sect. 93), 1
 of addition, 31
 patent museum (Sect. 47), 200
 rights under, 2, 77–143, 166
 sealing (Sect. 12, Rules 50, 51), 10, 30
- Patent Office—
 days and hours of business (Rule 112), 242
 library at, 5
 publications by (Sect. 46), 5
 seal of (Sects. 14 (1) and 64), 1, 205
 stamp room at, 5
 statutory provisions for (Sects. 62, 63), 205
 use of name by individuals (Sect. 89), 7
- Patented article, Meaning of (Sect. 27(13)), 191
- Patentee—
 company, wound up, 111
 definition of (Sect. 93), 214
 rights of person registered as, 106
- Patents Acts, 169–221
 — Rules, 222–304
- Persons aggrieved—
 by entries in register, 106
 by threats. *See* Action to restrain threats.
- Personal representatives—
 application for patent by, 8, 17
 devolution of patent, on death of patentee, 110, 135, 136
- Petition for extension of term. *See* Extension of term.
- for revocation. *See* Revocation of patent.
- Possession of patented article, Infringement by, 79
- Post—
 sending documents by (Sect. 81), 209
 service of proceedings by (Sect. 81), 209
- Post-dating of application, 28
- Prerogative of Crown (Sect. 97), 217
- Price, Reduction of, as basis of damages on infringement, 94
- Principle, to what extent patentable, 50, 59
- Prior grant—
 as a ground of invalidity, 58
 as a ground of opposition, 36–39
 investigation in the patent office under Sect. 8, 26
- Prior publication. *See* Novelty; Opposition to grant.
- user, 60
- Product—
 of patentee process or machine, 79, 191
 of chemical process (Sect. 38A), 86
- Profits—
 loss of, as basis of damages, 93
 inadequate. *See* Extension of term.
 of co-owners of patent, 136
- Prolongation. *See* Extension of term.
- Property in articles ordered to be delivered up, 95
- Proprietor. *See* Patentee.
- Protection—
 granted by patent, nature and extent of, 2
 of public, by insertion of reference in specification, 25, 26, 38, 39
 of public and parties, on amendment of specification, 121, 122
 of users—
 when lapsed patent is restored or expired patent extended, 133
 when patent is granted with abnormal priority of date, 141, 142
 provisional protection (Sect. 4), 20
- Provisional specification. *See* Specification.
- Public interest, in application for licence under restored patent, 160
 — knowledge distinguished from common knowledge, 65
 — Authorities Protection Acts, as affecting costs, 101

- Publication (*see also* Novelty)—
 of application under International Convention, 32
 of complete specification, 30
 of invention after application (Sect. 4), 174
- Purchase of patented article, 79
- REASONABLE terms—
 demand for patented article not met on (Sect. 27(2) (c)), 151
 refusal of patentee to grant licence on—
 in case of restored patents, 160
 in case of ordinary patent (Sect. 27(2) (d)), 152
- Rectification of the register—
 by the Comptroller (Sect. 70(c), Rule 96), 206
 by the Court (Sect. 72), 106
- References, Insertion of—
 as result of official investigations, 25, 26
 on opposition to grant, 38
- Register of patent agents (Sect. 85), 6
- Register of patents (Sects. 28, 71, Rules 86-95)—
 application to make or correct entry, 105, 106, 206, 238
 document of title not entered on, effect of, 85, 105
 inspection and certified copies of (Sect. 67), 105
 matters entered on, 104
 obligation to register (Sect. 71), 105
 rectification of (Sect. 72, Rule 115), 106
 rights of registered proprietor, 105
 trusts, notice of (Sect. 66), 105
- Remuneration—
 adequacy of. *See* Extension of term.
 of expert called by Law Officer (Sect. 11(3)), 178
- Renewal fees (Rules 55-57 and 1st Schedule), 11
- Repairs—
 patentee reserving right as to (Sect. 38), 89
 when constituting infringement, 80
- Reports—
 of Comptroller (Sect. 76), 208
 of examiners (Sect. 86), 9, 25, 27
 provisional (Rule 29), 228
 of patent cases (Sect. 46(1)), 200
- Restoration of lapsed patents (Sect. 20, Rules 58-63), 132-134
- Restored ex-enemy patents, 142, 165
- Restraint of trade (Sect. 38), 196
- Revocation of licence. *See* Licence.
- Revocation of patent—
 abuse of monopoly, 157
 action for declaration of invalidity, 146
 alternative grant to petitioner in case of fraud (Sect. 15(1) and (2)), 179
 amendment of specification pending, 147, 148
 applications to the Comptroller (Sect. 26, Rules 76-78), 149
 certificate of particulars, 148
 costs, 148
 counterclaim for, in infringement action, 83, 147
 evidence, 147
 fiat of Attorney General, 146
 grounds for, 145
 issues previously decided, 146
 judgment, 148
locus standi in petition for, 145, 146
 order for (Rule 115), 148
 particulars of objection, 147
 petitions to the Court, 145-148
 procedure, 146-148
 secret patent, 146
 service on patentee out of jurisdiction, 147
 surrender of patent (Sect. 26(3), Rule 78), 134
- Royal Arms, unauthorized use of (Sect. 90), 8
- Royalties—
 actions to recover, 103
 measure of damages in infringement actions, 95
 under licences granted by the Comptroller, 158
 under restored patents, 166
- Rules—
 Patents Rules, 1920, 222-304
 under Treaty of Peace Order, 336-344
- SALE—
 by Government, of patented article (Sect. 29(3)), 138
 implied licence as a result of, 88, 113
 restriction on resale, 88, 114
 infringement by sale or exposure for sale, 79
 parts of parts of article, sale of, 81
 prior user by, 60

Samples, chemical, (Sect. 2(5)), 22
 Saturday (Rule 113), 242
Scire Facias (Sect. 25), 145
 Scotland, application of Act to, 216
 Seal of Patent Office (Sect. 14(1)), 1
 impressions of, admission as evidence (Sect. 64), 205
 Search on examination of application (Sects. 7, 8 ; Rules 28-36)—
 extent of, 9, 25, 26
 procedure subsequent to, 25-29
 result of, obtainable (Sect. 68, Rule 37), 27
 Secret patent (Sect. 30, Rules 98-100), 32
 Sequestration, on breach of injunction, 103
 Servant, 110
 Ships, Use of invention on (Sect. 48), 79, 80
 Solicitor and clients costs. *See* Action for infringement (costs).
 Specific references on opposition, 38
 Specification (Sect. 2) (*see also* Construction of specification ; Validity of patent).
 acceptance of (Rules 39-41), 29, 30
 advantages of invention stated in, 75
 amendments of (*see also* Amendment of specification).
 manner of making amendments prior to acceptance, 29
 chemical inventions, 22, 86
 cognate inventions, 33
 complete specification—
 claims in, 22, 52-54, 88
 contents of, 21
 description of invention in, 21, 23
 distinguished from provisional, 9, 18
 drawings for, 22, 75
 requirements of, for valid patent, 71-76
 time for filing, (Sect. 5), 9
 deferring acceptance, 30
 disconformity, 27, 28, 76
 as result of amendment, 19, 28
 division of, 24, 25
 drawings, formal requirements for, 20, 22
 errors, omissions and ambiguities in, 74
 examination of, 9, 23-28
 formal requirements, 23
 forms for, 261, 262

Specification (*contd.*)—
 investigation and search as to novelty, 9, 25
 extent of, 25, 26
 manner of manufacture. *See* Manner of manufacture.
 obligations on applicant, 16-22
 one invention, 2, 24
 post-dating of application, 28
 procedure after report, 25-29
 result of, obtainable (Sect. 68, Rule 37), 27
 provisional specification, 19-21
 advantages and disadvantages of, 20
 claims in, to be avoided, 19
 contents of, 19
 distinguished from complete, 9, 18
 drawings. *See* Drawings.
 reports of examiners, 9, 27
 sealing of patent, 30
 statutory references, insertion of (Rules, 31, 32, 35), 26
 theory in, effect of, 74
 title of, 18, 23
 Statute of monopolies, 3, 169
 Statutory declaration (Rules 108, 109), 42, 43
 — reference, 26
 Subject-matter (*see* Manner of manufacture ; Novelty ; Validity of patent (utility) ; Inventive ingenuity).
 ambiguous use of term, Pref. vi
 what is included in term, Pref. vi, 1, 2
 Subordinate claims, 53
 "Substantially as described." *See* Construction of specification.
 Sufficiency of description (*see* Validity of patent).
 in alleged anticipation, 61
 Suggestion, False, effect on validity, 74
 Sunday (Rule 112), 242
 Surrender of patent (Sect. 26(3)), 134

 TECHNICAL terms, Evidence as to meaning of, 46, 47
 Tenants in common. *See* Co-owners
 Term of patent (Sect. 17), 122
 Threats to infringe, 81
 Threats of legal proceedings. *See* Action to restrain threats.
 Title of application and specification, 23
 — to sue for infringement, 85

Transfer of patent rights. *See* Assignment; Devolution of patent rights.
 Treaty of Peace Order and Rules, 306-344
 infringements of enemy patents (Art. 309), 143, 330
 patents granted abnormal priority of date, 140-142
 pre-war licences (Art. 310), 331
 restored patents and applications, 142
 compulsory licences under, 159
 restrictions on, 165, 166
 royalties and other payments under, 166
 True and first inventor, 8, 57, 58
 Trust, notice of, not entered on register, 105
 Trustee in bankruptcy, 111
 USER. (*See* Infringement; Novelty.)
 Utility. *See* Validity of patent.
 VALIDITY of patent—
 bona fides, 75, 76
 certificate of validity, 96-98
 commercial success, bearing on, 64
 disconformity as effecting (Sect. 42), 76
 errors, effect of, 74
 grounds of invalidity stated, 56
 intelligibility of specification, 72, 74, 75
 invalid claims, presence of (Sect. 32a), 55, 88
 inventive ingenuity. *See* Inventive ingenuity.

Validity of patent (*contd.*)—
 law and morality (Sect. 75), 59
 manner of manufacture, 1, 59
 basis of an invention, 1
 instances of want of, 59
 more than one invention, 24
 novelty. *See* Novelty.
 on petition to extend term, 125
 patent of addition, 32
 presumption of, 13, 55
 prior grant, 58
 public policy, invention contrary to, 59
 specification. *See* Specification.
 sufficiency of description, 73-75
 true and first inventor, 76
 in case of disconformity, 76
 material dates for determining, 57
 meaning of, 57
 must be a grantee or original applicant, 57
 utility—
 amount of, necessary, 64
 commercial success, 64
 tests of utility, 63-65
 Vesting order in favour of equitable assignee, 111
 WAR legislation, effect of, on patents, 140-143
 Warning, general, when actionable threat, 162
 Working on commercial scale (Sect. 93), 215
 Workman, 47



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